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BRODIX'S AMERICAN AND ENGLISH PATENT CASES.

VOL. IV.

DECISIONS

ON THE LAW OF

PATENTS FOR INVENTIONS

RENDERED BY

THE UNITED STATES SUPREME COURT.

FROM THE BEGINNING,

**1 DALLAS, - 5 HOWARD,
1754. 1847.**

EDITED BY

WOODBURY LOWERY.

WASHINGTON :

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PREFACE.

IN presenting to the profession this collection of Patent Cases decided in the Supreme Court of the United States, attention is called to those prominent features of the work which, it is hoped, will render it of use to the general as well as to the patent practitioner.

Each decision is given in full as reported in the original report, but both the statement of the case and the argument of counsel have been more explicitly stated.

To the statements have been added the specifications and drawings of patents therein referred to, whenever it appeared likely to facilitate the understanding of the case.

To the arguments of counsel have been added the names of the cases when they have been omitted, and are cited only by volume and page. The arguments are also given more *in extenso*, as will appear in the future volumes.

In the opinion the same rule has been followed of inserting omitted titles. These additions to the text are indicated by brackets.

The head-notes to each case have been numbered consecutively, and at the end of the case will be found under the corresponding number of the head-note a note of Supreme Court Patent Cases, in chronological order, bearing upon the subject-matter of the head-note.

These notes refer to all patent cases, including those arising during the spring term of the Supreme Court for 1887.

At the end of each head-note will be found, between brackets, the page of the opinion of which it is a digest.

Each case is accompanied by the name of the patent or patents and their reissues, if any, on which the suit is brought, followed by a chronological list of all reported Federal suits in which the patent has been involved.

Then follows a list of those cases, prepared with great

care, in which the opinion reported has been cited. This list includes cases Federal, State, and Canadian, opinions of the Attorney-General and of the Commissioner of Patents, and the latest text-books—*i.e.*, Curtis, 4th edition, Walker, Merwin, and Abbott. While the earlier and recent decisions of our Superior Court bristle with citations of English cases, the latter do not once cite us, as far as can be ascertained.

All of the lists are chronological in arrangement, and in the list of citations the dates are appended.

To facilitate the finding of any case appearing in the notes, not only is the original report given, but also volume and page of Robb, Fisher, and other reports in which it is reprinted. The only exceptions to this rule are the cases cited under each head-note, since these will all be found in this series.

To mitigate the imperfection attendant upon all human undertaking, however conscientious the performance, blank lined spaces have been left after each note, to be filled out by the owner, and the same has been done for the insertion of additional citations. A blank page is left at the end of each case for more general notes.

The volume is accompanied by several tables, among others one of cases cited in the opinions reported, and a table of abbreviations.

Attention is called to the latter as an index of the number of works, reports, periodicals, etc., consulted in its preparation. Reference is made throughout the work to the volume and page of the English cases already published as part of this series, wherever they occur.

It is sincerely hoped that the undertaking may commend itself to the profession, and that the novelty of some of its details may not be without their advantages.

In conclusion, the editor wishes to acknowledge his appreciation of the hearty co-operation of the publisher in everything which would tend to the completeness and finish of the work from a legal as well as from a mechanical standpoint.

WOODBURY LOWERY.

WASHINGTON, D. C., September 1, 1887.

TABLE OF CONTENTS.

PREFACE.....	iii
ALPHABETICAL TABLE OF CASES.....	vii
REFERENCE TABLE OF CASES.....	ix
TABLE OF PATENTS IN SUIT.....	x
TABLE OF CITATIONS.....	xi
TABLE OF ABBREVIATIONS.....	xviii
TABLE OF NAMES OF JUSTICES.....	xxi
TABLE OF NAMES OF COUNSEL.....	xxi
CASES REPORTED.....	1-560
INDEX DIGEST.....	561

ALPHABETIC TABLE OF CASES

REPORTED IN THIS VOLUME

BRUNDAGE, WOOD, <i>Ex parte</i>	198
CARVER v. HYDE <i>et al.</i> 16 Pet. 518-520. Jan., 1842.....	367
[Bk. 10, L. ed. 1051 ; 1 Whit. 316 ; Fish. Pat. Rep. 20]	
COOPER, SHAW v.....	286
DE YOUNG, KEPLINGER v.	209
DIALOGUE, PENNOCK v.....	217
EATON, EVANS v.....	16
EATON, EVANS v.....	105
EVANS v. EATON. 3 Wheat. 454-519. Feb., 1818.....	16
[Bk. 4, L. ed. 433 ; 1 Robb. 243 ; 1 Whit. 8.] Reversing	
<i>Ibid.</i> , 1 Pet. C. C. 322. Same case, 7 Wheat. 356	
[p. 105 <i>post</i>].	
EVANS v. EATON. 7 Wheat. 356-452. Feb., 1822.....	105
[Bk. 5, L. ed. 472 ; 1 Robb. 336 ; 1 Whit. 48.] Affirming	
<i>Ibid.</i> , 3 Wash. 443. Same case, 8 Wheat. 454 [p. 16	
<i>ante</i>].	
EVANS v. HETTICH. 7 Wheat. 453-470. Feb., 1822.....	182
[Bk. 5, L. ed. 496 ; 1 Robb. 417 ; 1 Whit. 104.] Affirming	
<i>Ibid.</i> , 3 Wash. 408.	
EVANS v. JORDAN AND MOREHEAD. 9 Cranch, 199-204. Feb.,	
1815.....	7
[Bk. 3, L. ed. 704 ; 1 Robb. 57 ; 1 Whit. 3.] Affirming	
<i>Ibid.</i> , 1 Brock. 248.	
GRANT <i>et al.</i> v. RAYMOND. 6 Pet. 218-249. Jan., 1832.....	245
[Bk. 8, L. ed. 376 ; 1 Robb. 604 ; 1 Whit. 146.]	
HETTICH, EVANS v.....	182
HYDE, CARVER v.....	367
JORDAN AND MOREHEAD, EVANS v.....	7
KEPLINGER v. DE YOUNG. 10 Wheat. 358-367. Feb., 1825.....	209
[Bk. 6, L. ed. 341 ; 1 Robb. 458 ; 1 Whit. 122.]	
KINGSLAND, McCLURG v.....	332
McCLURG v. KINGSLAND. 1 How. 202-211. Jan., 1843.....	382
[Bk. 11, L. ed. 102 ; 2 Robb. 105 ; 1 Whit. 322.]	
MOREHEAD AND JORDAN, EVANS v.	7
PENNOCK AND SELLERS v. DIALOGUE. 2 Pet. 1-24. Jan., 1829.	217

ALPHABETIC TABLE OF CASES.

	[Bk. 7, L. ed. 827 ; 1 Robb. 542 ; 1 Whit. 127.] Affirming <i>Ibid.</i> , 4 Wash. 538.	
PROUTY AND MEARS <i>v.</i> RUGGLES <i>et al.</i>	16 Pet. 836-841. Jan., 1842.....	351
	[Bk. 10, L. ed. 985 ; 2 Robb. 98 ; 1 Whit. 311.] Affirming <i>Ibid.</i> , 1 Story, 568.	
RAILROAD CO. <i>v.</i> STIMPSON. See PHILA. AND TRENTON R.R. CO. <i>v.</i> STIMPSON.....		
RAYMOND, GRANT <i>v.</i>		245
ROUSSEAU, WILSON <i>v.</i>		436
RUGGLES, PROUTY <i>v.</i>		351
SHAW <i>v.</i> COOPER. 7 Pet. 292-323. Jan., 1833.....		286
	[Bk. 8, L. ed. 689 ; 1 Whit. 173 ; 1 Robb. 643.]	
SIMPSON <i>v.</i> WILSON. 4 How. 709-711. Jan., 1846.....		533
	[Bk. 11, L. ed. 1169 ; 2 Robb. 469 ; 1 Whit. 424.]	
STIMPSON, THE PHILADELPHIA AND TRENTON R.R. Co. <i>v.</i>		324
STIMPSON <i>v.</i> THE WEST CHESTER RAILROAD COMPANY. 4 How. 380-404. Jan., 1846.....		398
	[Bk. 11, L. ed. 1020 ; 2 Robb. 335 ; 1 Whit. 330.]	
THE PHILADELPHIA AND TRENTON RAILROAD COMPANY <i>v.</i> STIMPSON, also called RAILROAD CO. <i>v.</i> STIMPSON. 14 Pet. 448-463. Jan., 1840.....		324
	[Bk. 10, L. ed. 536 ; 2 Robb. 46 ; 1 Whit. 292.]	
TUEL, TYLER <i>v.</i>		1
TURNER, WILSON <i>v.</i>		539
TYLER <i>et al.</i> <i>v.</i> TUEL. 6 Cranch, 324-327. Feb., 1810.....		1
	[Bk. 3, L. ed. 237 ; 1 Robb. 14 ; 1 Whit. 1.]	
UNDERHILL, WOOD <i>v.</i>		551
WEST CHESTER R.R. CO., STIMPSON <i>v.</i>		398
WILSON <i>v.</i> ROUSSEAU. 4 How. 646-709. Jan., 1846.....		436
	[Bk. 11, L. ed. 1140 ; 2 Robb. 373 ; 1 Whit. 357.]	
WILSON, SIMPSON <i>v.</i>		533
WILSON <i>v.</i> TURNER. 4 How. 712. Jan., 1846.....		539
	[Bk. 11, L. ed. 1171 ; 2 Robb. 467 ; 1 Whit. 427.] Affirming <i>Ibid.</i> , Taney, 278.	
WILSON, WOODWORTH <i>v.</i>		542
<i>Ex parte</i> WOOD AND BRUNDAGE. 9 Wheat. 603-615. Feb., 1824. 198		
	[Bk. 6, L. ed. 170 ; 1 Robb. 438 ; 1 Whit. 115.]	
WOOD <i>v.</i> UNDERHILL. 5 How. 1-6. Jan., 1847.....		551
	[Bk. 12, L. ed. 23 ; 2 Robb. 538 ; 1 Whit. 432.]	
WOODWORTH <i>v.</i> WILSON. 4 How. 712-716. Jan., 1846.....		542
	[Bk. 11, L. ed. 1171 ; 2 Robb. 473 ; 1 Whit. 428.]	

REFERENCE TABLE OF CASES.

REFERENCE TABLE OF CASES

DECIDED IN U. S. SUPREME COURT, AND REPORTED IN THIS VOLUME.

Date.	Official Reports of U. S. Supreme Court.	Lawyers' Edition of U. S. Supreme Court Reports.	Robb's Patent Cases and Fisher's Patent Report.	Whitman's Patent Cases.	Title of Cases in this Volume.
1810. February.	6 Cranch. 824.	Bk. 3, p. 287.	1 Robb. 14.	1 Whit. 1.	Tyler v. Tuel.
1815. February.	9 Cranch. 199.	Bk. 3, p. 704.	1 Robb. 57.	1 Whit. 8.	Evans v. Jordan.
1818. February.	3 Wheat. 454.	Bk. 4, p. 438.	1 Robb. 248.	1 Whit. 8.	Evans v. Eaton.
1822. February.	7 Wheat. 356.	Bk. 5, p. 472.	1 Robb. 386.	1 Whit. 48.	Evans v. Eaton.
1822. February.	7 Wheat. 453.	Bk. 5, p. 496.	1 Robb. 417.	1 Whit. 104.	Evans v. Hettich.
1824. February.	9 Wheat. 608.	Bk. 6, p. 170.	1 Robb. 438.	1 Whit. 115.	Wood v. Brundage.
1825. February.	10 Wheat. 358.	Bk. 6, p. 841.	1 Robb. 458.	1 Whit. 123.	Keplinger v. De Young.
1829. January.	2 Peters, 1.	Bk. 7, p. 827.	1 Robb. 542.	1 Whit. 127.	Pennock v. Dialogue.
1832. January.	6 Peters, 218.	Bk. 8, p. 376.	1 Robb. 604.	1 Whit. 146.	Grant v. Raymond.
1838. January.	7 Peters, 292.	Bk. 8, p. 689.	1 Robb. 643.	1 Whit. 173.	Shaw v. Cooper.
1840. January.	14 Peters, 448.	Bk. 10, p. 536.	2 Robb. 46.	1 Whit. 292.	Phila. & T. R. R. Co. v. Stimpson.
1842. January.	16 Peters, 386.	Bk. 10, p. 985.	2 Robb. 98.	1 Whit. 811.	Prouly v. Ruggles.
1842. January.	16 Peters, 513.	Bk. 10, p. 1051.	Fish. Pat. Rep. 20.	1 Whit. 816.	Carver v. Hyde.
1843. January.	1 How. 202.	Bk. 11, p. 102.	2 Robb. 105.	1 Whit. 822.	McClurg v. Kingsland.
1846. January.	4 How. 380.	Bk. 11, p. 1020.	2 Robb. 835.	1 Whit. 330.	Stimpson v. R. R. Co.
1846. January.	4 How. 646.	Bk. 11, p. 1140.	2 Robb. 878.	1 Whit. 357.	Wilson v. Rousseau.
1846. January.	4 How. 709.	Bk. 11, p. 1169.	2 Robb. 469.	1 Whit. 424.	Simpson v. Wilson.
1846. January.	4 How. 712.	Bk. 11, p. 1171.	2 Robb. 467.	1 Whit. 427.	Willson v. Turner.
1846. January.	4 How. 713.	Bk. 11, p. 1171.	2 Robb. 478.	1 Whit. 428.	Woodworth v. Willson.
1847. January.	5 How. 1.	Bk. 12, p. 28.	2 Robb. 588.	1 Whit. 432.	Wood v. Underhill.
					p. 1.
					p. 7.
					p. 16.
					p. 105.
					p. 182.
					p. 198.
					p. 209.
					p. 217.
					p. 245.
					p. 286.
					p. 324.
					p. 351.
					p. 367.
					p. 382.
					p. 398.
					p. 436.
					p. 533.
					p. 589.
					p. 543.
					p. 551.

TABLE OF PATENTS IN SUIT

IN CASES REPORTED IN THIS VOLUME.

Number of Patent.	Patentee.	Date of Patent.	Subject of Invention.	Inserted in this Volume.	Title of Case.	
No. —	Tyler, B.	Feb. 20, 1800.	Grist-Mill.	Drawing and Specification.	Tyler v. Tuel.	p. 1.
No. —	Evans, O.	Dec. 18, 1790.	Hopper-Boy.		Evans v. Jordan.	p. 7.
No. —	Evans, O.	Dec. 18, 1790.	Hopper-Boy.		Evans v. Eaton.	p. 16.
No. —	Evans, O.	Dec. 18, 1790.	Hopper-Boy.	Drawing.	Evans v. Eaton.	p. 105.
No. —	Evans, O.	Dec. 18, 1790.	Hopper-Boy.		Evans v. Hettich.	p. 182.
No. —	Wood & Brundage.	Nov. 9, 1820.	Plough.		<i>Ex parte</i> Wood & Brundage.	p. 198.
No. —	Keplinger, S.	May 4, 1820.	Watch-Chain.		Keplinger v. De Young.	p. 209.
No. —	Pennock & Sellers.	July 6, 1818.	Leather Tubes or Hose.		Pennock v. Dialogue.	p. 217.
No. —	Grant, J.	Aug. 11, 1821.	Hat Bodies.		Grant v. Raymond.	p. 245.
No. —	Shaw, J.	June 19, 1822.	Percussion Gun. Reissue May 7, 1829.	Drawing.	Shaw v. Cooper.	p. 286.
No. —	Stimpson, J.	Sept. 26, 1865.	Curves for Railways.		R. R. Co. v. Stimpson.	p. 324.
No. —	Prouty & Mears.	March 4, 1836.	Plough		Prouty v. Ruggles.	p. 351.
No. 777.	Carver, E.	June 12, 1838.	Ribs of Cotton-Gin. Reissue No. 17, Nov. 16, 1839.	Drawing and Specification.	Carver v. Hyde.	p. 367.
No. —	Harley, J. J.	March 8, 1835.	Castings Chilled Rollers.		McClurg v. Kingsland.	p. 382.
No. —	Stimpson, J.	Aug. 23, 1831.	Rails for Railroad Carriages.	Drawings and Specification.	Stimpson v. R. R. Co.	p. 398.
No. —	Woodworth, W.	Dec. 27, 1828.	Planing-Mill. Reissue No. 71, July 8, 1845.		Wilson v. Rousseau.	p. 436.
No. —	Woodworth, W.	Dec. 27, 1828.	Planing-Mill. Reissue No. 71, July 8, 1845.		Simpeon v. Wilson.	p. 533.
No. —	Woodworth, W.	Dec. 27, 1828.	Planing-Mill. Reissue No. 71, July 8, 1845.	Drawing and Specification.	Wilson v. Turner.	p. 539.
No. —	Woodworth, W.	Dec. 27, 1828.	Planing-Mill. Reissue No. 71, July 8, 1845.		Woodworth v. Wilson.	p. 542.
No. 97.	Wood, J.	Dec. 2, 1836.	Brick-Making.		Wood v. Underhill.	p. 551.

TABLE OF PATENTS IN SUIT.

TABLE OF CITATIONS
IN THE CASES REPORTED IN THIS VOLUME.

NOTE.—Cases cited in the Statement marked S.
“ “ “ Argument “ A.
“ “ “ Opinion “ Opin.
“ “ “ Dissenting opinion marked Dis. opin.
“ “ “ Wheaton's Appendix marked Wheat. App.

Citation.	Where reported.	Cited in this vol., page.
Ames v. Howard.....	1 Sumn. 485.....	527. Dis. Opin.
Appendix.....	3 Wheat. Rep. 18.....	181. A.
“	“ “ “ 27.....	117. A.
“	“ “ “ 21.....	185. S.
Bac. Abr.....	Vol. 6, p. 381.....	3. A.
Bac. Abr. Statute, T.....	507. Dis. opin.
Baldwin's Case.....	2 Co. 83.....	4. A.
Barrett v. Hall.....	1 Mason, 475.....	267. A.
Beck, <i>Ex parte</i>	1 Bro. Ch. Rep. 575. [1 Am. & Eng. 23].....	266. A.
Bedford v. Hunt.....	1 Mason's R. 7.....	100, 108. Wheat. App.
Bell v. Morrison.....	1 Peters, 355.....	331. A.
Bingham v. Cabot.....	3 Dall. 19.....	331. A.
Blanchard's Case.....	Opin. of Atty.-Gen., pp. 1184 and 1209.....	520. Dis. opin.
Blanchard v. Sprague.....	2 Story's Rep. 169.....	527. Dis. opin.
Blank	1 Bald.....	405. S.
“	3 East.....	3, 180. A.
“	Ld. Raymond, 271.....	3. A.
“	4 Mason's Rep.....	222. A.
“	1 Mass. 182, 452.....	121. A.
“	Plowd. 564	4. A.
“	2 Saunders's Rep. 72. Will- iams's Note (4) § 4.....	99. Wheat. App.
“	U. S. Law Journal, 83.....	198. A.
“	1 Vent. 521.....	4. A.
Bl. Com.....	Vol. 1, p. 89.....	4. A.
“ “	Vol. 2, p. 407. Note by Christian (7).....	91. Wheat. App.
Bombon v. Bule.....	113. S.

Citation.	Where reported.	Cited in this vol., page.
Boulton v. Bull.....	2 H. Bl. 463. [1 Am. & Eng. 59].....	91, 92, 93, 94, 97, 99. Wheat. App.
“ “	2 H. Bl. 478, 484, 497. [1 Am. & Eng. 59, 97].....	156. A.
“ “	[1 Am. & Eng. 59].....	185. S.
“ “	2 H. Black. 484. [1 Am. & Eng. 59].....	121, 130, 143, 156, 265, 555. A.
Bovill v. Moore.....	2 Marshall's R. 211. [1 Am. & Eng. 268].....	93, 97, 98. Wheat. App.
“ “	[1 Am. & Eng. 231].....	113, 185. S.
“ “	2 Marsh. Rep. 211. [1 Am. & Eng. 268].....	121, 130. A.
Brandling v. Barrington....	6 Barn. & Cressw. 475....	510. Dis. opin.
Brooke v. Clarke.....	1 B. & A., 396, note.....	260. A.
Brooks & Morris v. Bicknell & Jenkins'.....	4 McLean, 64.....	499, 520. Dis. opin.
Bulwer's Case.....	8 Co. 56	4. A.
Butler's Opinion.....	Opin. of Atty.-Gen., pp. 1184 and 1209.....	520. Dis. opin.
Chapman v. Lampshire	8 Mod. 156.....	3. A.
Coke.....	Vol. 8, p. 118, b.....	516. Dis. opin.
Com. Dig. Patent, G.....	295. A.
Conn. v. Penn	4 Washington, 438.....	318. Opin.
Consequa v. Fanning	8 John. Ch. Rep. 598.....	122. A.
Conway v. Gray.....	10 East's Rep. 536.....	122. A.
Cooper v. Matheys.....	C. C. MS	407. S.
Cowles v. Dunbar.....	2 Car. & Paine, 565.....	265. A.
Cresswell v. Cokes.....	Dyer, 851.....	4. A.
Dane's Abridg.....	Vol. 1, p. 527.....	297. A.
Davis's Patent Cases... ..	413.....	264. A.
Davis v. Packard.....	6 Peters, 47.....	409. S.
Dodson's Patents.....	56.....	264. A.
Dolland's Patent.....	2 H. Bl. 470, 487.....	98. Wheat. App.
Dominus Rex v. Whiting....	Salk. Rep. 288.....	297. A.
Dwarris on Statutes	692.....	507. Dis. opin.
“ “ “	711.....	521. Dis. opin.
“ “ “	658.....	516. Dis. opin.
Earle v. Sawyer.....	4 Mason, 9, 10.....	265. A.
Edgeberry v. Stevens	2 Salk, 447. [1 Am. & Eng. 8].....	91. Wheat. App.
Ellmaker v. Buckley.....	16 Serg. & Rawle.	332. A.
Evans v. Eaton.....	3 Wheat. 512 [p. 79, ante].	111, 187, 189, 191. S.
“ “	3 Wheat. 454-519	117, 118, 121, 129, 133, 135, 136, 146, 156, 265, 329, 331. A.
“ “	3 Wheat. 466.....	169. Dis. opin.

TABLE OF CITATIONS.

xiii

Citation.	Where reported.	Cited in this vol., page.
Evans v. Eaton.....	8 Wash. 443.....	156. Opin.
“ “	Peters C. C. R. 822.	829. A.
“ “	1 Peters C. C. Rep. 848....	229. A.
“ “	7 Wheat. 856	194. Opin.
Evans v. Hettich		186. A.
Evans v. Jordan.....	9 Cranch, 208	411, 412. S.
“ “	9 Cranch, 201	427. A.
<i>Ex parte</i> Beck. See Beck.		
“ “ Fox. See Fox.		
“ “ O'Reily. See O'Reily.		
Eystor v. Studd	Plowd. 467.....	60. A.
Fox, <i>Ex parte</i>	1 Ves. & Beames, 67. [1 Am. & Eng. 185].....	92, 94. Wheat. App.
“ “ “	1 Ves. & Beames, 67. [1 Am. & Eng. 185].....	198, 265. A.
Franklin Journal.....	Vol. 9, pp. 124, 125.....	899, 408. S.
“ “	Vol. 9, pp. 124, 125.....	423. A.
French v. Blackhouse ..	5 Burr. 2780.....	117. A.
Godson on Patents.....	85.....	555. A.
“ “ “	200.....	257, 295. A.
Godson.....	201.....	260. A.
“	124 ..	264. A.
Goodyear v. Matthews	1 Paine's Rep. 801.....	221, 298, 301. A.
“ “	1 Paine's Rep. 801.....	318. Opin.
Grant v. Raymond.....	6 Peters, 218	829, 415, 417, 418, 425, 426. A.
“ “	6 Peters, 243	405, 408, 409, 411. S.
“ “	6 Peters, 220	810, 888, 494. Opin.
“ “		527. Dis. opin.
Gray v. James	1 Peters, 401	263. A.
Gray & Osgood v. James...	1 Peters C. C. Rep. 894....	268. A.
Groenwelt v. Burwell.....	1 Salk. 144.....	198. A.
Harmer v. Playne.....	11 East, 101. [1 Am. & Eng. 171].....	91, 93, 96, 98. Wheat. App.
“ “	14 Ves. 130. [1 Am. & Eng. 166].....	92, 98. Wheat. App.
“ “	[1 Am. & Eng. 171].....	113, 185. S.
“ “	11 East, 107 [1 Am. & Eng. 171].....	121, 265, 555. A.
“ “	14 Ves. 131. [1 Am. & Eng. 166].....	265. A.
Hartop v. Hoare.....	8 Atk. Rep. 44.....	297. A.
“ “	2 Str. Rep. 1187.....	297. A.
Harvey v. Stokes.....	1 Wils. Rep. 8.....	297. A.
Hawk. P. C.....	B. 1, ch. 79, and see Noy 182, 188.....	91. Wheat. App.
“ “	Vol. 1, p. 477, note.	519. Dis. opin.

TABLE OF CITATIONS.

Citation.	Where reported.	Cited in this vol., page.
Hayne v. Maltby	3 T. R. 488. [1 Am. & Eng. 58].....	99. Wheat. App.
Herbert v. Adams.....	4 Mason, 15.....	519. Dis. opin.
Hill v. Thompson	8 Meriv. 622. [1 Am. & Eng. 299].....	121. A.
Holroyd	100, note.....	264. A.
Hornblower v. Boulton	8 T. R. 95. [1 Am. & Eng. 98].....	91, 92, 94. Wheat. App.
“ “	8 T. R. 95-97. [1 Am. & Eng. 98].....	71, 180, 188, 156, 265. A.
Hurst's Lessee v. M'Neil ...	1 Wash. C. C. Rep. 71....	265. A.
Inkersalls v. Samms	Cro. Car. 130.....	3. A.
Inst.....	Vol. 8, p. 184.	92. Wheat. App.
“	Vol. 8, p. 184.....	93. Wheat. App.
“	Vol. 8, p. 184.....	229. Opin.
“	Vol. 2, pp. 107, 386.....	507. Dis. opin.
Jefferson's Case	2 Saund. 15.....	198. A.
Jenk. Cent.....	138.....	60. A.
Jones v. Smart.....	1 D. & E. 52.....	521, 523. Dis. opin.
Journal of Franklin Inst....	Vol. 9, p. 124, No. 87....	423. A.
Keene v. Meade	3 Peters, 6... ..	331. A.
Kenson v. Reading	Cro. Eliz. 244.....	4. A.
King v. Arkwright.....	Davis's Pat. Cases, 106....	555. A.
King. See The King.		
Kneass v. Schuylkill Bank..	4 Wash. C. C. Rep. 13....	263. A.
Lane v. Cotton.....	1 Saulk. 17.....	3. A.
Langdon v. De Groot.....	1 Paine's R. 203.....	555. A.
Ld. Buckhurst v. Fenner....	1 Co. 8.....	4. A.
Ld. Cochrane v. Smethurst..	1 Starkie's N. P. R. 205.	
	[1 Am. & Eng. 228]....	94. Wheat. App.
Liardet v. Johnson.....	Bull N. P. 76. [1 Am. & Eng. 22], 1 T. R. 602, 608.....	97. Wheat. App.
Lowell v. Lewis.....	1 Mason's R.	100, 101, 103. Wheat. App.
“ “	1 Mason, 189, 191.....	156, 263, 265, 555. A.
“ “	1 Mason, 182.....	186. S.
McClurg v. Kingsland.....	1 How. 204.....	427. A.
“ “	1 How. 202.....	491. Opin.
“ “	1 How. 210.....	512. Dis. opin.
M'Farlane v. Price	1 Starkie's N. P. R. 199.	
	[1 Am. & Eng. 227]....	98. Wheat. App.
“ “	[1 Am. & Eng. 227].....	118, 185. S.
“ “	Starkie's N. P. Rep. 199. [1 Am. & Eng. 227].....	121, 131. A.
McPeake v. Hutchinson....	5 Serg. & Rawle, 295....	330. A.
Marbury v. Madison.....	1 Cranch, 159, 160.....	257. A.

TABLE OF CITATIONS.

xv

Citation.	Where reported.	Cited in this vol., page.
Margaretta.	See The Margaretta.	
Martin v. Hunter's Lessee...	1 Wheat. Rep. 813.....	330. A.
Mellus v. Silsbee.....	4 Mason's Rep. 108.....	268. A.
" ".....	4 Mason, 108.....	313. Opin.
Miller v. Taylor.....	4 Burr, 2368.....	297. A.
" ".....	4 Burr, 2368.....	313. Opin.
Moreland v. Leigh..	1 Starkie, 388.....	261. A.
Morris v. Huntington.....	Paine's Rep. 348.....	221, 260, 266, 293, 299, 304, 328. A.
" ".....	1 Paine, 354.....	313. Opin.
" ".....	1 Paine, 355.....	411. S.
Odiorne v. Winkley.....	2 Gall. 51.....	100, 101. Wheat. App.
" ".....	2 Gall. 51.....	121, 126, 131. A.
Oldham v. Langmead.....	[1 Am. & Eng. 53], cited 3 T. R. 439.....	99. Wheat. App.
O'Reily, <i>Ex parte</i>	1 Ves. jun. 112.....	198. A.
Otis v. Walkins.....	9 Cranch. 339, 355.....	261. A.
Paine v. Pritchard.....	2 Car. & Paine, 558.....	265. A.
Pamphlet Laws.....	1839, pp. 74, 75.....	390. Opin.
Park v. Little.....	3 Wash. C. C. Rep. 198.....	265. A.
Park v. Little & Wood.....	3 Washington, 196.....	263. A.
Pennock v. Dialogue.....	2 Peters, 1.....	260, 263, 293, 296, 302. A.
" ".....		278, 313, 338, 339, 391. Opin.
Philadelphia Railroad v. Stimpson.....	14 Peters, 462.....	426. A.
Phill. Ev.....	Ch. 5, p. 49.....	117. A.
Phillips on Patents.....	Pp. 83, 267, 268, 283, 284, 289.....	555. A.
Prouty <i>et al.</i> v. Ruggles....	16 Peters, 336.....	408. S.
" " ".....		426. A.
Railroad Co. v. Stimpson...	14 Peters, 458.....	405. S.
Reigart v. Ellmaker...	10 Serg. & Rawle, 27.....	330. A.
Rex v. Arkwright.....	Bull N. P. 77. [1 Am. & Eng. 29].....	92, 93 96, 97. Wheat. App.
Rex v. Cutler.....	1 Starkie's N. P. R. 354. [1 Am. & Eng. 225]....	92, 99. Wheat. App.
Roscoe on Evidence.....	P. 21.....	330. A.
Sawin v. Guild.....	1 Gall. R. 485.....	102. Wheat. App.
Schimmelpennick v. Turner.	6 Peters, 6.....	409. S.
Shaw v. Cooper.....	7 Peters, 313-328.....	388. Opin.
" ".....	7 Peters, 321.....	405. S.
" ".....	7 Peters, 292.....	329, 425, 426, 427. A.
Sherwood v. Sutton.....	5 Mason, 6.....	330. A.
Standen v. The University of Oxford.....	1 Jones, 26.....	516. Dis. opin.

TABLE OF CITATIONS.

Citation.	Where reported.	Cited in this vol., page.
State v. Woodruff.....	2 Day's Reports, 519.....	261. A.
Stearns v. Barrett.....	1 Mason's R. 10.....	104. Wheat. App.
" ".....	1 Mason's Rep. 153.....	198. A.
Story.....	Vol. 4, p. 2301.....	388. Opin.
".....	Vol. 4, p. 2511.....	389. Opin.
Sullivan v. Redfield.....	1 Paine, 447.....	381. A.
The King v. Dean of Trinity Chapel ..	8 Mod. 28.....	198. A.
The King v. Else.....	11 East, 109. [1 Am. & Eng. 40], note.....	93. Wheat. App.
The King v. Miles.....	7 Term Rep. 367.....	260. A.
The King v. The Poor Law Commissioners.....	6 Adolph. & Ellis, 7.....	528. Dis. opin.
The King v. Wheeler.....	2 Barn. & Ald. 345. [1 Am. & Eng. 317].....	555. A.
The Margarett.....	2 Gall. 519.....	381. A.
Thompson v. Haight.....	1 U. S. Law Journal, 563.....	229. A.
Treadwell v. Bladen.....	4 Wash. C. C. R. 708.....	299. A.
" ".....	4 Washington, 703.....	318. Opin.
Turner v. Winter.....	1 T. R. 602. [1 Am. & Eng. 43].....	96. 97. Wheat. App.
" ".....	1 Term Rep. 605. [1 Am. & Eng. 43].....	265, 555. A.
Tyler v. Tuel.....	6 Cranch, 324.....	102. Wheat. App.
United States v. Fisher.....	2 Cranch, 386, 399.....	60. A.
United States v. Liddle.....	2 Wash. C. C. Rep. 205.....	331. A.
Van Hook v. Wood.....	520. Dis. opin.
Vin. Abridg.....	Vol. 17, p. 151, Prerogative, etc., M. C. paragraphs 2, 3, 4, 6, 10, 14.....	295. A.
" ".....	Vol. 17, p. 114, Prerogative of the King, R. b. para- graph 9.....	295. A.
Watt's Patent.....	8 T. R. 95. [1 Am. & Eng. 98].....	139. A.
Webster's Patent Cases.....	477.....	517. Dis. opin.
Whitney v. Carter.....	Mr. Fessenden's Essay on the Law of Patents, 123.....	268. A.
Whitney v. Emmett.....	1 Bald. 303.....	425. A.
Whittemore v. Cutter.....	1 Gall. R. 429-478.....	100, 101, 102, 103, Wheat. App.
" ".....	318. Opin.
" ".....	1 Gall. 429.....	59, 60, 68, 126, 131, 156, 229, 263, 298. A.
Wilson v. Curtis & Grabon.....	520. Dis. opin.
Wilson v. Graham.....	4 Wash. C. C. R. 58.....	330. A.
Wilson v. Rousseau.....	535, 540, 547. Opin.
" ".....	538. S.

TABLE OF CITATIONS.

xvii

Citation.	Where reported.	Cited in this vol., page.
Wilson v. Turner.....	Taney, 278.....	507. Dis. opin.
Wood v. Zimmer.....	1 Holt's N. P. Rep. 58.	
	[1 Am. & Eng. 202]..	98, 97. Wheat. App.
" "	285. Opin.
" "1 Holt's N. P. Rep. 58.	
	[1 Am. & Eng. 202].....	229, 803. A.
Woodcock v. Parker.....	1 Gall. 438.....	100, 101. Wheat. App.
" "1 Gall. C. C. R. 438.....	121, 830. A.
Woodworth v. Parker.....	1 Gall. Rep. 439.....	131. A.
Woodworth v. Sherman....	8 Story, 171.....	520. Dis. opin.
Woodworth v. Cheever....	8 Story, 171.....	520. Dis. opin.
Wyeth v. Stone.....	1 Story's Rep. 287.....	527. Dis. opin.

TABLE OF ABBREVIATIONS

OF THE TITLES OF REPORTS AND WORKS OF LAW USED IN
THIS VOLUME.

-
- Abb. Pat. Law.—Abbott's Patent Laws.
 Adolph. & Ellis.—Adolphus & Ellis, England Q. B.
 Am. & Eng.—American & English Patent Cases.
 Am. L. J.—American Law Journal.
 Atk. Rep.—Atkyn's Reports, England, Chancery.
 Bac. Abr.—Bacon's Abridgment.
 Bald.—Baldwin, 8d Circuit.
 Ban. & Ard.—Banning & Arden.
 Barn. & Ald.—Barnwall & Alderson, England K. B.
 Barn. & Cressw.—Barnwall & Cresswell K. B.
 Biss.—Bissell, Circuit Ct.
 Black.—Black, Sup. Ct.
 Bl. Com.—Blackstone's Commentaries—Laws of England.
 Blatch.—Blatchford, U. S., 2d Circuit.
 Brock.—Brockenbrough, 4th Circuit.
 Bro. Ch. Rep.—Brown Chancery Report, England.
 Brunn. Coll. Cases.—Brunner's Collected Cases, Circuit Ct.
 Bull. N. P.—Bullers's Nisi Prius, England.
 Burr.—Burrow, England K. B.
 Car. L. R. (N. C).—Carolina Law Repository, N. C.
 Car. & Paine.—Carrington & Paine, N. P.
 C. C. MS.—Circuit Court Manuscript.
 Cliff.—Clifford, 1st Circuit.
 Co.—Coke.—England K. B.
 Cranch.—Cranch, U. S. Sup. Ct. R.
 Cro. Car.—Croke, Charles, England K. B.
 Cro. Eliz.—Croke, Elizabeth, England Q. B.
 Ct. of Clms.—Court of Claims.
 Curt. on Pats.—Curtis on Patents.
 Dall.—Dallas, Pennsylvania & U. S.
 Dane's Abridg.—Dane's Abridgment.
 Dav. Pat. Cases.—Davis, England.
 Day.—Day, Connecticut.
 Dev. & Bat. Eq., N. C. Rep.—Devereux & Battle's Equity, North Carolina Reps.
 D. & E.—Durnford & East, Term Reports.
 Dyer.—Dyer, England K. B.
 East's Rep.—East, England K. B.

Fed. Rep.—Federal Reporter.
Fish.—Fisher's Patent Cases.
Fish. Pat. Rep.—Fisher's Patent Reports.
Gall.—Gallison, 1st Circuit.
Gallis.—Gallison, 1st Circuit.
Godson.—Godson on Patents.
Grant's Chan. R.—Grant's Chancery Reports, Upper Canada.
Harris (Pa.)—Harris's Pennsylvania Reports.
Hawk. P. C.—Hawkins' Pleas of Crown.
H. Bl. Rep.—Henry Blackstone, England C. P.
Holmes.—Holmes, 1st Circuit.
Holt's N. P.—Holt's Nisi Prius, England.
How.—Howard, Sup. Ct. R.
Inst.—Coke's Institute, England.
Jenk. Cent.—Jenkins Century Report.
John. Ch. Rep.—Johnson, England, Chancery.
Jones.—Jones, Ireland, Exchequer.
Law Rep.—Law Reporter.
L. Ed.—Lawyers' Edition, Sup. Ct. R.
Ld. Raym.—Lord Raymond, England K. B.
Leg. Gaz. Rep.—Legal Gazette Report.
MacA. Pat. Cas.—MacArthur's Patent Cases.
McL.—McLean, 7th Circuit.
McLean.—McLean, 7th Circuit.
Marsh.—Marshall, England C. P.
Mason.—Mason, 1st Circuit.
Mass.—Massachusetts.
Meriv.—Merivale, England, Chancery.
Merwin.—Merwin on Patentability of Inventions.
Mod.—Modern, England K. B.
MS. D. C.—Manuscript Cases, District of Columbia.
Nat. Bank. Reg.—National Bankruptcy Register.
New Hampshire.—New Hampshire State Reports.
N. H. Rep.—New Hampshire Reports.
Noy.—Noy, England K. B.
O. G. Official Gazette of Patent Office.
Paine.—Paine, 2d Circuit.
Penn.—Pennsylvania Reports.
Penn. L. J.—Pennsylvania Law Journal.
Pet.—Peters, Sup. Ct.
Pet. C. C.—Peters, Circuit Ct.
Phill. Ev.—Phillips on Evidence.
Phillips.—Phillips on Patents.
Pitts. R.—Pittsburg Report.
Plowd.—Plowden, England K. B.
Rep.—The Reporter.
Robb.—Robb's Patent Cases.
Salk.—Salkeld, England K. B.
Saund.—Saunders, England K. B.

- Serg. & Rawle.—Sergeant & Rawle (Penn.) Rep.
Starkie.—England N. P.
Story.—Story, 1st Circuit.
Sumn.—Sumner, 1st Circuit.
Taney.—Taney, U. S., 4th Circuit.
Term Rep.—Term Reports, [Durnford & East], England.
T. R.—Term Reports, [Durnford & East], England.
U. S.—United States Sup. Ct. R.
U. S. L. J.—United States Law Journal.
Vent.—Ventriss, England K. B.
Ves.—Vesey, England Chancery.
Ves., Jr.—Vesey, Jr., England Chancery.
Ves. & Beames.—Vesey & Beames, England, Chancery.
Vin. Abr.—Viner's Abridgment, England.
Walker on Pats.—Walker on Patents.
Wall.—Wallace, Sup. Ct. R.
Wall., Jr.—Wallace, Jr., Circuit Ct.
Wash.—Washington, Circuit Court.
Web. P. C.—Webster's Patent Cases, England.
Wend.—Wendell, New York.
West. L. J.—Western Law Journal.
Wheat.—Wheaton, Sup. Ct.
Whit.—Whitman, Sup. Ct.
Wils.—Wilson, England K. B.
W. & M.—Woodbury & Minot.
Wood. & Minot.—Woodbury & Minot.
Woods.—Woods, 5th Circuit.

TABLE OF NAMES OF JUSTICES

WHOSE DECISIONS ARE REPORTED IN THIS VOLUME.

Mr. Justice Baldwin. *McClurg v. Kingsland*, p. 384.
 Mr. Justice Livingston. *Evans v. Eaton*, Dis. opin., p. 165.
 Mr. Justice McLean. *Stimpson v. West Chester R.R. Co.*, p. 427.
 ——— ——— ——— *Shaw v. Cooper*, p. 305.
 ——— ——— ——— *Wilson v. Rousseau*, Dis. opin., p. 498.
 Chief-Justice Marshall. *Grant v. Raymond*, p. 268.
 ——— ——— ——— *Evans v. Eaton*, p. 72.
 Mr. Justice Nelson. *Woodworth v. Wilson*, p. 547.
 ——— ——— ——— *Wilson v. Turner*, p. 540.
 ——— ——— ——— *Simpson v. Wilson*, p. 535.
 ——— ——— ——— *Wilson v. Rousseau*, p. 477.
 Mr. Justice Story. *P. & T. R. R. Co. v. Stimpson*, p. 337.
 ——— ——— ——— *Pennock v. Dialogue*, p. 229.
 ——— ——— ——— *Ex parte Wood & Brundage*, p. 198.
 ——— ——— ——— *Evans v. Hettich*, p. 193.
 ——— ——— ——— *Evans v. Eaton*, p. 156.
 Chief-Justice Taney. *Wood v. Underhill*, p. 555.
 ——— ——— ——— *Carver v. Hyde*, p. 372.
 ——— ——— ——— *Prouty v. Ruggles*, p. 354.
 Washington, Mr. Justice. *Evans v. Jordan*, p. 9.
 ——— ——— ——— *Evans v. Eaton*, p. 107.
 Mr. Justice Wayne. *Wilson v. Rousseau*, Dis. opin., p. 504.
 Woodbury, Mr. Justice. *Wilson v. Rousseau*, Dis. opin., p. 504.

TABLE OF NAMES OF COUNSEL

APPEARING IN CASES REPORTED IN THIS VOLUME.

Atty.-General, for Defendant. *Keplinger v. De Young*, p. 209.
 Mr. Bibb, for Defendants. *Woodworth v. Wilson*, p. 547.
 Mr. Choate, for Plaintiffs. *Prouty v. Ruggles*, p. 351.
 Mr. Cox, for Plaintiffs. *P. & T. R. R. Co. v. Stimpson*, p. 328.
 Franklin Dexter, for Defendants. *Prouty v. Ruggles*, p. 351.
 ——— ——— for Plaintiff. *Carver v. Hyde*, p. 372.

- Mr. Dunlap, for Plaintiffs. *McClurg v. Kingsland*, p. 384.
- Mr. Emmett, for Defendant. *Ex parte Wood & Brundage*, p. 198.
- — — for Defendant. *Shaw v. Cooper*, p. 293.
- — — for Defendants. *Shaw v. Cooper*, p. 300.
- Richard Fletcher, for Defendants. *Carver v. Hyde*, p. 372.
- Mr. Gilpin, for Defendants. *Simpson v. Wilson*, p. 535.
- Mr. Haines, for Plaintiffs. *Ex parte Wood & Brundage*, p. 198.
- Mr. Harper, for Plaintiff. *Evans v. Jordan*, p. 8.
- — — for Plaintiff. *Evans v. Eaton*, p. 69.
- — — for Plaintiff. *Evans v. Eaton*, p. 136.
- Mr. Henderson, for Plaintiff. *Simpson v. Wilson*, p. 535.
- Mr. Hopkinson, for Defendant. *Evans v. Eaton*, p. 62.
- Mr. Hubbard, for Defendant. *Tyler v. Tuel*, p. 2.
- C. J. Ingersoll, for Plaintiff. *Evans v. Eaton*, p. 58.
- — — for Plaintiff. *Evans v. Eaton*, p. 116.
- — — for Defendant. *P. & T. R. R. Co. v. Stimpson*, p. 330.
- — — for Plaintiff. *Stimpson v. West Chester R. R. Co.*, p. 414.
- J. R. Ingersoll, for Defendant. *P. & T. R. R. Co. v. Stimpson*, p. 328.
- — — for Plaintiff. *Stimpson v. West Chester R. R. Co.*, p. 414.
- R. Johnson, for Plaintiff. *Simpson v. Wilson*, p. 535.
- P. B. Key, for Defendants. *Evans v. Jordan*, p. 8.
- Mr. Latrobe, for Plaintiff. *Wilson v. Rousseau*, p. 476.
- — — for Complainants. *Woodworth v. Wilson*, p. 547.
- E. J. Lee, for Defendants. *Evans v. Jordan*, p. 8.
- Mr. Miles, for Defendants. *Stimpson v. West Chester R. R. Co.*, p. 414.
- Mr. Ogden, for Defendants. *Grant v. Raymond*, p. 255.
- Mr. Paine, for Plaintiff. *Shaw v. Cooper*, p. 293.
- Mr. Phelps, for Appellant. *Wilson v. Turner*, p. 539.
- Willard Phillips, for Defendants. *Carver v. Hyde*, p. 372.
- Rodney, Atty.-General, for Plaintiff. *Tyler v. Tuel*, p. 3.
- Mr. Rowley, for Defendants. *Wood v. Underhill*, p. 553.
- Leverett Saltonstall, for Defendants. *Carver v. Hyde*, p. 372.
- Mr. Sargeant, for Defendant. *Pennock v. Dialogue*, p. 222.
- Mr. Schley, for Appellees. *Wilson v. Turner*, p. 540.
- Mr. Sergeant, for Defendant. *Evans v. Eaton*, p. 122.
- — — for Defendant. *Evans v. Eaton*, p. 62.
- — — for Plaintiff. *Keplinger v. De Young*, p. 209.
- Mr. Seward, for Plaintiff. *Wilson v. Rousseau*, p. 476.
- Mr. Silliman, for Plaintiff. *Wood v. Underhill*, p. 553.
- Mr. Southard, for Plaintiffs. *P. & T. R. R. Co. v. Stimpson*, p. 328.
- Mr. Staples, for Complainants. *Woodworth v. Wilson*, p. 547.
- Mr. Stevens, for Defendants. *Wilson v. Rousseau*, p. 476.
- Mr. Webster, for Plaintiff. *Keplinger v. De Young*, p. 209.
- — — for Plaintiff. *Pennock v. Dialogue*, p. 219.
- — — for Defendants. *Grant v. Raymond*, p. 255.
- — — for Plaintiff. *Wilson v. Rousseau*, p. 476.
- — — for Appellant. *Wilson v. Turner*, p. 539.
- Mr. Westcott, for Defendants. *Simpson v. Wilson*, p. 535.

DECISIONS
OF
THE SUPREME COURT
OF
THE UNITED STATES
IN
PATENT CASES.

TYLER *et al.* v. TUEL.

6 Cranch, 824-827. Feb., 1810.

[Bk. 3, L. ed. 237 ; 1 Robb. 14 ; 1 Whit. 1.]

Assignee of part interest. Right of action.

1. Under Act Feb. 21, 1793, assignee of a part of a patent-right cannot maintain an action at law for its violation (p. 4).

THIS was a case certified from the Circuit Court of the District of Vermont.

Tyler and others, as assignees of Benjamin Tyler, the original patentee of an improvement in grist-mills, which he called the *wry-fly*, or side-wheel.

After a verdict for the plaintiffs, the judges of the court below, upon a motion in arrest of judgment, were divided in opinion upon the question "whether the plaintiffs, by their own showing, are legal assignees to maintain this action."

There were two counts in the declaration.

The first set forth the substance of the statutes upon the subject of patents for useful discoveries, the facts necessary to entitle the patentee to a patent for his invention, and

Argument of counsel.

the patent itself, together with the specification, dated February 20, 1800.

The averment of the assignment of the patent-right to the plaintiffs was in these words : “ And the plaintiffs further say, that the said Benjamin Tyler, afterward, to wit, on the 15th day of May, in the year last aforesaid, at said Claremont, by his certain deed of that date, by him signed, sealed, and to the plaintiffs then and there by the said Benjamin delivered, and ready to be shown to the court, did, in consideration of the sum of six thousand dollars, to him before that time by the plaintiffs paid, grant, bargain, sell, assign, and set over to the plaintiffs, their executors, administrators, and assigns, all the right, title, and privilege in, unto, and over the said improvement in the said patent described, and thereby vested in the said Benjamin, in any part of the United States, *excepting* in the counties of Chittenden, Addison, Rutland, and Windham, in the State of Vermont.”

The second count, omitting the recital of the statutes and of the patent, stated concisely the same facts. The averment of the assignment of the patent-right was as follows : “ And the said Benjamin Tyler, afterward, and before the expiration of the said fourteen years, to wit, at said Claremont, on the 15th day of May, in the year last aforesaid, by his certain deed of that date by him then and there signed, sealed, and to the plaintiffs delivered, assigned to the plaintiffs the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, in and throughout the United States, *excepting* in the counties of Chittenden, Addison, Rutland, and Windham, in the State of Vermont, as fully and amply as by said letters patent the said Benjamin Tyler was thereto entitled, and all his title and interest in and unto said improvement, *excepting* as aforesaid.”

Hubbard, for the defendant, contended that the assignment, being of *part* of the patent-right only, was not such as would authorize the assignees to maintain an action on the statute. Laws U. S., vol. 2, p. 202, §§ 4, 5.

Argument of counsel.

The fourth section of the act declares, "That it shall be lawful for any inventor, his executor or administrator, to assign *the* title and interest in the said invention, at any time, and *the* assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter *stand in the place of the original inventor*, both as to *right* and responsibility, and so the assignees of assigns to any degree."

The fifth section provides, "That if any person shall make, devise, and use, or sell the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or *assigns*, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum that shall be at least equal to three times the price for which the patentee has usually sold or licensed to other persons the use of the said invention; which may be recovered in an action on the case, founded on this act, in the Circuit Court of the United States, or any other court having competent jurisdiction."

It is evident from the whole purview of the statute, especially from the fourth, fifth, sixth, and tenth sections, that no person can be considered as an assignee, under the statute, who is not the assignee of the *whole* right of the original patentee.

Rodney, Attorney-General, contra.

Upon a motion in arrest of judgment, if the judges are divided the motion fails, and the judgment must be entered of course. It must follow the verdict, unless sufficient cause be shown to the contrary. [Lane v. Cotton] 1 Salk. 17; Ld. Raym. 271; [Chapman v. Lampshire] 3 Mod. 156.

If there can be no assignment but of the whole right, then the exception of particular counties is void, it being repugnant to the prior words and intention of the grant.

So if the jury find a fact inconsistent with a fact previously found, the latter fact shall be rejected. [Inkersalls v. Samms] Cro. Car. 130; 3 East; 6 Bac. Abr. 381;

Notes and Citations.

Plowd. 564 ; 1 Bl. Com. 89 ; [Baldwin's Case] 2 Co. 83 ; [Bulwer's Case] 8 Co. 56 ; [Cresswell v. Cokes] Dyer, 351 ; [Ld. Buckhurst v. Fenner] 1 Co. 3 ; 1 Vent. 521 ; [Kenson v. Reading] Cro. Eliz. 244.

The whole passed at law by the deed of assignment. The exceptions are in the nature of equitable assignments.

On a subsequent day, the court directed the following opinion to be certified to the Circuit Court for the District of Vermont, viz. :

It is the opinion of the court, that the plaintiffs, by their own showing, are not legal assignees to maintain this action in their own names, and that the judgment of the Circuit Court be

ARRESTED.

Note :

1. Aliter under Act 1836, § 14 ; Act 1870, § 59 ; R. S., § 4919.

Wilson v. Rousseau, 4 How. 646 [p. 436 *post*].

Gayler v. Wilder, 10 How. 477.

Moore v. Marsh, 7 Wall. 515.

Bill in equity :

Hayward v. Andrews, 106 U. S. 672.

Patent in suit :

No. Tyler, B. February 20, 1800. Grist-mill.

Citations :

IN SUPREME COURT OF UNITED STATES :

Moore v. Marsh, 1868. 7 Wall. 515 ; Bk. 19, L. ed. 37.

Notes and Citations.

IN CIRCUIT COURTS :

Whittemore v. Cutter, 1 Gall. 429 ; 1 Robb. 28.

Potter v. Holland, September, 1858. 4 Blatch. 206 ; 1 Fish. 327.

Meyer v. Bailey, May, 1875. 2 Ban. & Ard. 73 ; 8 O. G. 437.

IN STATE COURTS :

Holden v. Curtis, May, 1819. 2 New Hampshire, 61.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, p. 285.

Curt. on Pats., 4th ed., §§ 345, 346.

Statement of the case.

EVANS v. JORDAN AND MOREHEAD.

9 Cranch, 199-204. Feb., 1815.

[Bk. 3, L. ed. 704 ; 1 Robb. 57 ; 1 Whit. 3.]

Affirming *ibid.*, 1 Brock. 248.

Construction of special act.

1. An argument founded upon the hardship of a case is entitled to great weight in the construction of a statute, where the words are obscure, but not where expressed in plain and unambiguous language (p. 11).
2. Special Act 1808 for the relief of Oliver Evans construed not to authorize those who had erected his machinery in the interval between the expiration of his original patent and the special act to continue the use without liability, subsequent to the passage of the act (p. 12).

[TODD, J.—Absent.]

THIS was a case certified from the Circuit Court for the District of Virginia, in which the judges were divided in opinion upon the question whether, after the expiration of the original patent granted to Oliver Evans, a general right to use his discovery was not so vested in the public as to require and justify such a construction of the act, passed in January, 1808, entitled "An act for the relief of Oliver Evans," as to exempt from either single or treble damages the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent, and previous to the passage of the said act. The act (vol. 9, p. 20) authorizes the Secretary of State to issue letters patent to Oliver Evans, in the manner and form prescribed by the general Patent Law, granting to him for the term of fourteen years the exclusive right of making, using, and vend-

Argument of counsel.

ing for use the machinery in question : “ provided, that no person who may have heretofore paid the said Oliver Evans for license to use his said improvements shall be obliged to renew the said license, or be subject to damages for not renewing the same ; and provided also, that no person who *shall have* used the said improvements, *or have* erected the same for use, before the issuing of the said patent, shall be liable to damages *therefor*.”

Harper, for the plaintiff.

The former patent of the plaintiff having expired, Congress, in consideration of the particular circumstances of his case, authorized a new patent to issue for another term of fourteen years. Between the expiration of the old and the issuing of the new patent, the defendants had erected and used and continued to use the plaintiff's machinery in the manufacture of flour, contending that they were protected by the proviso of the act of January 21, 1808.

We contend that the proviso does not authorize them to continue the use of the machinery after the issuing of the new patent, but merely protects them from damages for *having* used and for *having* erected for use the machinery in question *prior* to the issuing of the new patent.

The second patent was intended to place Evans in the situation in which he would have been if the first patent had continued in force, except as to his right to damages for acts done in the intermediate time between the first and second patent. If the defendants chose to continue to use the machinery after the new patent, they were bound to pay for the right to use it.

E. J. Lee and P. B. Key, contra.

If the construction contended for on the other side be correct, the proviso was wholly useless, because the defendants needed no such protection. Evans could have no claim against them for acts done after his patent had expired and before the issuing of the new patent. The defendants had a full and perfect right to erect and use the machinery. A law to oblige them now to abandon their property, or to

Opinion of the court.

pay what Mr. Evans may choose to exact, is in the nature of an *ex post facto* law ; and although it may not be absolutely unconstitutional, yet is so far within the spirit of the Constitution that this court will not give such a construction to the proviso, if it can possibly be avoided. The proviso says that no person *who shall have erected the machinery for use* shall be liable to damages therefor. The defendants *had* erected the machinery for use, and are consequently not liable therefor. What can the proviso mean, unless to give those who are in the situation of the defendants the right to use their own machines, lawfully erected ? The inventions had become public property ; every one had a right to use them. Congress did not mean to take away that vested right from those who had availed themselves of it. To deprive a person of the *use* of his property is equivalent to depriving him of the property itself. Congress could not mean to do this. This court will give the act such an equitable construction as will give effect to the proviso.

Harper, in reply.

The words of the proviso are clear and explicit, and admit not of construction. The legislature may have supposed that the new patent, which was intended to be a continuation of the old one, might have subjected those who had already erected the machinery to damages, and intended to guard against them. It is not certain that under the law under which the patent issued this would not have been the effect ; but it is sufficient if the legislature supposed it would have been. We are not bound to show the motives of the legislature ; if their words are clear and explicit, there is no room for construction. The acts which are protected by the proviso are acts done *before* the issuing of the patent ; the opposite counsel contend that the legislature, when they said "*before*," meant *after*. The proviso is too plain to bear an argument.

[TODD, J.—Absent. March 4th.]

WASHINGTON, J., delivered the opinion of the court.

The question certified to this court by the Circuit Court

Opinion of the court.

for the District of Virginia, and upon which the opinion of this court is required, is, whether, after the expiration of the original patent granted to Oliver Evans, a general right to use his discovery was not so vested in the public as to require and justify such a construction of the act, passed in January, 1808, entitled "An act for the relief of Oliver Evans," as to exempt from either treble or single damages the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent, and previous to the passage of the said act.

The act—upon the construction of which the judges of the Circuit Court were opposed in opinion—directs a patent to be granted, in the form prescribed by law, to Oliver Evans for fourteen years, for the full and exclusive right of making, constructing, using, and vending to be used his invention, discovery, and improvements in the art of manufacturing flour and meal, and in the several machines which he has discovered, invented, improved, and applied to that purpose.

The *proviso* upon which the question arises is in the following words: "Provided, that no person who may have heretofore paid the said Oliver Evans for license to use the said improvements shall be obliged to renew said license, or be subject to damages for not renewing the same; and provided also, that no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages therefor."

The language of this last proviso is so precise, and so entirely free from all ambiguity, that it is difficult for any course of reasoning to shed light upon its meaning. It protects against any claim for damages which Evans might make, those who may have used his improvements, or who may have erected them for use, *prior to the issuing of his patent* under this law. The protection is limited to acts done prior to another act thereafter to be performed, to wit, the issuing of the patent. To extend it, by construction, to acts which might be done subsequent to the issuing

Opinion of the court.

of the patent, would be to make, not to interpret, the law.

The injustice of denying to the defendants the use of machinery which they had erected after the expiration of Evans's first patent, and prior to the passage of this law, has been strongly urged as a reason why the words of this proviso should be so construed as to have a prospective operation. But it should be recollected that the right of the plaintiff to recover damages for using his improvement after the issuing of the patent under this law, although it had been erected prior thereto, arises, not under this law, but under the general law of the 21st of February, 1793.* The provisos in this law profess to protect, against the operation of the general law, three classes of persons: those who had paid Evans for a license prior to the passage of the law; those who *may have used* his improvements, and those who *may have erected* them for use, before the issuing of the patent.

The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one. But the legislature have not thought proper to extend the protection of these provisos beyond the issuing of the patent under that law, and this court would transgress the limits of judicial power by an attempt to supply, by construction, this supposed omission of the legislature. The argument, founded upon the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction. But considerations of this nature can never sanction a construction at variance with the manifest meaning of the legislature, expressed in plain and unambiguous language.

The argument of the defendants' counsel—that, unless

* The fifth section of the act of 21st of February, 1793, which is the only section of that act which gives damages for violation of the patent-right, is repealed by the fourth section of the act of the 17th of April, 1800, vol. 5, p. 90, the third section of which act gives treble damages for the violation of any patent granted pursuant to that act, or the act of 1793.

Opinion of the court,

the construction they contend for be adopted, the proviso is senseless and inoperative—is susceptible of the same answer.

Whether the proviso was introduced from abundant caution, or from an opinion really entertained by the legislature that those who might have erected these improvements, or might have used them prior to the issuing of the patent, would be liable to damages for having done so, it is impossible for this court to say. It is not difficult, however, to imagine a state of things which might have afforded some ground for such an opinion.

Although this court has been informed that the judge who delivers this opinion knows that the former patent given to Evans had been adjudged to be void by the Circuit Court of Pennsylvania prior to the passage of this law, yet that fact is not recited in the law, nor does it appear that it was within the view of the legislature; and if that patent-right had expired by its own limitation, the legislature might well make it a condition of the new grant that the patentee should not disturb those who had violated the former patent. This idea was certainly in the mind of the legislature which passed the act of the 21st of February, 1793, which, after repealing the act of the 10th of April, 1790, preserves the rights of patentees under the repealed law only in relation to violations committed after the passage of the repealing law.

If the decision above mentioned was made known to the legislature, it is not impossible but that a doubt might have existed whether the patent was thereby rendered void *ab initio*, or from the time of rendering the judgment; and if the latter, then the proviso would afford a protection against all preceding violations. But, whatever might be the inducements with the legislature to limit the proviso under consideration, as we find it, this court cannot introduce a different proviso, totally at variance with it in language and intention.

It is the unanimous opinion of this court, that the act passed in January, 1808, entitled “An act for the relief of Oliver Evans,” ought not to be construed as to exempt from either treble or single damages the use, subsequent to

Notes and Citations.

the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent and previous to the passage of the said act. Which opinion is ordered to be certified to the Circuit Court for the District of Virginia.

Notes :

1. Rules as to construction of statutes.

Wilson v. Rousseau, 4 How. 646 [p. 436 *post*].

Brown v. Duchesne, 19 How. 183.

2. Special acts.

Evans v. Eaton, 3 Wheat. 454 [p. 16 *post*].

Bloomer v. McQuewan, 14 How. 539.

Patent in suit :

No. . . Evans, O. December 18, 1790. Hopper-boy.

OTHER SUITS ON SAME PATENT :

Evans v. Chambers, 1807. 2 Wash. 125 ; 1 Robb. 7.

Evans v. Weiss, 1813. 2 Wash. 342 ; 1 Robb. 10.

Evans v. Robinson, 1813. 1 Car. L. R. (N. C.) 209 ; 1 Brunn. Coll. Cases, 400.

Evans v. Jordan, 1813. 1 Brock. 248 ; 1 Robb. 20.

Evans v. Kremer, 1816. 1 Pet. C. C. 215 ; 1 Robb. 66.

Evans v. Eaton, 1816. 1 Pet. C. C. 322 ; 1 Robb. 68.

Evans v. Eaton, 1818. 3 Wash. 443 ; 1 Robb. 193.

Evans v. Eaton, 1818. 3 Wheat. 454 ; 1 Robb. 243 ; 1 Whit. 8.

Evans v. Hettich, 1818. 3 Wash. 408 ; 1 Robb. 166.

Evans v. Eaton, 1822. 7 Wheat. 356 ; 1 Robb. 336 ; 1 Whit. 48.

Evans v. Hettich, 1822. 7 Wheat. 453 ; 1 Robb. 417 ; 1 Whit. 104.

Citations :

IN SUPREME COURT OF UNITED STATES :

Bloomer *v.* McQuewan, Diss. Opin., December, 1852. 14 How.
560 ; Bk. 14, L. ed. 532.

IN CIRCUIT COURTS :

Washburn *v.* Gould, May, 1844. 3 Story, 122 ; 2 Robb. 206.
Blanchard *v.* Haynes, 1848. 6 West L. J. 82.
Day *v.* Union India Rubber Co., August, 1856. 3 Blatch. 495.
The Fire Extinguisher Case, July, 1884. 21 Fed. Rep. 40.

IN STATE COURTS :

Cross *v.* Huntley, January, 1835. 13 Wend. 385.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, p. 328.
Walker on Pats., 1883, p. 184.

This image shows a single page of white paper with horizontal blue or grey ruling lines. The lines are evenly spaced and run across the width of the page. There is no handwriting or printed text on the page. A small dark speck is visible near the top center.

Syllabus.

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EVANS v. EATON.

8 Wheat. 454-519. Feb., 1818.

[Bk. 4, L. ed 433; 1 Robb. 243; 1 Whit. 8]

Reversing *ibid.*, 1 Pet. C. C. 322.Same case, 7 Wheat. 356 [p. 105 *post*].

Evidence. Prior use. Particular patent construed. Construction of special act. Intention of Congress.

1. Under Act 1793, § 6, notice is submitted for a special plea, and is given only in order to offer special matter in evidence under the general issue (p. 72).
2. Evidence of special matter not specified in notice, held admissible, as it would be under a special plea. Evidence of prior use so admitted (p. 72).
3. Evidence that those engaged in such prior use had paid patentee for licenses is admissible (p. 73).
4. Where the words in a patent are ambiguous, the intention of the parties are entitled to great consideration in construing it (p. 74).
5. Doubted whether improvements on different machines could regularly be comprehended in the same patent, under the general patent law (p. 74).
6. Special Act 1808 for the relief of Oliver Evans construed (p. 75).
7. Patent granted Oliver Evans, December 18, 1790, for hopper-boy construed to be a grant of the general result of the whole machinery and of the improvements in each machine (p. 76).
8. The petition is a part of the patent (p. 77).
9. Congress can never be presumed to have decided in a general act that an individual is an author or inventor, the words of which do not render such a construction unavoidable (p. 79).
10. Under Act 1793, § 6, if the thing patented had been in use or described in some prior public work, judgment shall be rendered for defendant, and the patent declared void (p. 80).

Statement of the case.

11. The law presumes patentee's knowledge of prior public knowledge and use of his alleged invention (p. 80).
12. Evans's special act being engrafted on the general patent act, and the patent issued in pursuance of both, the court has jurisdiction under Act 1800, § 3, though between citizens of the same State (p. 83).

ERROR to the Circuit Court for the District of Pennsylvania.

In addition to the statement of the case, the following documents are material :

“ TO JAMES MADISON, ESQ., SECRETARY OF STATE.

The Petition of Oliver Evans, of the city of Philadelphia, a citizen of the United States, respectfully sheweth,

That your petitioner having discovered certain useful improvements, applicable to various purposes, but particularly to the art of manufacturing flour and meal, prays a patent for the same, agreeable to the act of congress, entitled, ‘An Act for the relief of Oliver Evans.’

The principles of these improvements consist,

1. In the subdivision of the grain, or any granulated or pulverized substance ; in elevating and conveying them from place to place, in small separate parcels ; in spreading, stirring, turning, and gathering them, by regular and constant motion, so as to subject them to artificial heat, the full action of the air to cool and dry the same when necessary, to avoid danger from fermentation, and to prevent insects from depositing their eggs during the operation of the manufacture.

2. In the application of the power which moves the mill, or other principal machine, to work any machinery which may be used to apply the said principles, or to perform the said operations by constant motion and continued rotation, to save expense and labor.

The machinery by him already invented, and used for applying the above principles, consists of an improved elevator, and an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier. For a particular explanation of the principles, and a description and application of the machines which he has so invented and discovered, he refers to the specifications and

Statement of the case.

drawings hereunto annexed ; and he is ready, if the Secretary of State shall deem it necessary, to deliver models of the said machines.

OLIVER EVANS.

DESCRIPTION

Of the several machines invented by Oliver Evans, and used in his improvement on the process of the art of manufacturing flour or meal from grain, and which are mentioned in his specification as applicable to other purposes.

No. 1.—THE ELEVATOR.

Plate vi. Fig. 1. AB, represents an elevator, for raising grain from the granary O, and conducting it by spouts into a number of different garnerers, as may be necessary, where a mill grinds separate parcels for toll, or pay. The upper pulley being set in motion, and the little gate A drawn, the buckets fill as they pass under the lower, and empty as they pass over the upper pulley, and discharge into a movable spout B, to be by it directed to any of the different garnerers.

Fig. 2. Part of the strap and bucket, showing how they are attached.

A, a bucket of sheet iron, formed from the plate 8, which is doubled up and riveted at the corners, and riveted to the strap.

B, a bucket made of tough wood, say willow, from the form 9, being bent at right angles, at e c, one side and bottom covered with leather, and fastened to the strap by a small strap of leather, passing through the main strap, and tacked to its sides.

C, a lesser bucket of wood, bottomed with leather, the strap forming one side of it.

D, a lesser bucket of sheet iron, formed from the plate 11, and riveted to the strap which forms one side of the bucket.

Fig. 6, the form of a gudgeon for the lower pulley.

7. The form of the gudgeons of the shaft of the upper pulley.

12. The form of the buckle for tightening the elevator strap.

Fig. 17, plate vii., represents an elevator applied to raise grain into a granary, from a wharf, &c., by a horse.

16, represents an elevator raising the meal in a grist-mill.

18, represents an elevator wrought by a man.

Plate viii. 35, 39, represents an elevator raising grain from the hold of a ship.

THE
R O U N D
MILL-WRIGHT & MILLER'S
G U I D E.

IN FIVE PARTS—EMBELLISHED WITH TWENTY FIVE PLATES.

CONTAINING,

PART I.—Mechanics and Hydraulics; shewing errors in the old, and establishing a new system of theories of water-mills, by which the power of mill-seats and the effects they will produce may be ascertained by calculation.

PART II.—Rules for applying the theories to practice; tables for proportioning mills to the power and fall of the water, and rules for finding pitch circles, with tables from 6 to 136 cogs.

PART III.—Directions for constructing and using all the authors patented improvements in mills.

PART IV.—The art of manufacturing meal and flour in all its parts, as practised by the most skilful millers in America.

PART V.—The Practical Mill-wright; containing instructions for building mills, with tables of their proportions suitable for all falls from three to thirty-six feet.

APPENDIX.

Containing rules for discovering new improvements—exemplified in improving the art of thrashing and cleaning grain, hulling rice, warming rooms, and venting smoke by chimneys, &c.



BY OLIVER EVANS, OF PHILADELPHIA.

PHILADELPHIA:

PRINTED FOR, AND SOLD BY THE AUTHOR, No. 215,
NORTH SECOND STREET.

1795.

PHOTO-GRAYURE CO NY

3. *Of the Hopper-boy.*

Fig. 12, plate VII, is a Hopper-boy ; which consists of a perpendicular shaft, AB, put in a slow motion, (not above 4 revolutions in a minute) carrying round with it the horizontal piece CD, which is called the arms, and set, on the under side, full of small inclining boards, called flights, so set as to gather the meal towards the centre, or spread it from the centre to that part of the arm which passes over the bolting hopper ; at which part, one board is set broad-side foremost, as E (called a sweeper) which drives the meal before it, and drops it into the hoppers HH, as the arms pass over them. The meal is generally let fall from the elevator, at the extremity of the arm, at D, where there is a sweeper, which drives the meal before it, trailing it in a circle the whole way round, so as to discharge nearly the whole of its load, by the time it returns to be loaded again : the flights then gather it towards the centre, from every part of the circle ; which would not be the case, if the sweepers did not lay it round ; but the meal would be gathered from only one side of the circle. These sweepers are screwed on the back of the arm, so that they may be raised or lowered, in order to make them discharge sooner or later, as necessary.

Fig. 12.
Of the
Hopper-boy

Sweepers,
their use.

The extreme flight of each and of the arms are put on with a screw passing through its centre, so that they may be turned to drive the meal outwards ; the use of which is, to spread the warm meal as it falls from the ele-

Art. 88.

a considerable distance, with a small descent. Where a motion is easily obtained from the water, it is to be preferred to that of working itself, it being easily stopped, is apt to be troublesome.

The Crain Spout is hung on a shaft to turn on pivots or a pin, so that it may turn every way, like a crane; into this spout the grain falls from the elevator, and, by turning, it can be directed into any garner. The spout is made to fit close, and play under a broad board, and the grain is let into it through the middle of this board, near the pin, so that it will always enter the spout. See it under B, fig. 1. L is a view of the under side of it, and M is a top view of it. The pin or shaft may reach down so low, that a man may stand on the floor and turn it by the handle x.

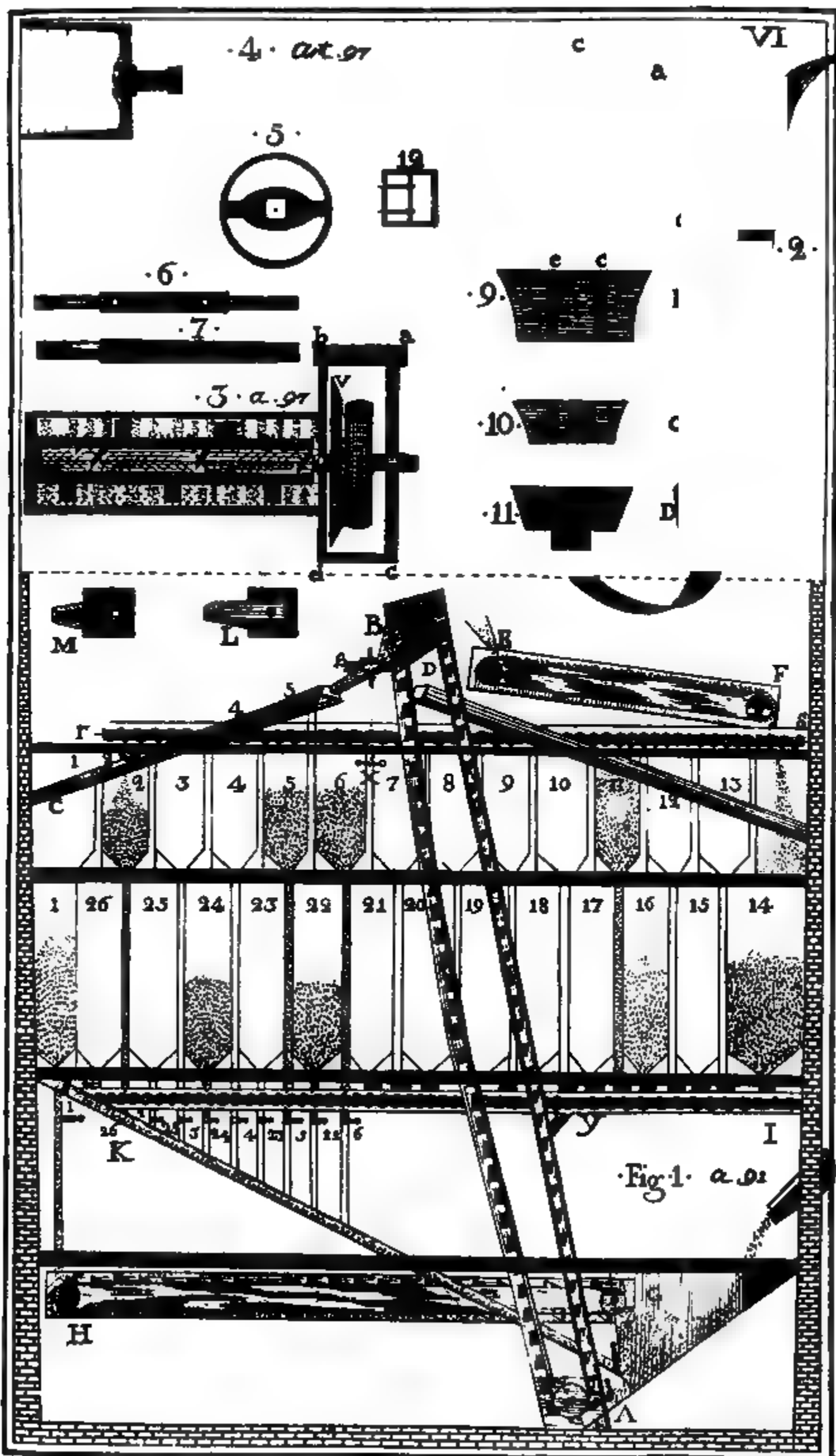
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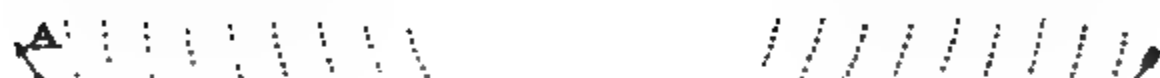
Art. 89.

APPLICATION OF THE MACHINES, IN THE PROCESS OF MANUFACTURING WHEAT INTO SUPERFINE FLOUR.

PLATE VIII, is not meant to shew the plan of a mill; but merely the Application and Use of the patented Machines.

PHOTO-GRAYURE CO. N.Y.





Evans' improved ~~mill~~ Mill

Statement of the case.

33, 34, represents an elevator raising meal from three pair of stones, in a flour mill, with all the improvements complete.

Plate ix. Fig. 1. CD represents an elevator raising grain from a wagon. E represents the movable spout, and manner of fixing it, so as to direct the grain into the different apartments.

Plate x. 2, 3, and 11, 12, represents elevators, applied to raise rice in a mill for hulling and cleaning rice.

The straps of elevators are best made of white harness leather.

No. II.—THE CONVEYOR.

Plate vi. Fig. 3, represents a conveyor, for conveying meal from the millstones into the elevator, stirring it to cool at the same operation, showing how the flights are set across the spiral line to change from the principle of an endless screw to that of a number of ploughs, which answer better for the purpose of moving meal, showing also the lifting flights set broadside foremost, and the manner of connecting it to the lower pulley of the elevator which turns it.

Fig. 4, gudgeon of the lower pulley of the elevator connected to the socket of the conveyor.

5. An end view of the socket, and the band which fastens it to the conveyor.

Plate viii. 37, 36, 4—represents a conveyor for conveying grain from a ship to the elevator 4—5, with a joint at 36, to let it rise and lower with the tide.

44—45. A conveyor, for conveying grain to different garners, from an elevator.

31—32. A conveyor, for conveying tail flour to the meal elevator, or the coarse flour to the eye of the stone.

Plate ix. Fig. 11, represents a conveyor for conveying the meal from two pair of stones, to the elevator connected to the pulley, which turns them both.

Plate x. 2—11, represents conveyors applied to convey rice, in a rice mill, from a boat or wagon to the elevator, or from the fan to an elevator.

No. III.—THE HOPPER-BOY.

Plate vii. Fig. 12, represents a hopper-boy, complete, for performing all the operations specified, except that only one arm is shown.

Statement of the case.

AB, the upright shaft ; CED, the arms, with flights and sweeps.

E, the sweeper to fill the bolting hoppers HH.

CFE, the brace or stay, for steadying the arms.

P, the pulley, and W, the weight, that is to balance the arms, to make them play lightly on the meal, and rise or fall, as the quantity increases or diminishes.

ML, the leader. N, the hitch stick, which can be moved along the leading line, to shorten or lengthen it.

Fig. 13. SSS, the arms turned bottom up, showing the flights and sweepers complete at one end ; and the lines on the other end show the mode for laying out for the flights, so as to have the right inclination and distance, according to the circle described by each, and so that the flights of one end may track between those of the other. The sweepers and the flights at each end of the arms are put on with a thumb screw, so that they may be moved, and so that these flights may be reversed, to drive meal outward from the centre, and at the same time trail it round the whole circle ; this is of use sometimes, when we wish to bolt one quantity which we have under the hopper-boy, without bolting that which we are grinding, and yet to spread that which we are grinding to dry and cool, laying round the hopper-boy, convenient to be shovelled under it, as soon as we wish to bolt it.

Fig. 15. The form of the pivot for the bottom of the upright shaft.

14. The plate put on the bottom of the shaft to rest on the shoulder of the pivot ; this plate is to prevent the arm from descending so low as to touch the floor.

Plate viii. Fig. 25, represents a hopper-boy attending two bolts in a mill, with all the improvements complete.

Plate ix. The hopper-boy is shown over QQ. Fig. 4 is the arm turned upside down, to show the flights and sweepers.

No. IV.—THE DRILL.

Plate vi. Fig. 1. HG represents a drill conveying grain from the different garners to the elevator, in a mill for grinding parcels for toll or pay.

Plate vii. Fig. 16. Bd. a drill, conveying meal from the stones in a grist-mill to the elevator.

The strap of this machine may be made broad, and the substance to be moved may be dropped on its upper surface, to be carried and dropped over the pulley at the other end ; in this case it requires

Statement of the case.

one bucket, like those of the elevator, to bring up any that may spill off the strap.

For full and complete directions for proportioning all the parts, constructing and using the above-described machines, see the book which I have published for that express purpose, entitled, *The Young Millwright and Miller's Guide*. See plate viii. representing a mill with three pair of mill-stones, with all the improvements complete, except the kiln-drier.

No. V.—THE KILN-DRIER.

Plate ix. [Probably Plate x., Fig. 1, is here referred to.—ED.] Fig. 2. A, the stove, which may be constructed simply of six plates, and inclosed by a brick wall lined with a mortar composed of pulverized charcoal and clay. B, the pipe for carrying off the smoke. CC, the air-pipes connecting the space between the stove and wall with the conveyor. DD, the pipes for the heated air to escape.

The air is admitted at the air-hole below, regulated by a register, as experience shall teach to be best, so as not to destroy the principle which causes the flour to ferment easily, and rise in the process of baking. The conveyors must be covered close; the meal admitted by small holes as it falls from the mill-stones.

OLIVER EVANS."

Witness, { Saml. H. Smith,
 { Jo. Gales, junr.

THE UNITED STATES OF AMERICA.

To all to whom these Letters-Patent shall come.

Whereas Oliver Evans, of the city of Philadelphia, a citizen of the United States, hath alleged that he hath invented a new and useful improvement in the art of manufacturing flour and meal, by means of certain machines, which he terms an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier; which machines are moved by the same power that moves the mill or other principal machinery, and in their operation subdivide any granulated or pulverized substance, elevate and carry the same from place to place in small and separate parcels, spread, stir, turn, and gather them by regular and constant motion, so as to subject them to artificial heat, and the

Statement of the case.

air to dry and cool when necessary ; a more particular and full description, in the words of the inventor, is hereby annexed in a schedule ; which improvement has not been known or used before his application—has affirmed that he does verily believe that he is the true inventor or discoverer of the said improvement, and, agreeably to the act of congress entitled, “ An act for the relief of Oliver Evans,” which authorizes the Secretary of State to secure to him by patent the exclusive right to the use of such improvement in the art of manufacturing flour and meal, and in the several machines which he has discovered, improved, and applied to that purpose ; he has paid into the Treasury of the United States, the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose : These are therefore to grant, according to law, to the said Oliver Evans, his heirs, administrators, or assigns, for the term of fourteen years, from the twenty-second day of January, 1808, the full and exclusive right and liberty of making, using, and vending to others to be used, the said improvement, a description whereof is given in the words of the said Oliver Evans himself, in the schedule hereto annexed, and is made a part of these presents.

In testimony whereof, I have caused these Letters to be made Patent, and the seal of the United States to be hereunto affixed.

[SEAL.] Given under my hand, at the city of Washington, this twenty-second day of January, in the year of our Lord, one thousand eight hundred and eight, and of the Independence of the United States of America, the thirty-second.

TH. JEFFERSON.

By the President,
JAMES MADISON, Secretary of State.

City of Washington, to wit :

I DO HEREBY CERTIFY, That the foregoing Letters-Patent were delivered to me on the twenty-second day of January, in the year of our

Statement of the case.

Lord, one thousand eight hundred and eight, to be examined ; that I have examined the same, and find them conformable to law. And I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit : on this twenty-second day of January, in the year aforesaid.

C. A. RODNEY, Attorney-General of the United States.

THE SCHEDULE.

Referred to these letters-patent, and making part of the same, containing a description, in the words of the said Oliver Evans, of his improvements in the art of manufacturing flour and meal.

“ My first principle is to elevate the meal as fast as it is ground, in small separate parcels, in continued succession and rotation, to fall on the cooling floor, to spread, stir, turn, and expose it to the action of the air, as much as possible, and to keep it in constant and continual motion, from the time it is ground until it be bolted ; this I do to give the air full action, to extract the superfluous moisture from the meal, while the heat generated by the friction of grinding, will repel and throw it off, and the more effectually dry and cool the meal, fit for bolting, in the course of the operation, and save time and expense to the miller. Also to avoid all danger from fermentation, by its lying warm in large quantities, as is usual ; and to prevent insects from depositing their eggs, which may breed the worms often found in good flour. And further to complete this principle, so as to dry the meal more effectually, and to cause the flour to keep sweet a longer space of time, I mean to increase the heat of the meal, as it falls ground from the millstones, by application of heated air ; that is to say, to kiln-dry the meal as it is ground, instead of kiln-drying the grain, as usual. The flour will be fairer and better than if made from kiln-dried grain, the skin of which is made so brittle that it pulverizes and mixes with the flour. This principle I apply by various machines which I have invented, constructed, and adapted to the purposes hereafter specified, numbered 1, 2, 3, 4, 5.

My second principle is to apply the power that moves the mill or other principal machine, to work my machinery, and by them to perform various operations which have always heretofore been per-

Statement of the case.

formed by manual force, and thus greatly to lessen the expense and labor of attending mills and other works.

The application of those principles, including that of kiln-drying the meal, during the process of manufacture, or otherwise to the improvement of the process of manufacturing flour, and for other purposes, is what I claim as my invention and improvement in the art, as not having been known or used before my discovery, knowing well that the principles once applied by one set of machinery, to produce the desired effect, others may be contrived and variously constructed and adapted to produce like effects in the application of the principles, but perhaps none to produce the desired effect more completely than those which I have invented and adapted to the purposes, and which are hereinafter specified.

No. 1. THE ELEVATOR. Its use is to elevate any grain, granulated or pulverized substances. Its use in the manufacture of flour or meal is to elevate the meal from the mill-stones, in small, separate parcels, and to let it fall through the air on the cooling floor as fast as it is ground. It consists of an endless strap, rope, or chain, with a number of small buckets attached thereto, set to revolve around two pulleys; one at the lowest, and the other at the highest point between which the substance is to be raised. These buckets fill as they turn under the lower, and empty themselves as they turn over the upper pulley. The whole is inclosed by cases of boards, to prevent waste.

No. 2. THE CONVEYOR. Its use is to convey any grain, granulated or pulverized substances, in a horizontal, ascending or descending direction. Its use in the progress of the art of manufacturing flour, is to convey the meal from the mill-stones, as it is ground, to the elevator, to be raised, and to keep the meal in constant motion, exposing it to the action of the air; also in some cases to convey the meal from the elevator to the bolting-hopper, and to cool and dry it fit for bolting, instead of the hopper-boy, No. 3; also to mix the flour after it is bolted; also to convey the grain from one machine to another, and, in this operation, to rub the impurities off the grain. It consists of an endless screw, set to revolve in a tube, or section of a tube, receiving the substance to be moved at one end, and delivering it at the other end; but for the purpose of conveying flour or meal, I construct it as follows: instead of making it a continued spiral, which forms an endless screw, I set small boards, called flights, at an angle crossing the spiral line; these flights operate like so many ploughs, following each other, moving

Statement of the case.

the meal from one end of the tube to the other with a continued motion, turning and exposing it to the action of the air, to be cooled and dried. Sometimes I set some of the flights to move broadside foremost, to lift the meal from one side to fall on the other, to expose it to the air more effectually.

No. 3. THE HOPPER-BOY. Its use is to spread any grain, granulated or pulverized substances, over a floor or even surface, to stir it and expose it to the air to dry and cool it; when necessary, and at the same time to gather it from the circumference of the circle it describes, to or near the centre, or to spread it from the centre to the circumference, and leave it in the place where we wish it to be delivered, when sufficiently operated on. Its use in the process of manufacturing flour, is to spread the meal as fast as it falls from the elevator over the cooling floor, on the area of a circle of from eight to sixteen feet, more or less, in diameter, according to the work of the mill, to stir and turn it continually, and to expose it to the action of the air to be dried and cooled, and to gather it into the bolting-hoppers, and to attend the same regularly. It consists of an upright shaft, made round at the lower end, about two thirds of its length, and set to revolve on a pivot in the centre of the cooling floor; through this shaft, say five feet from the floor, is put a piece called the leader, and the lower end of the shaft passes very loosely through a round hole in the centre of another piece called the arms, say from eight to sixteen feet in length; this last piece, revolving horizontally, describes the circle of the cooling floor, and is led round by a cord, the two ends of which are attached to the two ends of the arms, and passing through a hole at each end of the leader, so that the cord will reeve to pull each end of the arms equally. The weight of the arms is nearly balanced by a weight hung to a cord, which is attached to the arms, and passes over a pulley near to the upper end of the upright shaft, to cause the arms to play lightly, pressing with only part of their weight on the meal that may be under it. The foremost edges of the arms are sloped upward, to cause them to rise over and keep on the surface of the meal as the quantity increases; and if it be used separately and unconnected with the elevator, the meal may be thrown with shovels within its reach, while in motion, and it will spread it level, and rise over it until the heap be four feet high or more, which it will gather into the hoppers, always taking from the surface, after turning it to the air a great number of times. The underside of these arms are set with little inclining boards, called

Statement of the case.

flights, about four inches apart next the centre, and gradually closing to about two inches next the extremities, the flights of the one arm to track between those of the other, they operate like ploughs, and at every revolution of the machine they give the meal two turns toward the centre of the circle, near to which are generally the bolting-hoppers. At each extremity of the arms, there is a little board attached to the hindmost edge of the arm, to move side foremost; these are called sweepers; their use is to receive the meal as it falls from the elevator, and trail it round the circle described by the arms, that the flights may gather it toward the centre from every part of the circle; without these, this machine would not spread the meal over the whole area of the circle described by the arms. Other sweepers are attached to that part of the arms which pass over the bolting-hoppers, to sweep the meal into them.

But if the bolting-hoppers be near a wall and not in the centre of the cooling floor, then in this case the extremity of the arms are made to pass over them, and the meal from the elevator let fall near the centre of the machine, and the flights are reversed to turn the meal from the centre toward the circumference, and the sweepers will sweep it into the hoppers. Thus this machine receives the meal as it falls from the elevator on the cooling floor, spreads it over the floor, turns it twice over at every revolution, stirs and keeps it in continual motion, and gathers it at the same operation into the bolting-hoppers, and attends them regularly. If the bolting-reels are stopped, this machine spreads the meal and rises over it, receiving under it from one, two, to three hundred bushels of meal, until the bolts are set in motion again, when it gathers the meal into the hoppers, and as the heap diminishes, it follows it down until all is bolted. I claim as my invention, the peculiar properties or principles which this machine possesses, namely, the spreading, turning, and gathering the meal at one operation, and the rising and lowering of its arms by its motion, to accommodate itself to any quantity of meal it has to operate on.

No. 4. THE DRILL. Its use is to move any grain, granulated or pulverized substance, from one place to another. It consists, like the elevator, of an endless strap, rope, or chain, &c., with little rakes instead of buckets, (the whole cased with boards to prevent waste,) revolving round two pulleys or rollers. Its use in the process of the manufacture of flour, is to draw or rake the grain or meal from one part of the mill to another. It receives it at one pulley, and delivers it at the other, in a horizontal, ascending or descending

Statement of the case.

direction, and in some cases may be more conveniently applied for that purpose than the conveyor. I claim the exclusive right to the principles, and to all the machines above specified, and for all the uses and purposes specified, as not having been heretofore known or used before I discovered them. They may all be united and combined in one flour mill, to produce my improvement on the art of manufacturing flour complete, or they may be used separately for any purpose specified and allotted to them, or to produce my improvement, in part, according to the circumstances of the case.

No. 5. THE KILN-DRIER. To kiln-dry the meal after it is ground, and during the operation of the process of manufacturing flour, I take a close stove of any common form, and inclose it with a wall made of the best non-conductor of heat, leaving a small space between the stove and the wall, to admit air to be heated in its passage through this space. I set this stove below the conveyor, that conveys the meal from the mill-stones as ground, into the elevator, and I connect the space between the stove and the wall to the conveyor tube by a pipe entering near the elevator, and I cover the conveyor close, and set a tube to rise from the end of the conveyor tube near the mill-stones, for the heated air to ascend and escape as up a chimney. I make fire in the stove, and admit air at the bottom of the space between it and the wall around it, to be heated and pass along the conveyor tube, meeting the meal, which will be heated by the hot air; and the superfluous moisture will be more powerfully repelled and thrown off, and the meal will be dried and cooled as it passes through the operation of the elevator and hopper-boy. The flour will be fairer than if the grain had been kiln-dried, and it will keep longer sweet than flour not kiln-dried. I set all my machines in motion by the common means of cog and round tooth, and pinion straps, ropes, or chains, well known to every millwright.

Arrangement and Connection of the several Machines, so as to apply my Principles to produce my Improvements complete.

I fix a spout through the wall of the mill, for the grain to be emptied into from the wagoner's bag, to run into a box hung at the end of a scale-beam, to weigh a wagon-load at a draught. From this box it descends into the grain elevator, which raises it to a granary over the cleaning machines, and, as it passes through them, it may be directed into the same elevator to ascend to be cleaned a second time, and then descends into a granary, over the hopper of

Statement of the case.

the mill-stones to supply them regularly, and, as ground, it falls from the several pair of mill-stones into the conveyors, where it is dried by the heated air of the kiln-drier, and is conveyed into the meal elevator, to be raised and dropped on the cooling floor, within reach of the hopper-boy, which receives and spreads it over the whole area of the circle which it describes, stirring and turning it continually, and gathering it into the bolting-hoppers, which it attends regularly. That part of the flour which is not sufficiently bolted by the first operation, is conveyed by a conveyor or drill, into the elevator, to ascend with the meal to be bolted over again, and that of the meal which has not been sufficiently ground at the first operation, is conveyed by a conveyor or drill, and let run into the eye of the mill-stone to be ground over.

Thus the whole of the operation which used to be performed by manual labor, is, from the time the wheat is emptied from the wagoner's bag, or from the ship's measure, until it enters the bolts, and the manufacture be completed in the most perfect manner, performed by the machinery moved by the power which moves the mill, and this machinery keeps the meal in constant motion during the whole process, drying and cooling it more completely, avoiding all danger from fermentation, and preventing insects from depositing their eggs, and performing all the operations of grinding and bolting to much greater perfection, making the greatest possible quantity of the best quality of flour out of the grain, saving much time and labor and expense to the miller, and preventing much from being wasted by the motion of the machines being so slow as to cause none of the flour to rise in the form of dust, and be carried away by the air, and the cases of the machines being made close, prevents any from being lost."

OLIVER EVANS.

Witnesses { Samuel H. Smith,
 { Jo. Gales, Jun.

Washington County, District of Columbia, viz.:—

THIS 4th day of November, 1807, personally appeared before me, a justice of the peace in and for said county, Oliver Evans, who, being duly affirmed according to law, declares that he is a citizen of the United States, and that his usual place of residence is in the city of Philadelphia, and that he verily believes that he is the true

Statement of the case.

and original inventor of the improvements herein above specified, for which he solicits a patent.

OLIVER EVANS.

Affirmed before me,
SAM. H. SMITH.

This was an action brought by the plaintiff in error against the defendant in error, for an alleged infringement of the plaintiff's patent-right to the use of his improved *hopper-boy*, one of the several machines discovered, invented, improved, and applied by him to the art of manufacturing flour and meal, which patent was granted on the 22d January, 1808. The defendant pleaded the general issue, and gave the notice hereafter stated. The verdict was rendered, and judgment given thereupon for the defendant in the court below; on which the cause was brought, by writ of error, to this court.

At the trial in the court below, the plaintiff gave in evidence the several acts of Congress entitled, respectively, "An act to promote the progress of useful arts, and to re-

NOTE.—From a comparison of the foregoing specification with the drawings here reproduced from *The Young Millwright and Miller's Guide*, it appears highly probable that the latter are identical with those originally filed with the application for patent.—ED.

NOTE.—The Institute Journal, Vol. XCII., No. 1, of July, 1886, contains an article by Coleman Sellers, Jr., entitled "Oliver Evans and his Inventions," in which, f. 6, he says: "In 1786 Evans Owens applied to the Legislature of Pennsylvania for a right to use his improved machinery for making flour, and also to use his steam wagons on the roads of the State. The following year the Legislature granted his flour mill patent. . . . On May 21 the Legislature of Maryland granted both rights for fourteen years on the ground that, although it would doubtless do no good, yet it certainly could do no harm. . . ." A similar patent was subsequently granted (1789) by New Hampshire.

In 1790, when the United States Patent Office was organized, Evans relinquished his State rights, and December 18, 1790, a United States patent was granted for his "Method of Manufacturing Flour Meal." This is "said to be one of the three patents granted that year."

Also on f. II., Mr. Sellers continues: "In 1808 Congress passed a bill continuing his patent rights for twenty-two years." There is also a description of a hopper-boy on f. 7. It agrees quite closely with that in Evans's book as above.

F. T. CHAMBERS.

Statement of the case.

peal the acts heretofore made for that purpose ;” “ An act to extend the privilege of obtaining patents, for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define penalties for violating the rights of patentees ;” and “ An act for the relief of Oliver Evans ;” the said Oliver’s petition to the Secretary of State for a patent, and the patent thereupon granted to the said Oliver, dated the twenty-second day of January, in the year 1808 ; and further gave in evidence, that an agent for the plaintiff wrote a note to the defendant, in answer to which he called on the agent at Chambersburg, at the house of Jacob Snyder, on the 9th of August, 1813 ; there were a number of millers present ; the defendant then told the agent that he had got Mr. Evans’s book, a plate in the *Millwright’s Guide*, and if the agent would take forty dollars the defendant would give it him ; the defendant said that his hopper-boy was taken from a plate in Mr. Evans’s book ; he said he would give no more, alleging that the hundred dollars the agent asked was too much ; that the stream on which his mill was, was a small head of Conogocheage. The agent then declared that, if the defendant would not pay him by Monday morning, he would commence a suit in the Circuit Court.

The plaintiff further gave in evidence, that another agent for the plaintiff was in the defendant’s mill on the 2d of November, 1814, and saw a hopper-boy there, on the principles and construction of the plaintiff’s hopper-boy. This witness had heard that a right was obtained under Pennsylvania, but did not know of any rights under Pennsylvania sold by the plaintiff, and did not know that it was erected in any mill after the patent under Pennsylvania. The defendant’s hopper-boy had an upright shaft, with a leading arm, in the first place, and a large arm inserted with flights, and leading lines, and sweepers ; a little board for the purpose of sweeping the meal in the bolting hoppers, and spreading it over the floor ; a balance weight, to cause the arms to play up and down lightly over the meal. The leading arms are about five feet long, and seem to be in proportion, the arm about fourteen, and the length of the

Statement of the case.

sweep about nine inches. And the defendant, having previously given the plaintiff written notice that upon the trial of the cause the defendant would give in evidence, under the general issue, the following special matter,—to wit: “1st. That the improved hopper-boy, for which, *inter alia*, the plaintiff in his declaration alleges he has obtained a patent, was not originally discovered by the patentee, but had been in use anterior to the supposed discovery of the patentee, in sundry places, to wit, at the mill of George Fry and Jehu Hollingsworth, in Dauphin county, Pennsylvania; at Christian Stauffer’s mill, in Warwick township, Lancaster county, State of Pennsylvania; at Jacob Stauffer’s mill, in the same county; at Richard Downing’s mill, in Chester county, Pennsylvania; at Buffington’s mill, on the Brandywine; at Daniel Houston’s mill, in Lancaster county, Pennsylvania; at Henry Stauffer’s mill, in York county, Pennsylvania; and at Dihl’s mill, in the same county, or at some of the said places, and also at sundry other places in the said State of Pennsylvania, the State of Maryland, and elsewhere in the United States. 2d. That the patent given to the plaintiff, as he alleges in his declaration, is more extensive than his discovery or invention: for that certain parts of the machine in said patent, called an improved *hopper-boy*, and which the plaintiff claims as his invention and discovery, to wit, the upright shaft, arms, and flights, and sweeps, or some of them, and those parts by which the meal is spread, turned, and gathered at one operation, and also several other parts, were not originally invented and discovered by him, but were in use prior to his said supposed invention or discovery, to wit, at the places above mentioned, or some of them. 3d. That the said patent is also more extensive than the plaintiff’s invention or discovery: for that the application of the power that moves the mill or other principal machine to the hopper-boy is not an original invention or discovery of the plaintiff, but was in use anterior to his supposed invention or discovery, to wit, at the places above mentioned, or some of them. 4th. That the said patent is void, because it purports to give him an exclusive property.

Statement of the case.

in an improvement in the art of manufacturing meal by means of a certain machine termed an improved hopper-boy, of which the said plaintiff is not the original inventor or discoverer, parts of the machine in the description thereof referred to by the patent having been in use anterior to the plaintiff's said supposed discovery, to wit, at the places above mentioned, or some of them; and the said patent and description therein referred to contains no statement, specification, or description by which those parts, so used as aforesaid, may be distinguished from those of which the said plaintiff may have been the inventor or discoverer, protesting at the same time that he has not been the inventor or discoverer of any of the parts of the said machine.

5th. That the improved elevator described in the declaration, or referred to therein, was not originally discovered by the plaintiff, but was, anterior to his said supposed discovery or invention, described in certain public works, or books, to wit, in *Shaw's Travels*; in the first volume of the *Universal History*; in the first volume of *Mormer's Husbandry*; in *Ferguson's Mechanics*; in *Bossuet's Histoire des Mathematiques*; in *Wolf's Cours des Mathematiques*; in *Desagulier's Experimental Philosophy*, and in *Proney's Architecture Hydraulique*, or some of them.

6th. That the said patent is more extensive than the invention or discovery of the plaintiff, because certain parts of the machine called an improved elevator were, anterior to the plaintiff's said supposed invention or discovery, described in certain public works or books, to wit, the works or books above mentioned, or some of them; and that the said patent is void, because it neither contains nor refers to any specification or description by which the parts so before described in the said public works may be distinguished from those parts of which the plaintiff may be the inventor or discoverer, protesting, at the same time, that he has not been the inventor or discoverer of any of the parts of the said machine,"—gave in evidence the existence of hopper-boys, prior to the plaintiff's alleged discovery, at sundry mills in the State of Pennsylvania mentioned in the said notice; and further offered to give in evidence the existence

Statement of the case.

of hopper-boys, prior to the plaintiff's alleged discovery, at sundry other mills in the State of Pennsylvania not mentioned in the said notice ; and the counsel for the plaintiff objected to the admission of any evidence of the existence of hopper-boys in the said mills not mentioned in the said notice. But the court decided that such evidence was competent and legal. To which decision the counsel for the plaintiff excepted. The plaintiff, after the above evidence had been laid before the jury, offered further to give in evidence, that certain of the persons mentioned in the defendant's notice as having hopper-boys in their mills, and also certain of the persons not mentioned in the said notice, but of whom it has been shown by the defendant that they had hopper-boys in their mills, had, since the plaintiff's patent, paid the plaintiff for license to use his improved hopper-boy in the said mills respectively. But the counsel for the defendant objected to such evidence as incompetent and illegal, and the court refused to permit the same to be laid before the jury. To which decision the plaintiff's counsel excepted.

The court below charged the jury that the patent contained no grant of a right to the several machines, but was confined to the improvement in the art of manufacturing flour by means of those machines ; and that the plaintiff's claim must, therefore, be confined to the right granted, such as it was. That it had been contended that the schedule was part of the patent, and contained a claim to the invention of the peculiar properties and principles of the hopper-boy as well as the other machines. But the court was of opinion that the schedule is to be considered as part of the patent, so far as it is descriptive of the machines, but no farther ; and even if this claim had been contained in the body of the patent, it would have conferred no right which was not granted by that instrument.

The court further proceeded to instruct the jury that the law authorized the President to grant a patent for the exclusive right to make, construct, use, and vend to be used any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement in any

Statement of the case.

art, machine, &c., not known or used before the application. As to what constitutes an improvement, it is declared that it must be in the principle of the machine, and that a mere change in the form or proportions of any machine shall not be deemed a discovery. Previously to obtaining the patent, the applicant is required to swear or affirm that he verily believes that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent; and he must also deliver a written description of his invention, and of the manner of using it, so clearly and exactly as to distinguish the same from all other things before known, and to enable others skilled in art to construct and use the same. That from this short analysis of the law, the following rules might be deduced: 1st. That a patent may be for a new and useful art; but it must be practical; it must be applicable and referable to something by which it may be proved to be useful; a mere abstract principle cannot be appropriated by patent. 2d. The discovery must not only be useful, but *new*; it must not have been known or used before in any part of the world. It was contended, by the plaintiff's counsel, that the title of the patentee cannot be impeached, unless it be shown that he *knew* of a prior discovery of the same art, machine, &c.; and that *true* and *original* are synonymous terms in the intention of the legislature. But, as it was not pretended that those terms meant the same thing in common parlance, neither was it the intention of the legislature to use them as such. The first section of the law, referring to the allegations of the application for a patent, speaks of the discovery as something "not known or used before the application"; and in the sixth section it is declared that the defendant may give in evidence that the thing secured by patent was not *originally* discovered by the patentee, but had been in use, or had been described in some public work, *anterior* to the *supposed* discovery. 3d. If the discovery be of an improvement only, it must be an improvement in the principle of a machine, art, or manufacture before known or used; if only in the form or proportion, it has not the merit of a discovery which can entitle the

Statement of the case.

party to a patent. 4th. The grant can only be for the discovery as recited and described in the patent and specification. If the grantee is not the original discoverer of the art, machine, &c., for which the grant is made, the whole is void. Consequently, if the patent be for the whole of the machine, and the discovery were of an improvement, the patent is void. 5th. A machine or an improvement may be new, and the proper subject of a patent, though the parts of it were before known and in use. The combination, therefore, of old machines, to produce a new and useful result, is a discovery for which a patent may be granted.

The above principles would apply to most of the questions that had been discussed. It was strongly insisted upon, by the defendant's counsel, that this patent is broader than the discovery; the evidence proving that, in relation to the hopper-boy, for the using of which this suit is brought, the plaintiff can pretend to no discovery beyond that of an improvement in a machine known and used before the alleged discovery of the plaintiff. This argument proceeded upon the supposition that the plaintiff had obtained a patent for the hopper-boy, which was entirely a mistake. The patent was "for an improvement in the art of manufacturing flour," by means of a hopper-boy and four other machines described in the specification, and not for either of the machines so combined and used. That the plaintiff is the original discoverer of this improvement, was contested by no person, and, therefore, it could not, with truth, be alleged that the patent is broader than the discovery, or that the plaintiff could not support an action on this patent against any person who should use the whole discovery.

But could he recover against a person who had made or used one of the machines which in part constitutes the discovery? The plaintiff insisted that he could, because, having a right to the whole, he is necessarily entitled to the parts of which that whole is composed. Would it be seriously contended that a person might acquire a right to the exclusive use of a machine, because when used in combination with others a new and useful result is produced, which

Statement of the case.

he could not have acquired independent of that combination? If he could, then if A were proved to be the original inventor of the hopper-boy, B of the elevator, and so on as to the other machines, and either had obtained patents for their respective discoveries, or chose to abandon them to the public, the plaintiff, although it was obvious he could not have obtained separate patents for those machines, might nevertheless deprive the original inventors, in the first instance, and the public, in the latter, of their acknowledged right to use those discoveries, by obtaining a patent for an improvement consisting in a combination of those machines to produce a new result.

The court further charged the jury that it was not quite clear that this action could be maintained, although it was proved beyond all controversy that the plaintiff was the original inventor of this machine. The patent was the foundation of the action, and the gist of the action was the violation of a right which that instrument had conferred. But the exclusive right of the hopper-boy was not granted by this patent, although this particular machine constitutes a part of the improvement of which the plaintiff is the original inventor, and it is for this improvement, and this only, that the grant is made. If the grant, then, was not in this particular machine, could it be sufficient for the plaintiff to prove, in this action, that he was the original inventor of it?

Again, could the plaintiff have obtained a separate patent for the hopper-boy, in case he were the original inventor of it, without first swearing or affirming that he was the true inventor of that machine? Certainly not. Has the plaintiff then taken, or could he have taken, such an oath in this case? Most assuredly he could not; because the prescribed form of the oath is, that he is the inventor of the art, machine, or manufacture for which he solicits a patent. But since the patent which he solicited was not for the hopper-boy, but for an improvement in the manufacture of flour, he might, with safety, have taken the oath prescribed by law, although he knew at the time that he was not the true inventor of the hopper-boy; and thus it

Statement of the case.

would happen that he could indirectly obtain the benefit of a patent-right to the particular machine, which he could not directly have obtained without doing what, it must be admitted, in this case he had not done.

But this was not all. If the law had provided for fair and original discoverers a remedy when their rights are invaded by others, it had likewise provided corresponding protection to others, where he has not the merit. What judgment could the District Court have rendered upon a *scire facias* to repeal this patent, if it had appeared that the plaintiff was not the true and original inventor of the hopper-boy? Certainly not that which the law has prescribed, namely, the repeal of the patent; because it would be monstrous to vacate the whole patent, for an invention of which the patentee was the acknowledged inventor, because he was not the inventor of one of the constituent parts of the invention, for which no grant is made. But the court would have no alternative but to give such a judgment, or, in effect, to dismiss the *scire facias*; and if the latter, then the plaintiff would have beneficially the exclusive right to a machine which could not be impeached in the way prescribed by law, although it should be demonstrated that he was not either the true or the original inventor of it. And supposing the jury should be of opinion, and so find, that the plaintiff was not the original inventor of this machine, would not the court be prevented from declaring the patent void, under the provisions of the sixth section of the law, for the reason assigned why the District Court could not render judgment upon a *scire facias*? Indeed, it might well be doubted whether the defence now made by the defendant could be supported at all in this action, (if this action could be maintained,) inasmuch as the defendant cannot allege, in the words of the sixth section, *that the thing secured by patent* was not originally discovered by the patentee, since, in point of fact, the thing patented was originally discovered by the patentee, although the hopper-boy may not have been so discovered. But if this defence could not be made, did not that circumstance afford a strong argument against this action? If the plain-

Statement of the case.

tiff was not the inventor of the parts, he had no right to complain that they were used by others, if not in a way to infringe his right to their combined effect. If he was the original inventor of the parts which constitute the whole discovery, or any of them, he might have obtained a separate patent for each machine of which he was the original inventor.

Upon the whole, although the court gave no positive opinion upon this question, they stated that it was not to be concluded that this action could be supported, even if it were proved that the plaintiff was the original inventor of the hopper-boy. But if an action would lie upon this patent for violation of the plaintiff's right to the hopper-boy, still the plaintiff could not recover, if it had been shown to the satisfaction of the jury that he was not the original discoverer of that machine.

It appeared, by the testimony of the defendant's witnesses, that Stauffer's hopper-boy was in use many years before the alleged discovery of the plaintiff; that the two machines differed from each other very little in form, in principle, or in effect. They were both worked by the same power which works the mill; and they both stir, mix, cool, dry, and conduct the flour to the bolting-chest. Whether the flights and sweepers in the plaintiff's hopper-boy were preferable to the slips attached to the under part of the arm in Stauffer's, or whether, upon the whole, the former is a more perfect agent in the manufacture of flour than the latter, were questions which the court would not undertake to decide; because, unless the plaintiff was the original inventor of the hopper-boy, although he had obtained a separate patent for it, he could not recover in this action, however useful the improvement might be which he had made in that machine. If the plaintiff had obtained a patent for his hopper-boy, it would have been void, provided the jury should be of opinion, upon the evidence, that this discovery did not extend to the whole machine, but merely to an improvement on the principle of an old one, and if this should be their opinion in the present case, the plaintiff could not recover.

Statement of the case.

It had been contended, by the plaintiff's counsel, that the defendant, having offered to take a license from the plaintiff, if he would consent to reduce the price of it to forty dollars, he was not at liberty to deny that the plaintiff is the original inventor of this machine. This argument had no weight in it, not merely because the offer was rejected by the plaintiff's agent, and was, therefore, as if it had not been made, but because the law prevents the plaintiff from recovering, if it appear on the trial that he was not the original inventor. If the offer amounted to an acknowledgment that the plaintiff was the original inventor, (and further it could not go,) this might be used as evidence of that fact, but it would not entitle the plaintiff to a verdict if the fact proved to be otherwise.

The plaintiff's counsel had also strongly insisted that, under the equity of the tenth section of the law, the defence set up in this case ought not to be allowed after three years from the date of the patent. This argument might, perhaps, with some propriety, be addressed to the legislature, but was improperly urged to the court. The law had declared that in an action of this kind the defendant may plead the general issue, and give in evidence that the plaintiff was not the original inventor of the machine for which the patent was granted. The legislature has not thought proper to limit this defence in any manner ; and the court could not do it.

But what seemed to be conclusive of this point was, that the argument would tend to defeat altogether the provision of the sixth section, which authorizes this defence to be made ; for, if it could not be set up after three years from the date of the patent, it would be in the power of the patentee to avoid it altogether, by forbearing to bring suits until after the expiration of that period. And thus, although the law has carefully provided two modes of vacating a patent improvidently granted, the patentee, though not the original inventor, and however surreptitiously he may have obtained his patent, may secure his title to the exclusive use of another's invention, if he can for three years avoid an inquiry into the validity of his title.

Argument of counsel.

The last point was, that Stauffer's invention was abandoned, and, consequently, might be appropriated by the plaintiff. But if Stauffer was the original inventor of the hopper-boy, and chose not to take a patent for it, it became public property by his abandonment ; nor could any person obtain a patent for it, because no other person would be the original inventor.

To this charge the plaintiff's counsel excepted.

February 26. *Mr. C. J. Ingersoll, for the plaintiff,* premised, that this patent granted an exclusive right for fourteen years in the improvement in the art, by means of the five machines, and for the several machines ; the peculiar properties of each in its practical results, and the improvement of the art by the combination of the whole. The proof of this position is, that the defendant uses the precise machine, copied by the plaintiff's application, and offered to pay for it ; but they differed in price, which led to the contesting the originality of the plaintiff's invention.

1. It is said, in the charge of the court below, that the action is founded on the patent, which contains no grant of a right to the several machines, but is confined to the improvement in the art by means of those machines. The patent is to be made out in the manner and form prescribed by the general act. What are the manner and form ? By reciting the allegations and suggestions of the petition, giving a short description of the invention or discovery, and *thereupon* granting an exclusive right in the *said invention or discovery*. The manner and form of *these* letters patent are a recital of : 1st. The citizenship of the patentee. 2d. The allegations and suggestions of the petition, as to both the improvement and the machines in a short description, referring to the annexed schedule for one more full and particular, in the inventor's own words. 3d. That he has petitioned *agreeably to the special act*. 4th. A grant of the *said* improvement. The description must be short and *referential*. It must be a *description*. By the first section of the act of the 10th of April, 1790, ch. 34, it was to be described clearly, truly, and fully ; perhaps, because

Argument of counsel.

the board, constituted by that law, were to decide whether they deemed the discovery or invention sufficiently useful or important for letters patent. The patent, by express reference, adopts the special act *in extenso*. The connecting terms *which* and *said*, bind the whole to the granting clause; the allegations and suggestions *recited* are part of the grant; the machines are the means of *every* end, particular as well as general; nor can there be any practical result without them. To confine such a patent to one general result from a combination of the *whole* machines, nullifies it. It is never so in practice, and would operate infinite injustice in other cases. 2. But the schedule is part of the patent in *all* cases; in this case it is especially so. By the act of 1790, ch. 34, § 6, the patent *or specifications* are *prima facie* proof of everything which it is incumbent on the plaintiff to establish; and by the existing law, the specification is considered as explanatory of the terms used in the patent, so as to limit or enlarge the grant. *Whittemore v. Cutter*, 1 Gallis. 429. But it is said, in the grant, that the schedule annexed is made part of the patent. It is made so by the public agent, to avoid trouble, litigation, and unnecessary recitals. The petition, schedule, and description are all referred to, and incorporated with the patent. What does the law mean by a recital of allegations and suggestions? What more can a petitioner do than allege and suggest? He cannot shape or prescribe the manner and form of the grant. The charge denies that the schedule, at any rate, is more than *descriptive* of the machines, or that it would confer any right, even if claimed in the patent. But if no right would be conferred by insertion in the grant itself, what becomes of the argument which ascribes such potency to the grant? The charge says the grant can only be for the discovery *as recited and described* in the patent and *specification*. The grant is not for the parts, because it is for the whole; not in their rudiments or elements; not for wheels, cogs, or weights, nor for wood, iron, or leather; but for the peculiar properties, the new and useful practical results from each machine, and the vast improvements from their combination in this art.

Argument of counsel.

The charge supposes it impossible to obtain a patent for a hopper-boy, unless the plaintiff could swear that he invented that machine. But the oath is not a material, or at least not an indispensable, prerequisite. *Whittemore v. Cutter*, 1 Gallis. 433. 3. The special act for the relief of the plaintiff decides him to be the inventor of the machines and improvements for which he has obtained a patent. By the Constitution, art. 1, § 8, Congress have power to promote the progress of science and the useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries. This has been done by Congress in the instance of the plaintiff. The special act is an absolute grant to him, binding on all the community, and precluding any inquiry into the originality of the invention. It includes a monopoly in his invention, discovery, and improvements in the art, *and* in the several machines discovered, invented, improved, and applied for that purpose. The patent is to issue on a simple application in writing by the plaintiff, without any prerequisites of citizenship, oath, fee, or petition, specification, and description to be filed. The act of 1793, ch. 156, requires all these, and then grants a patent for *invention or discovery*; whereas this grant is for that, and for *improvements* in the art, *and* in the several machines. It is a remedial act, and should receive a liberal construction to effectuate the intentions of the legislature. *Whittemore v. Cutter*, 1 Gallis. 430. The patent is as broad as the law, if the grant be governed by the recital. Its construction is to be against the grantor, and according to the intent; nor is it to be avoided by subtle distinctions;—if there are two interpretations, the sensible one is to be adopted. *Jenk. Cent.* 138; *Eystor v. Studd*, *Plowd.* 467; *The United States v. Fisher*, 2 Cranch, 386, 399. 4. The improved hopper-boy of the plaintiff is the only new and useful discovery which was in evidence in the case. The court misconstrued the law in their charge in this respect, inasmuch as the true construction of it is not that the patentee shall be the first and original discoverer of a patentable thing, but “the true inventor” of such a thing; that such a thing was truly dis-

Argument of counsel.

covered and patented without knowledge of its prior use, or public employment, or existence ; more especially where, as in the present instance, the controversy is not between conflicting patents, but between the true patentee of a new and useful patentable thing, and a person defending himself against an infringement on the plea of its prior use by third persons who had no patent, and whose discovery, even if proved, was of a thing never in use or public existence, but in total disuse. The statute 21 Jac. 1, ch. 3, § 6, an. 1623, grants the monopoly “ of the sole working or making of any manner of new manufactures, within this realm, to the *true* and first inventor and inventors of such manufactures, which others, at the time of making such grant, shall not use,” &c. It is contended, under our law, that the *utility* is to be ascertained as well as the *originality* ; and that this, as well as that, is partly a question for the jury. The thing patentable must be *useful* as well as new. The *useful* thing *patented* prevails over one not useful nor patented, though in *previous* partial existence. This is not the case of conflicting patentees ; and to destroy this patent, the previous *use* must appear, there being no pretence of description in a *public* work. The title of the act is “ for the promotion of the *useful* arts.” The first section speaks of “ any new *and useful* arts,” not *known or used*, &c. The sixth, of that which “ had been *in use*, or described in some *public* work, anterior to the *supposed* discovery.” What degree of use does the law exact ?—a use *known* or described in a *public* work. Not merely an experimental, or essaying ; nor a clandestine, nor obscure use. It must be useful, and in use—perhaps in *known*, if not *public* use ; something equivalent to filing a specification on record. Now, here utility was lost sight of in search of novelty. It seemed to be taken for granted that proving the pre-existence of an unpatented hopper-boy defeated the plaintiff’s patent. The desuetude of the rival hopper-boy from inutility was established. The question was between a new and useful patented machine, and an useless and obsolete one never patented ; and which, not being *useful*, never could be patented. But that the patentee’s is useful,

Argument of counsel.

nobody questions. At all events, the question of fact, whether in use, should have been left to the jury. The jury are substituted for the *board* which, under the first law, was to decide whether the supposed invention was “sufficiently useful and important” for a patent. The court below suppose Stauffer to have given his discovery to the public. But it fell into disuse; there was nothing to give. Stauffer did not know its value; if he had abandoned a field with unknown treasure in the ground, could he afterward claim the treasure? Grotius de J. B., ac. Pl. 3, ch. 20, § 28. 5. The defendant’s testimony of the use of hopper-boys in mills not specified in his notice was erroneously admitted. The object of the provision in the sixth section of the Patent Law of 1793, ch. 156, was to simplify the proceedings, and to enable the defendant to give in evidence under his notice what he would otherwise be obliged to plead specially. The sufficiency of the notice is, therefore, to be tested by the rules of special pleading, which, though technical, are founded in good sense and natural justice, and are intended to put the adverse party on his guard as to what the other intends to rely upon in his defence. But such a notice as this could not answer that purpose. 6. The plaintiff’s testimony of the payment for licenses to use his improved hopper-boy ought not to have been rejected. It ought to have been admitted as circumstantial evidence entitled to some weight.

Mr. Hopkinson and Mr. Sergeant, contra.

1. The admissibility of evidence of the use of the hopper-boys anterior to the plaintiff’s alleged invention, in mills not specifically mentioned in the notice, depends upon the construction that may be given to the sixth section of the act of the 21st of February, 1793, ch. 156, taken in connection with the notice. This section is substituted for the sixth section of the act of the 10th of April, 1790, ch. 34. The office of the section, in each of these acts, is twofold: 1st. To state what shall constitute a defence. 2d. To state the manner in which the defendant may avail himself of it. And whatever difficulties may exist, if any there be, in the

Argument of counsel.

construction of the section, arise from the combination of this twofold object. That this was the object of the section is perfectly obvious. The general issue would be a denial of the allegation contemplated by the fifth section of the act of 1793 and the fourth of the act of 1790. If the acts had stopped there, it is manifest that the defendant could have had no defence but what was legally within the scope of the general issue. The tenth section would not have availed him, because the limitation of time and the grounds for repealing a patent upon a *scire facias* are totally different from those which ought to constitute a defence to the action. The patent may be opposed in an action upon the ground that the patentee is not the *original* inventor ; but it can be repealed only upon the ground that he is not the true inventor. Fraud (proof that it was surreptitiously obtained) is the necessary basis in the one case ; but error and mistake are equally available in the other. Neither could the defendant avail himself of the provisions in the prior part of the act ; for these are merely *directory*, and they terminate in the provision made by the fifth section, which would have been conclusive. The sixth section is, therefore, a proviso to the fifth. The sixth section of 1790, made the patent *prima facie* evidence only, which would have opened the inquiry as to the *truth* of the invention. It appears, then, that the object of the proviso was, in the first place, to settle what should constitute a defence. These matters would not have been within the scope of the general issue, by the rules of pleading. They would have presented the subject of a special plea in bar. The act, therefore, at the same time provides that they may be given in evidence under the general issue. The design, in this respect, was to save the necessity of special pleading on the one hand, and, on the other, to give a reasonable notice. Does the law require the *evidence* to be set out ? No ; and yet, if surprise is to be fully guarded against, this ought certainly to be stated, in order that the plaintiff may prove that it is false, or proceeds from corrupt witnesses, &c. Is it, then, necessary that *all the particulars* should be given—the State, county, township, town, street,

Argument of counsel.

square, number of the house? The law does not require it. What certainty, then, is required in the notice? The answer is obtained by ascertaining the use and intention of the section, which were to save the necessity of special pleading. What, then, must be alleged in a special plea? Not the evidence or facts, but the matter of defence, which may be that the plaintiff was not the true inventor, but that the invention was before his supposed discovery. You must state what is the ground and essence of the defence, and nothing more,—all else is surplusage: *e.g.*, that the plaintiff was not the true inventor of the hopper-boy, but the same was in use, prior to his supposed discovery, *at the mill of A*. Now, its being in use at *the mill of A* is not of the essence of the defence, for it is as good if used at *the mill of B*; the essence is, that it was used before. The defendant then would be entitled to lay the place under a videlicet, and of course would not be obliged to prove it, but might prove any other. If, then, the law did not mean to increase the difficulty of the defendant, the same may not be done in a notice. Consider the inconveniences of a contrary practice. A machine has been used in a foreign country; the country, town, and place may be *unknown*. Shall I, therefore, be deprived of the benefit of my invention? Again, *it is known*. I am bound to give thirty days' notice before trial, and no more. *Cui bono* that I should mention a town or place in England? The intention is, that the plaintiff shall come prepared to prove where his invention was made, and not to disprove the defendant's evidence; that he shall have notice of the *kind* of defence intended, in order that he may shape his case accordingly. If notice is given that the defendant will give in evidence that the plaintiff's machine was used before his supposed discovery, this is notice of special matter tending to prove that it was not invented by him. The law does not require a *statement* or *description* of the special matter, but notice that special matter will be given in evidence tending to prove certain facts. There is no reciprocity in the contrary rule. The declaration is general; it does not specify the *date* of the invention, the *place* of the invention, nor the

Argument of counsel.

evidence or *facts* by which the originality and truth of the invention are to be proved. Yet these are all extremely important to the defendant, to enable him to prepare this defence. As to the breach, it is equally general. It does not state the *time*, except as a mere matter of form, by which the plaintiff is not bound. It does not state the *place*, except by the very liberal description necessary for the venue, but which is not at all binding. And, finally, the rule contended for is impracticable, consistently with the purposes of justice; for it may, without any fault of the defendant, deprive him of the benefit of a perfectly good defence, upon a mere requisition of form which he cannot possibly comply with. The notice states the use of the hopper-boy at a number of mills, specially described by the State, county, and the name of the proprietor, "and at sundry other places in the said State of Pennsylvania, the State of Maryland, and elsewhere in the United States." It is not alleged, nor could it be, that the defendant had the knowledge that would have enabled him to extend the specification. Nor is it alleged that he could have acquired the knowledge, by any exertion he might have made; on the contrary, the course he has taken is indicative of perfectly fair intention. The exception is, that the defendant was permitted to give evidence that the hopper-boy "had been used at sundry other mills in Pennsylvania," precisely in the words of the notice. To sustain this exception, then, the court must decide that this cannot, in *any case*, be done. But if it cannot be shown that in a single supposable case this would work injustice, and defeat the law, it is sufficient. Now, it is very clear that in many cases this may be precisely the state of the party's knowledge, and all he can obtain, and it may be precisely the state of the *evidence*. Suppose a witness should know that hopper-boys were used in sundry mills, but not their precise local situation, name of owner, &c. Or, suppose he should have seen a hopper-boy that bore the most evident marks of having been *used* in a mill, or mills. The *effect* of such evidence is quite another question. Its competency and relevancy are for the court; its credibility and the inferences of fact that are to be

Argument of counsel.

made from it are for the jury. The same supposition would apply to its having been described in a public work. Is it necessary to give the title of the book, name of the author, and number of the edition? This may be impracticable. The defendant may have a witness who has seen the thing in use in a *foreign* country, and not be able to give a single particular; or who has seen it described in a foreign work, of which he can give no further account. Such evidence, if *credited*, would be entirely conclusive; and yet he could have no benefit of it, because he had not done what was impossible. But even if the witness knows all these particulars, the defendant has no means of compelling him to disclose them before the trial. The rules of pleading aim to establish a convenient certainty on the record, by giving the party notice of what is alleged, and furnishing evidence of what has been decided. In many instances, they fall short of this, their avowed design; in none do they go beyond it. For the purpose of preventing surprise, they are wholly ineffectual; they give no notice of particular facts, of evidence, of witnesses. The corrective of the evil, if evil there be, is to be found in the exercise of the general superintending authority of the court, applied to cases where there may really be surprise or fraud. So in this case; if there really had been surprise, (fraud is out of the question,) the court had the power to grant a new trial. This power is an amply sufficient corrective, and its existence affords a decisive answer to the argument drawn from the possible injustice that may be done. 2. The exception to the refusal to admit evidence of the payment for the use of licenses will be easily disposed of. The *fact* to be established on the one side, and disapproved on the other, was, that the hopper-boy was in use before the alleged invention or discovery of Evans. The evidence offered had no bearing whatever upon the question of fact. If believed, it went no farther than to show that those who had paid thought it best to pay,—a decision that might be equally prudent, whether the fact was or was not as alleged. Such testimony would be more objectionable than the opinion of the witness; for it would be only presumptive proof of opinion,

Argument of counsel.

without the possibility of examining its grounds. As *opinion*, it would be inadmissible ; as evidence of opinion, it would still be more objectionable. 3. The plaintiff's patent can only be considered in one of three points of view : 1st. As a patent for the improvement in the art of manufacturing flour ; that is, for the combination. 2d. As a patent for the combination, and also for the several machines ; that is, a joint and several patent. 3d. As a patent simply for the several machines. It is very clear that the patent itself is for the combination only ; though it is equally clear that, by the terms of the law, he might have obtained a patent for the *whole*, and also for the *several parts*. That this is the necessary construction of the patent, is plain from the patent itself, taken in connection with the act of 21st. of January, 1808, ch. 117. The act authorizes a patent to be issued for his *improvements* in the art of manufacturing flour, *and* in the several machines, &c. The matters are plainly different. They are the subject of distinct patents, to be obtained in the "*manner and form*" prescribed by the act of 1793, ch. 156. The object of the special act was to put Evans upon the same footing as if his former patent had not been issued ; but it did not mean to dispense with any of the requisites of the general law. With the general requisite, that he was the inventor, it could not dispense ; the Constitution did not permit it. By the general law, *improvement in an art* and *improvement in a machine* are distinct patentable objects. This patent is only for the improvement in the art of manufacturing flour, and the recital of the special act and the words "which" and "said" do not at all help it. It is true, it is an improvement operated by means of the machines, but not exclusively. The result may be secured without securing the means. This patent was granted to the plaintiff, was received by him, and must be presumed to be according to his application and his oath. The oath is, that he is the true inventor of the "*improvements* above specified," which *term* is applied in the specification, as in the patent, only to the *art*. But it is said the specification is a part of the patent, and limits or enlarges it, as the case may be.

Argument of counsel.

Mr. Justice STORY, in the case which has been cited, only says that the specification may control the generality of the patent. *Whittemore v. Cutter*, 1 Gallis. 437. But the specification in the case now before the court does not claim the machines. If the patent was for a combination, the plaintiff's action was gone; he could not maintain it against a person using one of the machines. If the patent was for the combination and also for the several machines, that is, a joint and several patent, then the patentee might proceed upon it as the one or the other, according to the nature of the alleged invasion. If he proceed upon it for a breach of the right to the combination, he must show the originality of invention, and might be defeated by opposite proof. If for a breach of the right to any one of the machines, he might be defeated by showing that he was not the original inventor of the machine. So if it be considered a several patent—that is, as if he had five distinct patents. But in no conceivable case can he stand upon any but one of these three grounds, nor claim to have the benefit of a larger, or even of a different, patent. 4. From this analysis, which is necessary to prevent confusion, we come to inquire into the nature of the case presented to the court for decision, and to which the charge was to be applied, premising: 1st. That no exception can be taken to what the court did not give in charge to the jury; and, 2d. That no exception can be taken to an opinion, however erroneous, that had no bearing upon the issue to be decided by the jury. It is apparent from the record that the action of the plaintiff was founded upon the alleged use, by the defendant, of a machine called a hopper-boy, of which the plaintiff claimed to be the inventor; that the evidence on both sides applied to this allegation, and to this alone,—the plaintiff claiming to be the inventor, and the defendant denying it. The charge of the court noticed the several arguments that had been used at the bar, and examined the general question as to the character of the patent; upon which, however, as it had not been discussed, no opinion was given. This is clear; for if an *opinion* had been expressed, it must have been that the action was not main-

Argument of counsel.

tainable. Nothing short of *that* would have been material. But the court left the case to the jury, as of an action that this was maintainable, and instructed them as to the principles by which it was to be decided, which negatives the conclusion of any opinion having been given that the action was not maintainable. If the defendant had required the court to charge that the action was not maintainable, and they had charged that it was, or declined to charge at all, he would have had ground of exception. But the plaintiff cannot complain, because he has what is equivalent to a decision in his favor. 5. The statute of James, (21 Jac. I., c. 3,) A. D. 1623, confined monopolies to the first and true inventors of manufactures not known or used before. One hundred and seventy years had elapsed when our act passed; commerce and the arts had made such advances, such facilities had been created for the diffusion of knowledge, that everything known by use, or described in books, might be considered as common property. It would have been strange to adopt a different principle. The act of Congress does not. It is a mistake to suppose there is in this respect any difference between the act of Congress and the act of Parliament. One says "useful" inventions, the other "new and useful"; but both have the expression "not used or known before." A patent can only be upon an allegation that the applicant has invented something *new* and *useful*. Its *novelty* may certainly be questioned; perhaps its *usefulness*. But where the defence is that the thing was known or used before, is it necessary to prove the usefulness of the thing so known or used? The act does not require it; nor is there any good reason why the patentee should be permitted to controvert it.

Mr. Harper, in reply, insisted: 1. That the court below had erred in admitting testimony of the use of the plaintiff's machine in mills not specified in the notice. The statute was not framed with a view to the benefit of the defendant alone. The notice to be given is not that vague, indistinct, general notice which is set up on the other side. It must be an effectual, useful notice,—such a notice as may put the

Argument of counsel.

patentee on his guard, and enable him to see what are the precise grounds of defence. It must be more specific than a mere transcript of the particular class of grounds of defence, such as suppression of parts, redundancy, &c. The circumstances of the *time*, the *place* when and where used, and by what *persons*, are essentially necessary, in order to enable the patentee to meet the defence. The burden of proof is, in effect, thrown upon the patentee; and the law intended that he should meet it fairly. Such a notice as that given in this case would not be good, if put into the form of a special plea. The degree of certainty required in a plea, in a statement of the *time* and *place*, when and where material facts have happened, is one of the most difficult questions of the law; but these circumstances must always be laid, and must be proved as laid, whenever it is essential to enable the other party to maintain his case. There is a distinction between the *matter of defence* and the *evidence* by which it is to be maintained. A notice of the particulars of the evidence is not required, but of the time and place where the former use of the machine in question occurred. Nor is this unreasonable; for it is highly improbable that anybody would be able to testify as to the minute particulars of an invention, without being able to remember in what work he had seen it described, or to state in what place and at what time he had seen it used. 2. The special act for the plaintiff's relief is a distinct, substantive, independent grant, declaring the plaintiff to be the original inventor, and as such entitled to a patent. It contains no reference to the general Patent Law, nor does it reserve any right in others to contest the originality of his invention. The defendant, therefore, cannot say that the plaintiff is not the inventor, though he may deny that he has violated the plaintiff's rights as inventor. Congress is not confined by the Constitution to any particular mode of determining the fact who are inventors or authors. It is true, a patent or copyright can only be granted to an inventor or author; but the originality of the invention or authorship may be determined by Congress itself, upon such testimony as it deems sufficient; or by an administrative act, by the deci-

Argument of counsel.

sion of some board or executive officer ; or, lastly, by a judicial investigation,—according as the legislative will may prescribe either of these several modes. The act of Parliament, 15 Geo. 3, for the relief of Watt and Boulton, the inventors of the improved steam-engine, and extending the term of their patent for twenty-five years, contained an express provision that every objection in law competent against the patent should be competent against the act, “ to all intents and purposes, *except so far as relates to the term thereby granted.*” *Hornblower v. Boulton*, 8 T. R. 95-97 [1 Am. & Eng. 98]. The act of Congress for the relief of Oliver Evans contains no such provision. The conclusion, therefore, is, that the legislature meant to *quiet* him in his claim, after he had so long enjoyed it, and in consideration of his peculiar merits, and of his former patent having been vacated for informality. 3. The court below instructed the jury that the patent was not for any one machine, but for the combined effect of the whole ; though they concluded by leaving it upon the prior use, still the intimation that the action could not be maintained, even though the prior use of it was not proved, did not leave the fact to the jury free from bias. Though not a positive direction to the jury to find for the defendant, it had the effect of a nonsuit. The *wishes* of the grantee and the *intention* of the grantor, both extended as well to a patent for the several machines as to a patent for the combined effect of the whole. The word “improvement,” though in the singular number, extends not only to the plaintiff’s improvement in the art of manufacturing flour, but to his improvement in the several machines by means of which the operations of the art are conducted. This was a patent for an *improvement* on the particular machine in question, and not for its original invention. In this respect it is like that of Watt and Boulton for their improvement on the steam-engine. 4. The prior use, which is to defeat a patent, ought to be a *public* use. The defence here set up under the sixth section of the Patent Law of 1793, ch. 156, was, that the patentee was not the original discoverer, and that the thing had been in use, &c. But how else could it be

Opinion of the court.

shown that he was not the discoverer, but by showing that it had before been in *public* use? A mere secret, furtive use would not disprove the fact of his being the original discoverer. If this were so, then the art of printing and gunpowder were not invented in Europe, because they had been before used in a sequestered corner of the globe like China. But there is a distinction between a *first* discovery and an *original* discovery. The art of printing was *originally* discovered in Germany, though it was *first* invented in China. So the plaintiff would not cease to be the original inventor of the hopper-boy, even if it had been proved that another similar machine had been before privately used in a single mill. It ought, therefore, to have been left to the jury to find for the plaintiff, if they believed that the use was a secret use.

MARSHALL, C. J., delivered the opinion of the court.

In this case exceptions were taken in the Circuit Court by the counsel for the plaintiff in error.

1st. To the opinion of the court in admitting testimony offered by the defendant in that court.

2d. To its opinion in rejecting testimony offered by the plaintiff in that court.

3d. To the charge delivered by the judge to the jury.

Under the sixth section of the act for the promotion of useful arts, and to repeal the act heretofore made for that purpose, the defendant pleaded the general issue, and gave notice that he would prove at the trial that the improved hopper-boy, for the use of which, without license, this suit was instituted, had been used previous to the alleged invention of the said Evans, in several places, (which were specified in the notice,) or in some of them, "and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States." Having given evidence as to some of the places specified in the notice, the defendant offered evidence as to some other places not specified. This evidence was objected to by the plaintiff, but admitted by the court; to which admission the plaintiff's counsel excepted.

The sixth section of the act appears to be drawn on the

Opinion of the court.

idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading, when it allows him to give in evidence matter which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of this privilege. Reasoning merely on the words directing this notice, it might be difficult to define, with absolute precision, what it ought to include, and what it might omit. There are, however, circumstances in the act which may have some influence on this point. It has been already observed, that the notice is submitted for a special plea ; it is farther to be observed, that it is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. If, then, the defendant may give in evidence on a special plea the prior use of the machine at places not specified in his plea, it would seem to follow that he may give in evidence its use at places not specified in his notice. It is not believed that a plea would be defective, which did not state the mills in which the machinery alleged to be previously used was placed.

But there is still another view of this subject which deserves to be considered. The section which directs this notice, also directs that if the special matter stated in the section be proved, "judgment shall be rendered for the defendant with costs, and the patent shall be declared void." The notice might be intended not only for the information of the plaintiff, but for the purpose of spreading on the record the cause for which the patent was avoided. This object is accomplished by a notice which specifies the particular matter to be proved. The ordinary powers of the court are sufficient to prevent, and will, undoubtedly, be so exercised as to prevent, the patentee from being injured by the surprise.

This testimony having been admitted, the plaintiff offered

Opinion of the court.

to prove that the persons of whose prior use of the improved hopper-boy the defendant had given testimony, had paid the plaintiff for license to use his improved hopper-boy in their mills since his patent. This testimony was rejected by the court, on the motion of the defendant, and to this opinion of the court, also, the plaintiff excepted.

The testimony offered by the plaintiff was entitled to very little weight, but ought not to have been absolutely rejected. Connected with other testimony, and under some circumstances, even the opinion of a party may be worth something. It is, therefore, in such a case as this, deemed more safe to permit it to go to the jury, subject as all testimony is to the animadversion of the court, than entirely to exclude it.

We come next to consider the charge delivered to the jury.

The errors alleged in this charge may be considered under two heads :

1st. In construing the patent to be solely for the general result produced by the combination of all the machinery, and not for the several improved machines, as well as for the general result.

2d. That the jury must find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the invention of the improvement thereon by Oliver Evans.

The construction of the patent must certainly depend on the words of the instrument. But where, as in this case, the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit us to explore, are entitled to great consideration. But before we proceed to this investigation, it may not be improper to notice the extent of the authority under which this grant was issued.

The authority of the executive to make this grant is derived from the general Patent Law, and from the act for the relief of Oliver Evans. On the general Patent Law alone, a doubt might well arise, whether improvements on different machines could regularly be comprehended in the same

Opinion of the court.

patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination. And if such a patent would be irregular, it would certainly furnish an argument of no inconsiderable weight against the construction. But the "act for the relief of Oliver Evans" entirely removes this doubt. That act authorizes the Secretary of State to issue a patent, granting to the said Oliver Evans the full and exclusive right in his invention, discovery, and improvements in the art of manufacturing flour, and in the several machines which he has invented, discovered, improved, and applied to that purpose.

Of the authority, then, to make this patent coextensive with the construction for which the plaintiff's counsel contends, there can be no doubt.

The next object of inquiry is the intention of the parties, so far as it may be collected from sources to which it is allowable to resort.

The parties are the government, acting by its agents, and Oliver Evans.

The intention of the government may be collected from the "act for the relief of Oliver Evans." That act not only confers the authority to issue the grant, but expresses the intention of the legislature respecting its extent. It may fairly be inferred from it, that the legislature intended the patent to include both the general result and the particular improved machines, if such should be the wish of the applicant. That the executive officer intended to make the patent coextensive with the application of Oliver Evans and with the special act, is to be inferred from the reference to both in the patent itself. If, therefore, it shall be satisfactorily shown, from his application, to have been the intention of Oliver Evans to obtain a patent including both objects, that must be presumed to have been also the intention of the grantor.

The first evidence of the intention of Oliver Evans is furnished by the act for his relief. The fair presumption is, that it conforms to his wishes ; at least, that it does not transcend them.

Opinion of the court.

The second, in his petition to the Secretary of State, which speaks of his having discovered certain useful improvements, and prays a patent for them, "agreeably to the act of Congress entitled 'An act for the relief of Oliver Evans.' " This application is for a patent coextensive with the act.

This intention is further manifested by his specification. It is not to be denied that a part of this specification would indicate an intention to consider the combined operation of all his machinery as a single improvement, for which he solicited a patent. But the whole taken together will not admit of this exposition. The several machines are described with that distinctness which would be used by a person intending to obtain a patent for each. In his number 4, which contains the specification of the drill, he asserts his claim, in terms, to the principles and to all the machines he had specified, and adds, "They may all be united and combined in one flour-mill, to produce my improvement in the art of manufacturing flour complete, or they may be used separately for any of the purposes specified and allotted to them, or to produce my improvement in part, according to the circumstances of the case."

Being entitled by law to a patent for all and each of his discoveries; considering himself, as he avers in his specification and affirmation, as the inventor of each of these improvements; understanding, as he declares he did, that they might be used together, so as to produce his improvement complete, or separately, so as to produce it in part—nothing can be more improbable than that Oliver Evans intended to obtain a patent solely for their combined operation. His affirmation, which is annexed to his specification, confirms this reasoning. To the declaration that he is the inventor of these improvements, he adds, "for which he solicits a patent."

With this conviction of the intention with which it was framed, the instrument is to be examined.

The patent begins with a recital that Oliver Evans had alleged himself to be the inventor of a new and useful improvement in the art of manufacturing flour, &c., by the

Opinion of the court.

means of several machines, for a description of which reference is made to his specification.

It will not be denied that, if the allegation of Oliver Evans was necessarily to be understood as conforming to this recital, if our knowledge of it was to be derived entirely from this source, the fair construction would be, that his application was singly for the exclusive right to that improvement which was produced by the combined operation of his machinery. But in construing these terms, the court is not confined to their most obvious import. The allegation made by Oliver Evans, and here intended to be recited, is in his petition to the Secretary of State. That petition is embodied in, and becomes a part of, the patent. It explains itself, and controls the words of reference to it. His allegation is not "that he has invented a new and useful improvement," but that he has discovered certain useful improvements. The words used by the Department of State in reciting this allegation must, then, be expounded by the allegation itself, which is made a part of the patent.

The recital proceeds, "which has not been known," &c. These words refer clearly to the improvement first mentioned and alleged in the petition of Oliver Evans, and are of course to be controlled in like manner, with the antecedent words, by that petition. This part of the recital is concluded by adding that Oliver Evans has affirmed that he does verily believe himself to be the true inventor or discoverer of the said improvement.

But the affirmation of Oliver Evans, like his petition, is embodied in the grant, and must, of course, expound the recital of it. That affirmation is, that he does verily believe himself to be the true and original inventor of the *improvements* contained in his specification.

In every instance, then, in which the word improvement is used in the singular number throughout the part of the recital of this patent, it is used in reference to a paper contained in the body of the patent, which corrects the term and shows it to be inaccurate.

The patent, still by way of recital, proceeds to add, "and agreeably to the act of Congress entitled 'An act for the re-

Opinion of the court.

lief of Oliver Evans,' which authorizes the Secretary of State to secure to him, by patent, the exclusive right to the use of such *improvement* in the art of manufacturing flour and meal, and in the several machines which he has discovered, improved, and applied to that purpose ; he has paid into the Treasury, &c., and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said *improvement*, and praying that a patent may be granted for that purpose."

To what do the words "said improvement" relate? The answer which has been given at the bar is entirely correct : to the improvement mentioned in the statute and in the petition,—to both of which direct reference is made. But in the statute, and in the petition, the word used is "*improvements*," in the plural. The patent, therefore, obviously affixed to the word improvement, in the singular, the same sense in which the plural is employed, both in the statute and in the petition. We are compelled, from the whole context, so to construe the word in every place in which it is used in the recital, because it is constantly employed with express reference to the act of Congress, or to some document embodied in the patent, in each of which the plural is used.

When, then, the words "said improvement" are used as a term of grant, they refer to the words of the recital, which have been already noticed, and must be construed in the same sense. This construction is rendered the more necessary by the subsequent words, which refer for a description of the improvement to the schedule. It also derives some weight from the words "according to law," which are annexed to the words of grant. These words can refer only to the general Patent Law, and to the "act for the relief of Oliver Evans." These acts, taken together, seem to require that the patent should conform to the specification, affirmation, and petition of the applicant.

It would seem as if the claim of Oliver Evans was rested at the Circuit Court, on the principle that a grant for an improvement, by the combined operation of all the machinery, necessarily included a right to the distinct operation of each

Opinion of the court.

part, inasmuch as the whole comprehends all its parts. After very properly rejecting this idea, the judge appears to have considered the Department of State and the patentee as having proceeded upon it in making out this patent. He supposed the intention to be to convey the exclusive right in the parts, as well as in the whole, by a grant of the whole ; but as the means used are in law incompetent to produce the effect, he construed the grant according to his opinion of its legal operation.

There is great reason in this view of the case, and this court has not discarded it without hesitation. But as the grant, with the various documents which form a part of it, would be contradictory to itself ; as these apparent contradictions are all reconciled by considering the word "improvement" to be in the plural instead of the singular number ; as it is apparent that this construction gives to the grant its full effect, and that the opposite construction would essentially defeat it, this court has, after much consideration and doubt, determined to adopt it as the sound exposition of the instrument.

The second error alleged in the charge, is in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made thereon by Oliver Evans.

This part of the charge seems to be founded on the opinion that if the patent is to be considered as a grant of the exclusive use of distinct improvements, it is a grant for the hopper-boy itself, and not for an improvement on the hopper-boy.

The counsel for the plaintiff contends that this part of the charge is erroneous, because, by the "act for the relief of Oliver Evans," Congress has itself decided that he is the inventor of the machines for which he solicited a patent, and has not left that point open to judicial inquiry.

This court is not of that opinion. Without inquiring whether Congress, in the exercise of its powers "to secure for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries," may decide the fact that an individual is an author or inventor, the court can never presume Congress to have decided that

Opinion of the court.

question in a general act, the words of which do not render such a construction unavoidable. The words of this act do not require this construction. They do not grant to Oliver Evans the exclusive right to use certain specified machines, but the exclusive right to use his invention, discovery, and improvements, leaving the question of invention or improvement open to investigation under the general Patent Law.

The plaintiff has also contended that it is not necessary for the patentee to show himself to be the first inventor or discoverer ;—that the law is satisfied by his having invented a machine, although it may have been previously discovered by some other person.

Without a critical inquiry into the accuracy with which the term invention or discovery may be applied to any other than the first inventor, the court considers this question as completely decided by the sixth section of the general Patent Act. That declares that if the thing was not *originally* discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, judgment shall be rendered for the defendant, and the patent declared void.

Admitting the words “*originally* discovered” to be explained or limited by the subsequent words, still if the thing had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void. It may be that the patentee had no knowledge of this previous use or previous description ; still his patent is void ; the law supposes he may have known it ; and the charge of the judge, which must be taken as applicable to the testimony, goes no farther than the law.

The real inquiry is, does the patent of Oliver Evans comprehend more than he has discovered ? If it is for the whole hopper-boy, the jury has found that this machine was in previous use. If it embraces only his improvement, then the verdict must be set aside.

The difficulties which embarrass this inquiry are not less than those which were involved in the first point. Ambiguities are still to be explained. and contradictions to be reconciled.

Opinion of the court.

The patent itself, construed without reference to the schedule and other documents to which it refers, and which are incorporated in it, would be a grant of a single improvement; but construed with those documents, it has been determined to be a grant of the several improvements which he has made in the machines enumerated in his specification. But the grant is confined to improvements. There is no expression in it which extends to the whole of any one of the machines which are enumerated in his specification or petition. The difficulty grows out of the complexity and ambiguity of the specification and petition. His schedule states his first principle to be the operation of his machinery on the meal from its being ground until it is bolted. He adds, "this principle I apply by various machines, which I have invented, constructed, and adapted to the purposes hereafter specified."

His second principle is the application of the power that moves the mill to his machinery.

The application of these principles, he says, to manufacturing flour, is what he claims as his invention or improvement in the art.

He asserts himself to be the inventor of the machines, and claims the application of these principles to the improvement of the process of manufacturing flour, and other purposes, as his invention and improvement in the art.

The schedule next proceeds to describe the different machines as improved, so as to include in the description the whole machine, without distinguishing his improvement from the machine as it existed previous thereto; and in his fourth number he says, "I claim the exclusive right to the principles, and to all the machines above specified, and for all the uses and purposes specified, as not having been heretofore known or used before I discovered them."

If the opinion of the court were to be formed on the schedule alone, it would be difficult to deny that the application of Oliver Evans extended to all the machines it describes. But the schedule is to be considered in connection with the other documents incorporated in the patent.

The affirmation which is annexed to it avers that he is

Opinion of the court.

the inventor, not of the machines, but of the improvements hereinabove specified.

In his petition, he states himself to have discovered certain useful improvements applicable to the art of manufacturing flour, and prays a patent for the same, that is, for his improvements, agreeably to the act of Congress entitled "An act for the relief of Oliver Evans." After stating the principles as in his schedule, he adds, "the machinery consists of an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier."

Although, in his specification, he claims a right to the whole machine, in his petition he only asks a patent for the improvements in the machine. The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded with each other.

The act of Congress, agreeably to which Evans petitions for a patent, authorizes the Secretary of State to issue one for his improvements in the art of manufacturing flour, "and in the several machines which he has invented, discovered, improved, and applied to that purpose."

In conformity with this act, this schedule, and this petition, the Secretary of State issues his patent, which, in its terms, embraces only improvements. Taking the whole together, the court is of opinion that the patent is to be construed as a grant of the general result of the whole machinery, and of the improvement in each machine. Great doubt existed whether the words of the grant, which are expressed to be for an *improvement* or *improvements* only, should be understood as purporting to be a patent only for the improvements, or should be so far controlled by the specification and petition as to be considered as a grant for the machine as improved, or, in the words of the schedule and petition, for "an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier." The majority of the court came at length to the opinion that there is no substantial difference, as they are used in this grant, whether

Opinion of the court.

the words grant a patent for an improvement on a machine or a patent for an improved machine, since the machine itself, without the improvement, would not be an improved machine. Although I did not concur in this opinion, I can perceive no inconvenience from the construction.

It is, then, the opinion of this court that Oliver Evans may claim, under his patent, the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered.

In all cases where the claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.

Some doubts have been entertained respecting the jurisdiction of the courts of the United States, as both the plaintiff and defendant are citizens of the same State. The fifth section of the act to promote the progress of useful arts, which gives to every patentee a right to sue in a Circuit Court of the United States, in case his right be violated, is repealed by the third section of the act of 1800, ch. 179, (xxv.,) which gives the action in the Circuit Court of the United States, where a patent is granted "pursuant" to that act or to the act for the promotion of useful arts. This patent, it has been said, is granted not in pursuance of either of those acts, but in pursuance of the act "for the relief of Oliver Evans." But this court is of opinion that the act for the relief of Oliver Evans is ingrafted on the general act for the promotion of useful arts, and that the patent is issued in pursuance of both. The jurisdiction of the court is, therefore, sustained.

As the charge delivered in the Circuit Court to the jury differs in some respects from this opinion, the judgment rendered in that court is reversed and annulled, and the cause remanded to the Circuit Court, with directions to award a *venire facias de novo*, and to proceed therein according to law.

JUDGMENT REVERSED.

Notes and Citations.

JUDGMENT. This cause came on to be heard on the transcript of the record of the Circuit Court for the District of Pennsylvania, and was argued by counsel. On consideration whereof, this court is of opinion that there is error in the proceedings of the said Circuit Court, in this : that the said court rejected testimony which ought to have been admitted ; and, also, in this : that, in the charge delivered to the jury, the opinion is expressed that the patent on which this suit was instituted conveyed to Oliver Evans only an exclusive right to his improvement in manufacturing flour and meal, produced by the general combination of all his machinery, and not to his improvement in the several machines applied to that purpose ; and, also, that the said Oliver Evans was not entitled to recover, if the hopper-boy, in his declaration mentioned, had been in use previous to his alleged discovery. Therefore, it is considered by this court that the judgment of the Circuit Court be reversed and annulled, and that the cause be remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

Notes :

1. Notice. Act 1790, § 6 ; Act 1793, § 6 ; see Act 1836, § 15 ; Act 1870, § 61 ; R. S., § 4920.

Must be given :

Seymour v. Osborne, 11 Wall. 516.

Definiteness :

Silsby v. Foote, 14 How. 218.

O'Reilly v. Morse, 15 How. 62.

Teese v. Huntingdon, 23 How. 2.

Phillips v. Page, 24 How. 164.

Agawam Co. v. Jordan, 7 Wall. 583.

Wise v. Allis, 9 Wall. 737.

Railroad Co. v. Dubois, 12 Wall. 47.

Roemer v. Simon, 95 U. S. 214.

Bates v. Coe, 98 U. S. 31.

Craig v. Smith, 100 U. S. 226.

Machine Co. v. Keith, 101 U. S. 479.

Loom Co. v. Higgins, 105 U. S. 580.

Notes and Citations.

2. Admissible evidence.

Railroad Co. *v.* Stimpson, 14 Pet. 448 [p. 324 *post*].
Blanchard *v.* Putnam, 8 Wall. 420.

4. Intention in construction of patent.

Mitchell *v.* Tilghman, 19 Wall. 287.

5. Joinder of invention.

Hogg *v.* Emerson, 6 How. 437; 11 How. 587.
Bennet *v.* Fowler, 8 Wall. 445.
Bates *v.* Coe, 98 U. S. 31.

Ex parte Austin Herr 41. O. G. 463

6. Evans *v.* Jordan, 9 Cranch, 199 [p. 7 *ante*].

10. Repealed by Act 1836, § 21.

12. Act 1790, § 4; Act 1793, § 5; Act 1800, § 3; Act 1836,
§ 14; Act 1870, § 59; R. S., § 4919.

Notes and Citations.

Patent in suit:

No. . Evans, O. December 18, 1790. Hopper-boy.

OTHER SUITS ON SAME PATENT :

Evans v. Chambers, 1807. 2 Wash. 125 ; 1 Robb. 7.
 Evans v. Weiss, 1813. 2 Wash. 342 ; 1 Robb. 10.
 Evans v. Robinson, 1813. 1 Car. L. R. (N. C.) 209 ; 1 Brunn.
 Coll. Cases, 400.
 Evans v. Jordan, 1813. 1 Brock. 248 ; 1 Robb. 20.
 Evans v. Jordan, 1815. 9 Cranch, 199 ; 1 Robb. 57 ; 1 Whit. 3.
 Evans v. Eaton, 1816. Pet. C. C. 322 ; 1 Robb. 68.
 Evans v. Kremer, 1816. 1 Pet. C. C. 215 ; 1 Robb. 66.
 Evans v. Eaton, 1818. 3 Wash. 443 ; 1 Robb. 193.
 Evans v. Hettich, 1818. 3 Wash. 408 ; 1 Robb. 166.
 Evans v. Hettich, 1822. 7 Wheat. 453 ; 1 Robb. 417 ; 1 Whit. 104.
 Evans v. Eaton, 1822. 7 Wheat. 356 ; 1 Robb. 336 ; 1 Whit. 48.

Citations :**IN SUPREME COURT OF UNITED STATES :**

Evans v. Eaton, 1822. 7 Wheat. 356 ; Bk. 5, L. ed. 472 [p. 105
post].
 Evans v. Hettich, 1822. 7 Wheat. 453 ; Bk. 5, L. ed. 496 [p. 182
post].
 Gerard v. Reynolds, 1846. 4 How. 123 ; Bk. 11, L. ed. 903.
 Hogg v. Emerson, 1847. 6 How. 457 ; Bk. 12, L. ed. 505.
 Bloomer v. McQuewan, 1852. 14 How. 539 ; Bk. 14, L. ed. 532.

Notes and Citations.

IN CIRCUIT COURTS :

- Barrett v. Hall, October, 1818 ; 1 Mason, 447 ; 1 Robb. 207.
Evans v. Hettich, October, 1818. 3 Wash. 408 ; 1 Robb. 166.
Evans v. Eaton, October, 1818. 3 Wash. 443 ; 1 Robb. 193.
Thomas v. Weeks, 1827. 2 Paine, 92 ; Fish. Pat. Rep. 5.
Whitney v. Emmett, April, 1831. 1 Bald. 303 ; 1 Robb. 567.
Blanchard v. Sprague, May, 1839. 3 Sumn. 535 ; 1 Robb. 734.
Wyeth v. Stone, October, 1840. 1 Story, 273 ; 2 Robb. 23.
Reed v. Cutter, October, 1841. 1 Story, 590 ; 2 Robb. 81.
Emerson v. Hogg, December, 1845. 2 Blatch. 1 ; Fish. Pat. Rep. 77.
Hovey v. Stevens, October, 1846. 3 Wood & Minot, 17 ; 2 Robb. 567.
Olcott v. Hawkins, 1849. 2 Am. L. J. ; 9 Penn. L. J. 317.
Day v. New England Car Spring Co., May, 1854. 3 Blatch. 179.
Goodyear v. Providence Rubber Co., November, 1864. 2 Cliff. 351 ; 2 Fish. 499.
Reed v. Miller, November, 1867. 2 Biss. 12 ; 3 Fish. 310.
Carew v. Boston Elastic Fabric Co., October, 1871. 5 Fish. 90 ; 3 Cliff. 356 ; 1 O. G. 91.
Parham v. Am. Button-hole &c. Co., 1871. 1 Leg. Gaz. Rep. 145 ; 4 Fish. 468.
Hubbell v. De Land, November, 1882. 11 Biss. 382 ; 14 Fed. Rep. 471 ; 22 O. G. 1883.
Fire Extinguisher M'fg Co. v. Graham, May, 1883. 16 Fed. Rep. 543 ; 24 O. G. 793.
Cottier v. Stimson, November, 1883. 18 Fed. Rep. 689.
Sessions v. Romadka, July, 1884. 21 Fed. Rep. 124 ; 28 O. G. 721.
The Fire Extinguisher Case, July, 1884. 21 Fed. Rep. 40.
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IN STATE COURTS :

- Holden v. Curtis, May, 1819. 2 New Hampshire, 61.
Cross v. Huntley, January, 1835. 13 Wend. 385.

Notes and Citations.

Hiatt *v.* Tuomey, June, 1836. 1 Dev. & Bat. Eq. N. C. Rep. 315.

Holliday *v.* Rheem, 1852. 6 Harris (18 Pa.), 465.

Burke *v.* Partridge, June, 1878. 58 N. H. Rep. 349 ; 10 Rep. 310.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 5, 50, 59, 76, 223, 464.

Curt. on Pats., 4th ed., §§ 21, 99, 108, 232, 357, 358, 376, 492, 494.

Walker on Pats., 1883, pp. 133, 324, 328, 360.

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The British Statute of Monopolies.

NOTE ON THE PATENT LAWS.

(Appendix. 3 Wheaton, 655.)

The Patent Acts of the United States are, in a great degree, founded on the principles and usages which have grown out of the English statute on the same subject. It may be useful, therefore, to collect together the cases which have been adjudged in England, with a view to illustrate the corresponding provisions of our own laws ; and then bring in review the adjudications of the courts of the United States.

By the statute of 21 Jac. I., ch. 3, commonly called the Statute of Monopolies, it is enacted, (§ 1,) “ That all monopolies, and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license, or toleration, to be had or made, or to agree or compound with any others for any penalty or forfeiture, limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute, before judgment thereupon had ; and all proclamations, inhibitions, straits, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing the same, or any of them, are altogether contrary to the laws of the realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution.” The sixth section, however, provides : “ That any declaration before mentioned shall not extend to any letters patent, and grants of privilege, for the term of fourteen years, or under, hereafter to be made, *of the sole working or making of any manner of new manufactures within this realm, to the true and first in-*

The British Patent Laws.

ventor and inventors of such manufactures, which others, at the time of making such letters patent and grants, shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient ; the said fourteen years to be accounted from the date of the first letters patent, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this act had never been made, and none other."

It is under this last section that patents for new and useful inventions are now granted in England ; and by a proviso, or condition, always inserted in every patent, the patentee is bound particularly to describe and ascertain the nature of his invention, and in what manner the same is to be constructed or made, by an instrument in writing, under his hand and seal, and to cause the same to be enrolled in the Court of Chancery within a specified time. *Harmer v. Playne*, 11 East, 101 [1 Am. & Eng. 171] ; *Boulton v. Bull*, 2 H. Bl. 463 [1 Am. & Eng. 59] ; *Hornblower v. Boulton*, 8 T. R. 95 [1 Am. & Eng. 98] ; 2 Bl. Com. 407, note by Christian (7). This instrument is usually termed the specification of the invention, and all such instruments are preserved in an office for public inspection.

Upon the construction of the British Patent Act, taken in connection with the conditions inserted in the letters patent, a great variety of decisions have been made. 1. As the statute contains no restriction confining the grants to British subjects, it is every-day practice to grant patents to foreigners, and no such patent has ever been brought into judicial doubt. 2. A patent can be granted only for a thing *new* ; but it may be granted to the first inventor, if the invention be *new in England*, though the thing was practised beyond sea before ; for the statute speaks of *new manufactures within this realm* ; so that if it be new here, it is within the statute, and whether learned by travel or study is the same thing. *Edgeberry v. Stevens*, 2 Salk. 447 [1 Am. & Eng. 8] ; Hawk, P. C., b. 1, ch. 79, and see Noy, 182, 183. 3. The language of the statute is *new manufacture* ; but the terms are used in an enlarged sense, as equivalent to new device or contrivance, and apply not only to *things made*, but to the *practice of making*. Under *things made*, we may class, in the first place, new compositions of things, such as manufactures in the ordinary sense of the word ; secondly, all mechanical inventions, whether made to produce old or new effects ; for a new piece of

The British Patent Laws.

mechanism is certainly a thing made. Under *the practice of making*, we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art, producing effects useful to the public. When the effect produced is some new substance or composition, it would seem that the privilege of the sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. When the effect produced is no new substance or composition of things, the patent can only be for the mechanism, if new mechanism is used ; or for the process, if it be a new method of operating with or without old mechanism, by which the effect is produced. Per EYRE, Ch. J., in *Boulton v. Bull*, 2 H. Bl. 463, 492 [1 Am. & Eng. 59], and LAWRENCE, J., in *Hornblower v. Boulton*, 8 T. R. 95, 106 [1 Am. & Eng. 98]. A patent, therefore, under certain circumstances, may be good for a *method* as well as for an *engine* or *machine*. *Ibid.*, and 8 T. R. 95, 106 ; *Rex v. Cutler*, 1 Starkie's N. P. R. 354 [1 Am. & Eng. 225]. 4. A patent cannot be for a mere principle, properly so called ; that is, for an elementary truth. But the word principle is often used in a more lax sense, to signify constituent parts, peculiar structure, or process ; and in specifications it is generally used in this latter sense ; and in this view, it may well be the subject of a patent. *Ibid.* 5. It was formerly considered that a patent could not be for an improvement ; (3 Inst. 184 ;) but that opinion has been long since exploded, and it is now held that a patent may well be for a new improvement. *Harmer v. Playne*, 14 Ves. 130 [1 Am. & Eng. 166] ; *Ex parte Fox*, 1 Ves. & Beames, 67 [1 Am. & Eng. 185] ; *Boulton v. Bull*, 2 H. Bl. 463, 488 [1 Am. and Eng. 59] ; 8 T. R. 95 [1 Am. and Eng. 98] ; Bull. N. P. 77 [1 Am. & Eng. 29]. 6. A patent must be of such manufacture or process as no other did, at the time of making the letters patent, use ; for though it were newly invented, yet if any other did use it at the time of making the letters patent, or grant of the privilege, it is declared void by the act. 3 Inst. 184. And in a very recent case of a patent for a new mode of making verdigris, one of the objections was that the invention was in public sale by the patentee, before the grant of the patent ; and GIBBS, Ch. J., on that occasion said : “ With respect to this objection, the question is somewhat new. Some things are obvious as soon as they

The British Patent Laws.

are made public ; of others, the scientific world may possess itself by analysis ; some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be *new to the world*. The public sale of that which is afterward made the subject of a patent, *though sold by the inventor only*, makes the *patent void*. It is in evidence that a great quantity was sold in the course of four months, before the patent was obtained." And if the jury were satisfied of that fact, his lordship added "that he thought the patent void." *Wood v. Zimmer*, 1 Holt's N. P. Rep. 58 [1 Am. & Eng. 202]. 7. The invention must not only be new, but useful ; for if it be contrary to law, or mischievous, or hurtful to trade, or generally inconvenient, it is, by the terms of the statute, void. 8 Inst. 184. 8. A patent can legally be granted only to the first and true inventor ; for such are the descriptive terms of the statute. 3 Inst. 184. But if the original inventor has confined the invention to his closet, and the public be not acquainted with it, a second inventor, who makes it public, is entitled to a patent. *Boulton v. Bull*, 2 H. Bl. 463. [1 Am. & Eng. 59], and *Dolland's patent*, cited 2 H. Bl. 470, 487. 9. The patent must not be more extensive than the invention ; therefore, if the invention consist in an addition or improvement only, and the patent is for the whole machine or manufacture, it is void. *Buller's N. P.* 76 ; *Boulton v. Bull*, 2 H. Bl. 463. [1 Am. & Eng. 59], and cases there cited ; *The King v. Else*, 11 East, 109 [1 Am. & Eng. 40], note ; *Harmer v. Playne*, 11 East, 101 ; *S. C.* 14 Ves. 180 [1 Am. & Eng. 171]. Therefore, where a patent was for the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of making it, and it was proved that silk and cotton thread were before mixed on the same frame for lace, in some mode or other, though not like the plaintiff's, the patent was held void, as being more extensive than the invention. *The King v. Else*, 11 East, 109 [1 Am. & Eng. 40], note. A person may obtain a patent for a machine, consisting of an entirely *new combination of parts*, although the parts may have been separately used in former machines ; and the patent may correctly set out the whole as the invention of the patentee. But if a combination of a certain number of those parts have previously existed, up to a certain point, in former machines, the patentee merely adding other combinations, the patent should comprehend such improvements only. *Bovill v. Moore*, 2 Marshall's R. 211 [1 Am. & Eng. 268]. 10. If a person has invented an improvement upon an

The British Patent Laws.

existing patented machine, he is entitled to a patent for his improvement ; but he cannot use the original machine until the patent for it has expired. *Ex parte Fox*, 1 Ves. & Beames R. 67 [1 Am. & Eng. 185]. 11. Although the specification is not annexed to a patent in England, and the patent contains a concise description only of the invention, yet as there is a proviso in the patent requiring the enrolment of a specification in chancery, within a specified time, and in default making the patent void, the patent is always construed in connection with the specification, and the latter is deemed a part of the patent, at least for the purpose of ascertaining the nature and extent of the invention claimed by the patentee. *Boulton v. Bull*, 2 H. Bl. 463 [1 Am. & Eng. 59] ; *Hornblower v. Boulton*, 8 T. R. 95 [1 Am. & Eng. 98]. 12. Care should be taken that the specification comports with the patent ; for otherwise it will not sustain the grant. For where a patent was obtained for an improved mode of lighting cities, it was held by LE BLANC, J., that it was not supported by a specification, describing an improved lamp. The patent ought to have been for an improved street lamp. *Lord Cochrane v. Smethurst*, 1 Starkie's N. P. R. 205 [1 Am. & Eng. 228]. No technical words, however, are necessary to explain the subject of a patent ; but the court will construe the terms of the patent, and of the specification, in a liberal manner, and give them such a meaning as best comports with the apparent intention of the patentee. *Hornblower v. Boulton*, 8 T. R. 95 [1 Am. & Eng. 98] ; *Boulton v. Bull*, 2 H. Bl. 463 [1 Am. & Eng. 59]. Therefore, where the patent was "for a method of lessening the consumption of steam and fuel in fire-engines," one objection was, that the patent was for a philosophical principle only, neither organized nor capable of being organized, whereas it ought to have been for a formed machine ; a second objection was, that if it was a patent for a formed machine, it was for the whole machine, when the invention was only an improvement or addition to an existing machine. But the Court of King's Bench, on examining the specification, were of opinion that both of the objections were unfounded, although the terms of the specification were so doubtful and obscure as to have produced a division of opinion in the Court of Common Pleas. *Hornblower v. Boulton*, 8 T. R. 95 [1 Am. & Eng. 98] ; *Boulton v. Bull*, 2 H. Bl. 463 [1 Am. & Eng. 59]. Both of these cases were very elaborately discussed, and contain more learning on the subject of patents than can be found in any other adjudication, and are, there-

The British Patent Laws.

fore, deserving of the most accurate attention of every lawyer. In both of them, all the judges agreed that a mere mistake in terms, or in the correct sense of words, would not vitiate a patent, if the court could give a reasonable construction to the whole specification. Mr. Justice HEATH said: "When a mode of doing a thing is referred to something permanent, it is properly termed an *engine*; when to something fugitive, a *method*." "If *method* and *machinery* had been used by the patentee as convertible terms, and the same consequences would result from both, it might be too strong to say that the inventor should lose the benefit of his patent by the misapplication of this term." "Method is a principle reduced to practice; it is, in the present instance, the general application of a principle to an old machine." "*A patent for an improvement of a machine, and a patent for an improved machine, are in substance the same.* The specification would serve for both patents; the new organization of parts is the same in both." Mr. Justice ROOKE said: "*A newly-invented method* conveys to my understanding the idea of a new mode of construction. I think those words are tantamount to fire-engines of a newly-invented construction; at least, I think they will bear this meaning, if they do not necessarily exclude every other. The specification shows that this was the meaning of the words as used by the patentee, for he has specified a new and particular mode of constructing fire-engines. It seems, therefore, but reasonable, that if he sets forth his improvement intelligibly, his specification should be supported, though he professes only to set forth the principle." Mr. Justice BULLER said: "The method and mode of doing a thing are the same; and I think it is impossible to support a patent for a method only, without having carried it into effect and produced some new substance." "When the thing is done or produced, then it becomes the manufacture which is the proper subject of a patent." The remarks of Lord Chief Justice AYRE have been already stated. He, however, considered the patent not to be for a fire-engine, but in effect for a *manner of working a fire-engine so as to lessen the consumption of steam*; and he added: "The specification calls a method of lessening the consumption of steam in fire-engines a *principle*, which it is not; the act [of Parliament] calls it an *engine*, which, perhaps, also, it is not; but both the specification and statute are referable to the same thing, and when they are taken with their correlative are perfectly intelligible." "A narrower ground was taken in the argu-

The British Patent Laws.

ment, which was to expound the word *engine* in the body of this act, [meaning the special act of Parliament for this patent,] in opposition to the title of it, to mean a *method*; and I am ready to say I would resort to that ground, if necessary, in order to support the patent, *ut res magis valeat quam pereat*." In the King's Bench, Mr. Justice LAWRENCE observed: "*Engine* and *method* mean the same thing, and may be the subject of a patent. *Method*, properly speaking, is only placing several things, and performing several operations, in the most convenient order; but it may signify *contrivance*, or *device*; so may an *engine*; and, therefore, I think it may answer the word *method*. So, *principle* may mean an elementary truth; but it may also mean constituent parts." 13. The patent being granted upon condition that the invention is new (at least in England) and useful, and also that the patentee shall deliver and enroll in chancery a specification of his invention, it is *necessary* for the patentee to establish, by proof, when his invention is called in question in a suit, that he has complied with these conditions. If, therefore, the novelty or effect of the invention be disputed, the patentee must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this, on his part, is sufficient; and it is then incumbent on the defendant to falsify the specification. *Turner v. Winter*, 1 T. R. 602 [1 Am. & Eng. 43]. 14. In respect to specifications, (objections to which form the most common, and, indeed, usually the most fatal, defence to suits for infringements of patents,) several rules have been laid down. In the first place, a man, to entitle himself to the benefit of a patent of monopoly, must disclose his secret, and specify his invention in such a way that others of the same trade who are artists may be taught to do the thing for which the patent is granted, by following the directions of the specification, without any new invention or addition of their own. *Rex v. Arkwright*, Bull. N. P. 77 [1 Am. & Eng. 29]. In the second place, he must so describe it that the public may, after the expiration of the term, have the use of the invention in as cheap and beneficial a way as the patentee himself uses it; and, therefore, if the specification describe many parts of an instrument, or machine, and the patentee uses only a few of them, or does not state how they are to be put together or used, the patent is void. *Rex v. Arkwright*, Bull. N. P. 77 [1 Am. & Eng. 29]; *Harmer v. Playne*, 11 East, 101 [1 Am. & Eng. 171]. So, if the patentee could only make the article with two or

The British Patent Laws.

three of the ingredients specified, and he has inserted others which will not answer the purpose, that will avoid the patent. So, if he makes the article with cheaper materials than those which he has enumerated, although the latter will answer the purpose, the patent is void. *Turner v. Winter*, 1 T. R. 602 [1 Am. & Eng. 43]. In the third place, if the specification be, in any part of it, materially false or defective, or obscure and ambiguous, or give directions which tend to mislead the public, the patent is void. *Rex v. Arkwright*, Bull. N. P. 77 [1 Am. & Eng. 29]; *Turner v. Winter*, 1 T. R. 602 [1 Am. & Eng. 43]. Therefore, where, in a patent for trusses for ruptures, the patentee omitted what was very material for tempering the steel, which was rubbing it with tallow, Lord MANSFIELD held the patent, for want of it, void. *Liardet v. Johnson*, Bull. N. P. 76 [1 Am. & Eng. 22]; S. C., cited 1 T. R. 602, 608, per BULLER, J. So, where a patent was for a new mode of making verdigris, and the specification omitted an ingredient (aqua-fortis) which, though not necessary to the composition for which the patent was claimed, was a more expeditious and beneficial mode of producing the same effects, and was as such used by the patentee, Lord Chief Justice GIBBS held the patent void. *Wood v. Zimmer*, 1 Holt's N. P. R. 58 [1 Am. & Eng. 202]. So, if the specification direct an ingredient to be used which will not answer the purpose, or is never used by the patentee, the patent is void. *Turner v. Winter*, 1 T. R. 602 [1 Am. & Eng. 43]. So, if the patentee says, in his specification, he can produce three things by one process, and he fails in any one, the patent is void. *Turner v. Winter*, 1 T. R. 602 [1 Am. & Eng. 43]. So, if the specification direct the same thing to be produced several ways, or by several different ingredients, and any of them fail, the patent is void. *Turner v. Winter*, 1 T. R. 602 [1 Am. & Eng. 43]. In the fourth place, if the invention be of an improvement only, it is indispensable that the patent should not be more broad than the invention, and the specification should be drawn up in terms which do not include anything but the improvement. *Boulton v. Bull*, 2 H. Bl. 463 [1 Am. & Eng. 59]; Bull. N. P. 76 [1 Am. & Eng. 22]; *Bovill v. Moore*, 2 Marsh. R. 211 [1 Am. & Eng. 268]. And in the specification for such improvement, it is essential to point out precisely what is new and what is old; and it is not sufficient to give a general description of the construction of the instrument, without such distinction, although a plate be annexed containing detached and separate representations of the parts

The British Patent Laws.

in which the improvement consists. Therefore, where a patent was "for certain improvements in the making of umbrellas and parasols," and the specification contained a minute description of the construction of them, partly including the usual mode of stitching the silk, and also certain improvements in the insertion of the stretches, &c., and throughout the whole specification no distinction was made between what was new and what was old, Lord ELLENBOROUGH said: "The patentee ought, in his specification, to inform the person who consults it what is new and what is old. He should say, my improvement consists in this, describing it by words if he can, or, if not, by reference to figures. But here the improvement is neither described in words nor figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. A person ought to be warned by the specification against the use of a particular invention." *M'Farlane v. Price*, 1 Starkie's N. P. R. 199 [1 Am. & Eng. 227]. And it may be added, also, that the public have a right to purchase the improvement by itself, and not to be incumbered with other things, where the improvement is of the old machine. But where the patentee obtained a patent for a new machine, and afterward another patent for improvements in the said machine, in which the grant of the former was recited, it was held, that a specification containing a full description of the whole machine so improved, but not distinguishing the new improved parts, or referring to the former specification, otherwise than as the second recited the first, was sufficient. Lord ELLENBOROUGH on that occasion said: "It may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and then to apply to those the improvement; but on many occasions it may be sufficient to refer generally to them. As, in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." *Harmer v. Playne*, 11 East, 101 [1 Am. & Eng. 171]; S. C. 14 Ves. 130 [1 Am. & Eng. 166]. The case, also, of *Bovill v. Moore*, already cited, (2 Marsh. R. 211) [1 Am. & Eng. 268,] affords very important instruction on this point. In the fifth place, if a patentee in his specification sum up the principle in which his invention consists, if this principle be not new, the patent cannot be supported, although it appear that the application of the principle, as described in the specification, be

Patent Laws of the United States.

new ; for the patentee, by such summing up, confines himself to the benefit only of the principle so stated. *Rex v. Cutler*, 1 Starkie's N. P. R. 354 [1 Am. & Eng. 225]. 15. If a patent is void, the patentee cannot enforce performance of a covenant for the observance of the exclusive right, entered into by the covenantor in contemplation of the patent being good. *Hayne v. Maltby*, 3 T. R. 438 [1 Am. & Eng. 53]. 16. The right of a patentee is assignable at law ; and upon such an assignment the assignee has the exclusive right to maintain an action for any infringement of the patent. See *Boulton v. Bull*, 2 H. Bl. 463 [1 Am. & Eng. 59]. 17. Where the patentee has assigned his patent, in an action by the assignee against the patentee, for an infringement of the patent, the latter will not be permitted to aver against his deed that the invention is not new. *Oldham v. Langmead* [1 Am. & Eng. 53], cited 3 T. R. 439. 18. Where the patent is void, from any of the causes before stated, the party sued for an infringement may, under the general issue, avail himself of any such matter in his defence. 19. Or the patent itself may be repealed by a *scire facias* by the King, upon the ground of fraud or false suggestion. The mode of proceeding on *scire facias* may be seen in 2 Saunders's Rep. 72, Williams's note, (4,) § 4.

These are the principal doctrines established in the English courts, upon the subject of patents for new inventions. In respect to the adjudications under the Patent Laws of the United States, it is matter of regret that so few of them have been published ; but the following are the leading provisions of the act, and the principles which have been recognized as applicable to it. It may be convenient to follow the order of the Patent Act itself, and to arrange the decisions under the corresponding heads to which they properly belong.

The first Patent Act of the United States was passed in the year 1790, (act of the 10th of April, 1790, ch. 34,) and was repealed by another act passed in the year 1793 ; (act of the 21st of February, 1793, ch. 11 ;) and this last act, as amended by the act of 1800, (act of the 17th of April, 1800, ch. 25,) constitutes the present general Patent Law of the United States. 1. By the first section of the act of 1793, any citizen who has invented any new and useful *art, machine, manufacture, or composition* of matter, or any *new and useful* improvements therein, *not known or used before* the application, may, on application and petition to the Secretary of

Patent Laws of the United States.

State, obtain a patent for the exclusive right and liberty of *making, constructing, using, and vending* to others to be used the said invention or discovery, upon complying with the regulations of the act; and the patent is required to recite the allegations and suggestions of the petition, and give a short description of the invention or discovery. The letters patent, previous to their being issued, are to be examined by the Attorney-General, and are by him to be certified to be conformable to law, and are then to be recorded in the office of the Secretary of State. The act of 1800, ch. 25, secs. 1, 2, extends this provision to aliens who have resided two years in the United States, and also to the legal representatives and devisees of a person entitled to a patent, who dies before it is obtained. The original inventor of a machine, who has reduced his invention first into practice, is entitled to a *priority of the patent-right*; and a *subsequent* inventor, although an original inventor, cannot sustain his claim, although he has obtained the first patent; for *qui prior est in tempore, potior est in jure*. *Woodcock v. Parker*, 1 Gallis. R. 438; *Odiorne v. Winkley*, 2 Gallis. R. 51. And, therefore, every subsequent patentee, although an original inventor, may be defeated of his patent-right, upon proof of such prior invention put into actual use; (*Bedford v. Hunt*, 1 Mason's R.); for then the invention cannot be considered as *new*. If an inventor make a gift of his invention to the public, and suffer it to go into general use, he cannot afterward resume the invention and claim an exclusive right under a patent. *Whittemore v. Cutter*, 1 Gallis. R. 478. By *useful* invention, in the Patent Act, is meant an invention which may be applied to a beneficial use in society, in contradistinction to an invention injurious to the morals, health, or good order of society, or frivolous and insignificant. *Bedford v. Hunt*, 1 Mason's R.; *Lowell v. Lewis*, 1 Mason's R. It is not necessary to establish that it is in all cases superior to the modes now in use for the same purpose. *Ibid.* 2. By the second section, any person who shall have invented an improvement shall not be at liberty to use the original discovery, nor shall the original inventor be at liberty to use the improvement. And the simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery. See *Odiorne v. Winkley*, 2 Gallis. R. 51. If the inventor of an improvement obtain a patent for the whole machine, the patent, being more extensive than the invention, is void. *Woodcock v. Parker*, 1

Patent Laws of the United States.

Gallis. R. 439 ; Whittemore v. Cutter, 1 Gallis. R. 478 ; Odiorne v. Winkley, 2 Gallis. R. 51. 3. By the third section, every inventor, before he can obtain a patent, is required to swear that he is the *true inventor* or *discoverer* of the art, machine, or improvement for which he solicits a patent, and to deliver a *written description* of his invention, and of the manner of using or process of compounding it, in such *full, clear, and exact* terms *as to distinguish the same from all other things before known*, and to enable any person skilled in the art or science of which it is a branch, or with which it is most clearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by *which it may be distinguished from other inventions* ; and he is to accompany the whole with drawings and written references, where the nature of the case admits of drawings ; or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is a composition of matter ; which description, signed by himself and attested by two witnesses, is to be filed in the office of State ; and the inventor is, moreover, to deliver a model of his machine, if the Secretary shall deem it necessary. The patentee must describe in his specification, with reasonable certainty, in what his invention consists ; otherwise it will be void for ambiguity. If it be for an improvement in an existing machine, he must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new ; for if both are mixed up together, and a patent is taken for the whole, it is void. Lowell v. Lewis, 1 Mason's R. The taking of the oath is directory to the party ; but if, by mistake, the oath is not taken before the issuing of the patent, the patent is not thereby rendered void. Whittemore v. Cutter, 1 Gallis. R. 429. 4. By the fourth section, patentees may assign their rights, and, upon the assignment being recorded in the office of State, the assignee shall stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assignees in any degree. Where the patentee has assigned an undivided moiety of his patent-right, the action for an infringement of the right should be in the joint names of the patentee and the assignee. Whittemore v. Cutter, 1 Gallis. R. 429. But an assignee of the patent-right, by an assignment excepting *certain places*, is not an

Patent Laws of the United States.

assignee entitled to sue within the act. *Tyler v. Tuel*, 6 Cranch, 324. 5. The third section of the act of 1800 (which is a substitute for the fifth section of the act of 1793) declares that any person who, without the written consent of the patentee, &c., shall "*make, devise, use, OR sell*" (the words of the fifth section of the act of 1793 were "*make, devise, AND use or sell*") the thing patented, shall forfeit three times the actual damages sustained by the patentee, &c., to be recovered by an action on the case in the Circuit Court of the United States having jurisdiction thereof. Upon this section, it has been held that the making of a patented machine, *fit for use, and with a design to use it for profit*, in violation of the patent-right, is, of itself, a breach of this section, for which an action lies; but where the making only, *without a user*, is proved, *nominal* damages only are to be given for the plaintiff. *Whittemore v. Cutter*, 1 Gallis. R. 429, 478. If a *user* is proved, the measure of damages is the value of the use during the time of the user. *Ibid.* But the act gives the plaintiff a right to his *actual damages* only, and not to a vindictive recompense, as in other cases of tort. *Ibid.* And neither the price of nor the expense of making a patented machine is a proper measure of damages in such case. *Ibid.* The sale of the materials of a patented machine by a sheriff, upon an execution against the owners, is not a sale which subjects the sheriff to an action under the third section of the act of 1800. *Sawin v. Guild*, 1 Gallis. R. 485. In an action on this section, the jury are to find the *single* damages, and the court are to treble them. *Whittemore v. Cutter*, 1 Gallis. R. 479. 6. The sixth section authorizes the defendant to plead the general issue, and give this act and any special matter in evidence, of which *notice in writing* may have been given to the plaintiff *thirty* days before trial, tending to prove (1) that the specification does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, *which concealment or addition shall fully appear to have been for the purpose of deceiving the public*; (2) or that the patented thing was not originally discovered by the patentee, *but had been in use*, or had been described in some public work, anterior to the supposed discovery of the patentee; (3) or that he had surreptitiously obtained a patent for the discovery of another person,—in either of which cases, judgment shall be rendered for the defendant, with costs, *and the patent shall be declared void*. Besides the points decided in the

Patent Laws of the United States.

principal case in the text, (*Evans v. Eaton*), the following are deserving of notice. It is clear that this section does not include all the matters of defence which the defendant may be legally entitled to make ; as, for instance, it does not include the case of the non-existence of the fact of infringement in any shape, the case of an assignment from the plaintiff, or a written license or purchase from the plaintiff, or that the patentee is an alien not entitled to a patent, which are clearly bars to the action upon the very terms of the act, as well as the general principles of law. *Whittemore v. Cutter*, 1 Gallis. R. 429, 435. So, if the specification do not describe the invention in clear and exact terms, so as to distinguish it from other inventions, but be so ambiguous and obscure that it cannot be with reasonable certainty ascertained for what the patent is taken, or what it includes, the patent is void for ambiguity, and the fact may be shown in his defence by the defendant. *Lowell v. Lewis*, 1 Mason's R. But if the invention is *definitely* described in the patent and specification *so as to distinguish it from other inventions before known*, the patent is good, although it does not describe the invention in such full, clear, and exact terms that a person skilled in the art or science of which it is a branch could construct or make the thing, unless such defective description or concealment *was with intent to deceive the public*. *Whittemore v. Cutter*, 1 Gallis. R. 429 ; *Lowell v. Lewis*, 1 Mason's R. In order to defeat a patent, it is not necessary to prove that the invention has previously been in *general use*, and generally known to the public. It is sufficient if it has been previously known to and put in use by other persons, however limited in extent the use or the knowledge of the invention may have been. *Bedford v. Hunt*, 1 Mason's R. 7. The seventh section applies only to the cases of patents under State authority, before the Constitution of the United States. 8. The eighth section applied only to applications then pending for patents under the Patent Act of 1790. 9. The ninth section directs that in cases of interfering applications for a patent for the same invention, the same may be referred to arbitrators, chosen by the applicants and the Secretary of State, whose award shall be final, "as far as respects the granting of the patent" ; and if either of the applicants refuse to choose an arbitrator, the patent shall issue to the opposite party. It has been held that such an award is not conclusive in any other respect than as to the mere issuing of the patent ; and that it decides nothing as to the right of invention,

Patent Laws of the United States.

or other claims of either party, but that either party may contest, in a suit at law, the validity of the patent. *Stearns v. Barrett*, 1 Mason's R. 10. The tenth section provides that upon oath or affirmation being made before the district judge of the district where the patentee, his executors, &c., reside, that any patent was obtained "*surreptitiously* or upon *false suggestion*," (the words of the act of 1790 are "*surreptitiously by* or upon *false suggestion*,") the district judge may, if the matter appear sufficient, at any time within three years after the issuing of the patent, grant a rule that the patentee show cause why process should not issue against him to repeal the patent; and if sufficient cause be not shown, the rule shall be made absolute, and the judge shall order process to be issued against such patentee, &c., *with costs of suit*. And if no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by the court for the repeal of the patent; and if the plaintiff fails in his complaint, the *defendant* shall recover costs. It has been held that the proceedings upon the rule to show cause are summary; and that when it is made absolute, it is not that the patent be repealed, but only that process issue to try the validity of the patent, on the suggestion stated in the complaint. That this process is in the nature of a *scire facias* at the common law, to repeal patents, and the issues of facts, if any, are to be tried, not by the court, but by a jury; that the judgment upon this process is in the nature of a judgment on a *scire facias* at common law, upon which a writ of error lies, as in other cases, to the Circuit Court, where there is matter of error apparent on the record, by bill of exceptions or otherwise. That the patent itself is slight but *prima facie* evidence, in favor of the patentee, that it is his invention; that if it appear that he is but a joint inventor, and he takes out the patent as his *sole* invention, it is an obtaining of the patent upon *false suggestion* within the act. *Stearns v. Barrett*, 1 Mason's R. 11. The remaining sections of the act (11, 12) contain no matter of any general importance; the eleventh being directory only as to the fees of office, and the twelfth being a repealing clause of the act of 1790.

Syllabus.

EVANS v. EATON.

7 Wheat. 356-452. Feb., 1822.

[Bk. 5, L. ed. 472 ; 1 Robb. 336 ; 1 Whit. 48.]

Affirming *ibid.*, 8 Wash. 443.Same case, 8 Wheat. 454 [p. 16 *ante*].

Competency of witness. Particular patent construed. Improvement. Description.

1. A person having an interest only in the question, and not in the event of the suit, is a competent witness. And where witness for defendant had used the patented improvement claimed, he was held competent, although matters in the defence, if found specially for defendant, would authorize the court to declare the patent void (p. 156).
2. A party can take nothing by a void patent (p. 157).
3. The law judges a party incompetent only when he has a certain and not a contingent interest (p. 158).
4. Depositions taken according to State court practice not admissible (p. 158).
5. Charge to jury should not be spread *in extenso* on the record (p. 158).
6. The sufficiency of the description of the invention is a matter of fact for the jury and not of law for the court (p. 159).
7. Evans's claim construed to be for the entire machine (p. 160).
8. Act 1793, ch. 11, reviewed (§§ 1, 2, 3 and 6) (p. 160).
9. A patentee who includes in his patent, as part of his invention, things before known or used, cannot recover, as his patent is broader than his invention (p. 161).
10. A patent for an improvement must be limited to the improvement (p. 161).
11. Identity of infringing machine is a question of fact for the jury (p. 162).
12. A patent for an improvement must distinguish in full, clear,

Statement of the case.

and exact terms the nature and extent of the improvement only (p. 162).

13. Act 1793, § 3. "Description" reviewed (p. 163).

14. Evans's patent construed to be for an improvement, and defective for not specifying it (p. 165).

ERROR to the Circuit Court of Pennsylvania.

This is the same case which was formerly before this court, and is reported [*ante*] vol. 3, p. 454 ; and by a reference to that report the form of the patent, the nature of the action, and the subsequent proceedings will fully appear. The cause was now again brought before the court upon a writ of error to the judgment of the Circuit Court, rendered upon the new trial had in pursuance of the mandate of this court.

Upon the new trial, several exceptions were taken by the counsel for the plaintiff, Evans. The first was to the admission of one Frederick as a witness for the defendant, upon the ground of his interest in the suit. The witness, on his examination on the *voir dire*, denied that he had any interest in the cause, or that he was bound to contribute to the expenses of it. He said that he had not a hopper-boy in his mill at present, it being then in court ; that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia ; and that his hopper-boy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting-chest. Upon this evidence, the plaintiff's counsel contended that Frederick was not a competent witness. But the objection was overruled by the court.

Another exception was to the refusal of the court to allow the deposition of one Shetter to be read in evidence by the plaintiff, which had been taken according to a prevalent practice of the State courts, instead of being taken pursuant to the provisions of the act of Congress.

But the principal exceptions were to the charge by the Circuit Court, in summing up the cause to the jury, which it is deemed necessary here to insert at large.

Statement of the case.

WASHINGTON, J. This is an action for an infringement of the plaintiff's patent, which the plaintiff alleges to be :

1. For the whole of the machine employed in the manufacture of flour, called the hopper-boy.

2. For an improvement on the hopper-boy.

The question is, is the plaintiff entitled to recover upon either of these claims ? The question is stated thus singly, because the defendant admits that he uses the very hopper-boy for which the patent is, in part, granted, and justified himself by insisting :

1st. That the plaintiff was not the original inventor of, but that the same was in use prior to the plaintiff's patent, the hopper-boy as patented.

2d. That his patent for an improvement is bad, because the nature and extent of the improvement is not stated in his specification ; and if it had been, still the patent comprehends the whole machine, and is therefore too broad.

1st. The first is a mixed question of fact and law. In order to enable you to decide the first, it will be well to attend to the description which the plaintiff has given to this machine in his specification, a model of which is before you. Its parts are : (1.) An upright round shaft, to revolve on a pivot in the floor. (2.) A leader or upper arm. (3.) An arm set with small inclining boards, called flights and sweepers. (4.) Cords from the leader to the arm, to turn it. (5.) A weight passing over a pulley, to keep the arm tight on the meal. (6.) A log at the top of the shaft, to turn it, which is operated upon by the water-power of the mill. The flights are so arranged as to track the one below the other, and to operate like ploughs, and at every revolution of the machine to give the meal two turns toward the centre. The sweepers are to receive the meal from the elevator, and to trail it round the circle for the flights to gather it to the centre, and also to sweep the meal into the bolt.

The use of this machine is stated to be : to spread any granulated substance over a floor, to stir and expose it to the air, to dry and cool it, and to gather it to the bolt.

The next inquiry under this head is, when was this dis-

Statement of the case.

covery made? Joseph Evans has sworn that, in 1783, the plaintiff informed him that he was engaged in contriving an improvement in the manufactory of flour, and had completed it in his mind some time in July of that year. In 1784, he constructed a rough model of the hopper-boy, but, having no cords from the extremities of the leader to those of the arm, it was necessary, in making his experiments, to turn round the arm by hand. In 1785, he set up a hopper-boy in his mill, resembling the model in court and the machine described in his specification. The evidence of Mr. Anderson strongly supports this witness, and, indeed, the discovery, as early as 1784 or 1785, is scarcely controverted by the defendant.

The defendant insists that a hopper-boy similar to the plaintiff's was discovered and in use many years anterior even to the year 1783, and relies upon the testimony of the following witnesses:

Daniel Stouffer, who deposes that he first saw the Stouffer hopper-boy in his father's, Christian Stouffer's, mill, in the year 1774; in the year 1775 or 1776, he erected a similar one in the mill of his brother Henry, and another in Jacob Stouffer's mill, in 1777, 1778, or 1779.

Philip Frederick swears that in 1778 he saw a Stouffer hopper-boy in operation in Christian Stouffer's mill, and in the year 1783 he saw one in Jacob Stouffer's mill, and another in U. Charles's mill, and that it was always called Stouffer's machine.

George Roup stated that in 1784 he erected one of these hopper-boys in the mill of one Braniwar, and that in 1782 Abraham Stouffer described to him a similar machine, which his father used in his mill.

Christopher Stouffer, the son of Christian, has sworn that his father, having enlarged his mill in the year 1780, erected a new hopper-boy of the description above mentioned, which is still in use in the same mill, now owned by Peter Stouffer.

If these witnesses are believed by the jury, they establish the fact asserted by the defendant, that the Stouffer hopper-boy was in use prior to the plaintiff's discovery.

Statement of the case.

The next inquiry is into the parts, operation, and use of the Stouffer hopper-boy. This consists of an upright square shaft, which passes lightly through a square mortise in an arm, underneath which are fixed slips of wood, called flights, and the arm is turned by a log on the upper end of it, which is moved by the power which moves the mill.

The arm, with the flights, operates as it turns upon the meal placed below it, and its use is, in a degree, to cool the meal and to conduct it to the bolt. It will now be proper to compare this machine with the plaintiff's. They agree in the following particulars: They each consist of a shaft, or log, to turn it by the power of the mill, and an arm with flights on the under side of it; they each operate on the mill below the arm, to cool, dry, and conduct it to the bolt.

In what do they differ? The plaintiff's shaft is *round*, and consequently could not turn the arm, into which it is loosely inserted, if it were not for the cords which connect the extremities of the arm to those of the leader. The shaft of the Stouffer hopper-boy is *square*, and therefore turns the arm without the aid of a leader or of cords. It has neither a weight nor pulley, nor are the flights arranged in the manner the plaintiff's are, and consequently it does not, in the opinion of most of the witnesses, cool or prepare the flour for packing as well as the plaintiff's.

The question of law now arises, which is, are the two machines, up to the point where the difference commences, the same in principle, so as to invalidate the plaintiff's claim to the hopper-boy as the original inventor of it? I take the rule to be, and so it has been settled in this and in other courts, that if the two machines be substantially the same, and operate in the same manner to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted, because he cannot be considered as the original inventor of the machine. If the alleged

Statement of the case.

inventor of a machine, which differs from another previously patented merely in form and proportion, but not in principle, is not entitled to a patent for an improvement, which he cannot be by the second section of the law, he certainly cannot, in a like case, claim a patent for the *machine itself*.

The question for the jury, then, is, are the two hopper-boys substantially the same in principle?—not whether the plaintiff's hopper-boy is preferable to the other. Because if that superiority amounts to an *improvement*, he is entitled to a patent only for an improvement, and not for the whole machine. In the latter case, the patent would be too broad, and therefore void when the patent is single.

If you are of opinion that the plaintiff is not the original inventor of the hopper-boy, he cannot obtain a verdict on that claim, unless his is an excepted case. The first, second, third, and sixth sections of the general Patent Law conclusively support this opinion. But the *judgment* of the Supreme Court in this case, (3 Wheat. Rep. 519, [*ante*]) is relied upon by the plaintiff's counsel to prove that this is an excepted case; insomuch that the plaintiff is entitled to a verdict, although you should be satisfied that he is not the original inventor of the hopper-boy. But we are perfectly satisfied that the interpretation put upon the last clause of the judgment by the plaintiff's counsel is incorrect; and that for the following reasons: 1. The question of priority of invention was not before the Supreme Court, and it is therefore incredible that any opinion, much less a judgment, would have been given upon that point. The error in the charge, which this part of the judgment was obviously intended to correct, is stated by the Chief Justice in the following words:

“The second error alleged in the charge, is in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made thereon by Oliver Evans.

“This part of the charge seems to be founded on the opinion that if the patent is to be considered as a grant of the exclusive use of distinct improvements, it is a grant for

Statement of the case.

the hopper-boy itself, and not for an improvement on the hopper-boy" [Evans v. Eaton, 3 Wheat.]. Page 512 [p. 79, *ante*].

It contradicts what is stated on page 517, [p. 83, *ante*,] where it is said that the plaintiff's claim is to the machine "*which he has invented*," &c. Now, if he did not invent the hopper-boy, he has no claim to it; and if so, could the court mean to say that he was nevertheless entitled to recover under that claim? Such a decision was certainly not called for by the terms of the "act for the relief of Oliver Evans," but would seem to be in direct violation of it. The act directs a patent to issue to Oliver Evans, not for his *hopper-boy, elevator, &c.*, but "for his invention, discovery, and improvement in the art, &c., and on the several machines which he has discovered, invented, and improved." Now, if the hopper-boy was not *invented*, &c., by O. E., this act, without which O. E. could not have obtained a patent, did not authorize the Secretary of State to grant him one for that machine; or if granted, it is clear that it was improvidently done. If, indeed, the Supreme Court had been of opinion that the fact of Oliver Evans's prior invention was decided, and could constitutionally have been decided, by Congress, there might have been more difficulty in the case; but the argument of counsel, which pressed that point upon the court, was distinctly repudiated. We conceive that the meaning of that part of the opinion is, that this court erred in stating to the jury that O. Evans was not entitled to recover if the *hopper-boy* (that is, the original hopper-boy) had been in use prior to the plaintiff's alleged discovery of it; because if the plaintiff was entitled to claim an *improvement* on the hopper-boy, which this court had denied, and which the Supreme Court affirmed, this court was clearly wrong in saying to the jury that the plaintiff could not recover for his improvement, which, in effect, was said. Upon the whole, then, the court is of opinion that O. Evans is not entitled to a verdict in his favor as the inventor of the hopper-boy, if you should be of opinion that another hopper-boy, substantially the same as his in princi-

Statement of the case.

ple, as before explained, up to the point where any alteration or improvement exists in his hopper-boy, was invented and in use prior to the plaintiff's invention or discovery, however they may differ in mere form, proportions, and utility.

2d. The plaintiff's next claim is to an improvement on a hopper-boy, which claim, we were of opinion, in another case, has received the sanction of the Supreme Court. His counsel contended that his improvement is: (1.) On the original method of supplying the bolt by manual labor; (2.) On his own hopper-boy; and (3.) On some hopper-boy, invented by some other person. Let this position be analyzed.

1. It is said to be an improvement on the original method by manual labor. But it is obvious that if this be the invention, it is of an original machine, because wherever the Patent Law speaks of an improvement, it is on some *art*, *machine*, or *manufacture*, &c., and not on manual labor, which was applied to the various arts long before the invention of machinery to supply its place.

2. An improvement on his own discovery.

But where is the evidence of such invention? It is true that Joseph Evans has stated that the plaintiff constructed, in 1784, a rude model of a hopper-boy; but it was no substitute for manual labor, because, without the cords or leading lines, the arm could not move, and it was therefore turned by hand. It was, in fact, in an incomplete state; in progress to its completion, but not given out, or prepared to be given out, to the world as a machine, before 1785, when the cords to turn the arm were added.

3. An improvement on a former machine.

This is a fair subject for a patent; and the plaintiff has laid before you strong evidence to prove that this hopper-boy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered, which is that the plaintiff's patent for an improve-

Statement of the case.

ment is void, because the nature and extent of his improvements are not stated in his specification.

The patent is for an improved hopper-boy, as described in the specification, which is referred to and made part of the patent. Now, does the specification express in what this improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating, and claims as his invention the machine, the peculiar properties or principles of it, namely, the spreading, turning, and gathering the meal, and the rising and lowering of its arm by its motion to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the original hopper-boy described, either as to its construction, operation, or use, or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such original stated? The undoubted truth is, that the specification communicates no information whatever upon any of these parts. This being so, the law, as to ordinary cases, is clear that the plaintiff cannot recover for an improvement. The first section of the general Patent Law speaks of an improvement as an *invention*, and directs the patent to issue for this said invention. The third section requires the applicant to swear or affirm that he believes himself to be the true inventor of the art, machine, or improvement for which he asks a patent; and, further, that he shall deliver a written description of his invention, in such full, clear, and exact terms that any person acquainted with the art may know how to construct and use the same, &c. That it is necessary to the validity of a patent that the specification should describe in what the improvement consists, is decided by Mr. Justice STORY, in the cases referred to in the appendix to 3 Wheat. Rep., and in the case of *Bombon v. Bule*, *Bovill v. Moore* [1 Am. & Eng. 231], *M'Farlane v. Price* [1 Am. & Eng. 227], *Harmer v. Playne* [1 Am. & Eng. 171], and perhaps some others. What are the reasons upon which this doctrine is founded? They are to guard the public against an unintentional infringe-

Statement of the case.

ment of the patent during its continuance, and to enable an artist to make the improvement, by a reference to some known and certain authority, to be found among the records of the Secretary of State, after the patent has run out. But it is contended, by the plaintiff's counsel, that the law would be unreasonable to require, and that it does not require, this to be done, unless the improvement is upon a *patented* machine, a description of which can be obtained by a reference to the records of the Secretary of State's office; that it might often be impossible for the patentee to discover, and, consequently, to describe, the parts of a machine in use, perhaps, only in some obscure part of the world. The answer to this is, that an improvement necessarily implies an original, and unless the patentee is acquainted with the original which he supposes he has improved, he must talk idly when he calls his invention an improvement.

If he knows nothing of an original, then his invention is an original, or nothing; and the subsequent appearance of an original, to defeat his patent, is one of the risks which every patentee is exposed to under our law.

As to the supposed distinction between an improvement on a machine patented and one not so, there is nothing in it. In both cases the improvement must be described, but with this difference: that in the former case it may be sufficient to refer to the patent and specification for a description of the original machine, and then to state in what the improvements, or such original, consists; whereas in the latter case it would be necessary to describe the original machine, and also the improvement. The reason for this distinction is too obvious to need explanation.

If the general law upon this subject has been correctly stated, the next question is, is this an excepted case? It is contended by the plaintiff that it is so. First, in virtue of the act for the relief of O. E.; and, second, by the decision of the Supreme Court.

1. Under the private act, that declares that the patent is to be granted in the *manner and form* prescribed by the

Statement of the case.

general Patent Law. What constitutes the manner and form in which a patent is granted by the law? The obvious answer is, the petition—the patent, with the signature of the President and the seal of the United States affixed to it—the oath or affirmation, the specification, or description of the invention, as required by the third section, the drawings and models, if required. Will it be contended that a patent would be granted in the *manner and form* prescribed by this law, if there were no description whatever of the invention? And if it would not, which is taken for granted, where is the difference between the total absence of a specification, and one which has no reference at all to the invention for which the patent is granted?

This is not the case of an imperfect or obscure description, but of one which relates exclusively to the whole machine, whereas the invention for which the patent is granted is for an improvement.

2. The opinion of the Supreme Court, which states “that it will be incumbent on the plaintiff, where he claims for an improvement, to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.” 3 Wheat. Rep. 518 [*ante*]. But how is it to be shown? The court has not pointed out the manner, and we therefore think the only fair implication is, that it must be shown as the statute of the United States and the general principles of law require; that is, by the patent and specification. If it may be shown by parol evidence to the jury, as the plaintiff’s counsel contend it may, then it may be fairly asked, *cui bono*, which sort of a showing would then be, so far as it would be productive of any useful purpose? As to the defendant, the evidence comes too late to save him from the consequence of an error innocently committed. As to the public at large, with a view to caution during the continuance of the patent, and to information of the nature of the improvement after its termination, the evidence given in this case must be evanescent and totally useless.

We feel perfectly convinced that the meaning of the Su-

Argument of counsel.

preme Court, as to this patent, is again misunderstood by the plaintiff's counsel, not only for the reasons above mentioned, but because the *extent and construction* of the plaintiff's patent, and not the validity of it, in relation to any one of the machines, were the questions before that court, and none others (in reference to the charge) were argued at the bar, or reasoned upon by the Chief Justice in delivering the opinion.

Upon the whole, we are of opinion that the plaintiff is not entitled to a verdict for the alleged infringement of his patent for an improvement of the hopper-boy.

Whereupon a verdict and judgment thereon were rendered for the defendant in the Circuit Court, and the cause was again brought by writ of error to this court.

Mr. C. J. Ingersoll, for the plaintiff*, premised a review of Evans's inventions and improvements as in proof in the cause, originating in 1783, and perfected, as regards the hopper-boy, in 1785; the grants from the legislatures of Delaware, Maryland, and Pennsylvania, in 1787; the first patent of the plaintiff under the Federal government, in 1790, and the second in 1808, by virtue of the special act of Congress for the relief of Oliver Evans. The great utility of those improvements was now universally acknowledged, while the patentee was deprived of all their advantages. It was a singular misfortune for him, among others, to be under the necessity of bringing his patent a second time before this court for revision, in the same case, in which much of the matter in dispute was the construction of the opinion formerly pronounced, reversing that of the Circuit Court of Pennsylvania, which that court had occasion to review. It was the earnest hope of the plaintiff that a full and final decision would now take place, so as to put the subject at rest.

With respect to the matters of evidence, he contended :

* Some part of his argument is applicable to the points of evidence in the subsequent case of Evans v. Hettich.

Argument of counsel.

(1.) That David Aby was incompetent as a witness, because he was sued *in pari delicto*, and of course disposed to vacate the patent he had himself infringed. Interest in such a question is equivalent to interest in the cause. Perhaps even the verdict might be given in evidence, under the sixth section of the act of 1793, ch. 11, which enjoins it on the court to declare the patent void in the event of a verdict for the defendant. The plaintiff's answer to this objection is, that as the patent is for several machines and improvements, the court could not annul such a patent but on the foundation of a verdict against all the claims. But why not? Why not declare it void *pro tanto*? Every principle applicable to common cases applies to this. Nay, it is even more necessary, in so complicated a monopoly, to guard the public against imposition or vexation, by demands founded on any part of it, tried and abrogated.

(2.) It was objected to David Aby, as a witness, that he and six others, including the defendants in these cases, as was ascertained on his *voir dire*, combined to defeat the suits, and for that purpose contributed a common purse to bear the expenses of defending them. If any surplus remained, it was to be returned by the witness, who acted as treasurer; if any deficiency, it was to be raised by further levies from the contributors. This was breaking down all distinction between bias and interest. It amounted, perhaps, to maintenance. [French v. Blackhouse] 5 Burr. 2730; Phill. Ev., ch. 5, page 49.

(3.) David Aby was suffered to prove the existence of the Stouffer original hopper-boy, when the notice was that evidence would be given of the existence of the improved hopper-boy. The notice is in [Evans v. Eaton] 3 Wheat. Rep. 470. By this, a complete surprise was inflicted on the plaintiff. The defendant's position was, that for this purpose he waived the notice of special matter and gave the evidence, under the general issue, as proof of non-user. But as the notice is equivalent to a special plea, was it competent to the defendant, after putting it in, to abandon it on the trial? There no doubt are cases when the defendant might avail himself of the general issue. 3 Wheat.

Argument of counsel.

Rep., App. 27 [*ante*]. But this was a case of special matter, *tending* to prove that the specification does not contain the whole truth, or that the thing was not *originally* discovered by the patentee. The decisive proof of this position is, that the defendant was allowed to use the same evidence to show that the plaintiff was not original with his hopper-boy, which he used to show that the defendant did not use the hopper-boy. It was an evasion of the wholesome provisions of the sixth section of the act of 1793, (act of 1793, ch. 11, § 6 ; [*ibid.*] 3 Wheat. Rep. 504 [*ante*],) calculated to destroy a patent by means which a patentee never could possibly controvert. It was an aggravation of these objections, that the court charged the jury that after a witness was ruled by the court to be competent, the jury could not disqualify him on the ground of discredit, but must believe him, unless otherwise contradicted. By this course of proceeding, the defendants were their own witnesses, and the plaintiff was not allowed to discredit them. (4.) The court should have suffered the plaintiff to prove that the son of one of the Stouffers, and the executors of another, purchased Evans's improvements. On the former occasion, similar evidence was sanctioned as to the Stouffers themselves, the alleged originators of the hopper-boy. [*Ibid.*] 3 Wheat. Rep. 495, 505 [*ante*]. And why not the acknowledgments of their descendants and legal representatives? It was treated before as evidence of opinion. If so, why not the opinion of one generation as well as another? But it was more than opinion. It was traditionary history of the invention and improvements. (5.) The court should have suffered the defendant's witness, Philip Frederick, to be asked whether Daniel Stouffer was subject to fits of mental derangement. Stouffer was the defendant's principal witness ; and that was a most material circumstance in his faculty to bear credible testimony as to remote periods and obscure circumstances. Besides, the witness, Philip Frederick, if he had denied the fact, might have been contradicted by other testimony ; in which respect it was a very important inquiry to be made of him, with a view to

Argument of counsel.

Frederick's credit. (6.) The deposition of Michael Forner was overruled, after that of John Shetter had been received, under precisely the same circumstances. Neither of them was taken according to the act of Congress, which is inconvenient and unfair in its operation. Rules for depositions were entered by both parties. Both parties took depositions under these rules. When the defendant offered to read Shetter's deposition, no objection was made, and it was laid before the jury. But when the plaintiff offered to read Forner's, taken in the same manner and under the same rules, it was objected to and overruled. The clerk testified that for twenty years the practice had been to take depositions by rule, on notice, instead of taking them under the act of Congress, which requires no notice where the witness lives more than one hundred miles from the place of trial. There was, therefore, evidence of mutual consent and understanding between the parties, deducible both from the invariable practice and from the rules entered and acted on in these cases. Yet the court rejected the plaintiff's proof, and suffered the defendants' to remain as received, in force. Thus, the plaintiff was most unexpectedly deprived of some of his most material testimony, while the defendants themselves were their own witnesses.

The main matter in dispute was on the court's construction of the word *improvement* which it imputed to the patent. This radical difficulty escaped notice when these cases were before discussed in the Circuit and Supreme Courts. 1. It was a misapprehension to suppose that the word exists at all in the patent or specification in connection with the hopper-boy. The patent is for improvements in the art of manufacturing flour, and for certain other machines, one of which is denominated an *improved* hopper-boy. But the distinction is obvious between something patented as an improvement of a hopper-boy, and something patented as an improved hopper-boy. The latter was so called as substituting mere machinery for manual labor. It might be so called as a caveat against unknown but possibly existing originals, which, in the strong illustration of the court,

Argument of counsel.

would avail a defendant if he could prove their existence in the mountains of China. It might be so called as meaning nothing more than amelioration of the inventor's own original essays. Evans's hopper-boy was a great and most beneficial improvement, which he called an improved hopper-boy. But it had no original. Even the bolt-filler ascribed to Stouffer, alleged to be of earlier origin, was as different in principle as it was inferior in practice to the plaintiff's machine.

2. It was a second error of the court, to take it for granted that the improved hopper-boy was not so described in the specification as to distinguish it from all things before known or used, and to enable a person skilled in the art to make it. It is so described. [Here the counsel went into a specification of the peculiar structure and properties of the hopper-boy.] No one skilled in the art could misapprehend this description, or be misled by it. The error of the court was in condescending to consider itself skilled in the art of which this is a branch. The law does not require of patentees to describe new *and* old, but merely to distinguish new *from* old. Otherwise a patent would be more complex and voluminous than a Welsh pedigree. Take a boat, for instance ; must every species, from the ark downward, be described ? The peculiar properties of the improved hopper-boy are perfectly explained. It is not a mere change of form and proportions, but a combination of well-known materials, on new principles, essentially set forth in the specification, so as to prevent all interfering claims during the exclusive term, and to impart the rights to the public afterward. The authorities were misunderstood by the court in this respect. They all require, to be sure, a discrimination, when the subject-matter is an improvement. But they require only an essential improvement ; not a recapitulation of the particulars of both the old rudiments and the new combinations, in detail, distinguishing them in terms.

3. This, however, was a question of fact to have been submitted to the jury, instead of being, as it was, exclusively

Argument of counsel.

assumed and determined by the court. How can a court decide whether a person skilled in the art could understand a description and copy a machine? The cases are uniformly so. [Boulton v. Bull] 8 T. R. 95 [1 Am. & Eng. 59]; [Harmer v. Playne] 11 East's Rep. 101 [1 Am. & Eng. 171]; [Bovill v. Moore] 2 Marsh. Rep. 211 [1 Am. & Eng. 268]; [M'Farlane v. Price] Starkie's N. P. Rep. 199 [1 Am. & Eng. 227]; [Hill v. Thompson] 3 Meriv. 622 [1 Am. & Eng. 299]; [Woodcock v. Parker] 1 Gallis. 438; [Odiorne v. Winkley] 2 Gallis. 51; 1 Mass. 182, 452; [Evans v. Eaton] 3 Wheat. Rep. 513, App. 17 [*ante*]. In all these cases, the court left this inquiry as a fact to the jury. Indeed, the sixth section of the act of 1793, ch. 11, treats it not only as a matter of fact, but of fraud. It must appear that the specification is untrue, either deficient or redundant, in order to deceive the public. It is matter of concealment. Can the court infer this *scienter*?

4. Indeed, it may well be doubted whether any discrimination is necessary where, as in this case, there is but one patent in existence. The second section of the law speaks of the case of a prior patented machine. The court would have the third section to be substantive, without association with the second and sixth. But how can a patentee describe what he never saw? If not before patented, how could he see or know? If he knew, but concealed his knowledge, is it not matter of fraud? The cases, when examined, will be found to have most of them referred their reasoning to the point of conflicting patents. Such is the fact in Harmer v. Playne, Bovill v. Moore, and Lowell v. Lewis. Which explanation is all-important to a correct understanding of those cases.

5. The special act of Congress for the *relief* of Oliver Evans vouchsafes him from all *technical* obstacles. His improvements by that time were universally acknowledged. Congress did not mean to forestall the ascertainment of their *originality*, which any citizen might try, if he chose, nor their utility. But the relieving act dispenses with specification, oath, fee, and all the other prerequisites of

Argument of counsel.

common cases. It was not designed merely to prolong the term of monopoly, but to relieve it from vexatious and frivolous embarrassments. Accordingly, it uses the term *improvements*, in addition to the terms applied to such subjects by the act of 1793 ; and confers on Oliver Evans an exclusive right in his discoveries, machines, and improvements, in general and specifically. The obvious design of this act of grace was to relieve the grantee from all the formalities to which patentees in common are subjected, leaving the question of priority or originality alone open to inquiry by the country.

6. But even this inquiry was not competent to these defendants, who are citizens of Pennsylvania. The act of Assembly of that Commonwealth, in 1786, confers on Evans the exclusive right in his hopper-boy, and inflicts penalties on all infractors of it. To this act, the defendants directly acceded and contributed by their representatives ; and it is a well-settled principle that they are bound by their legislation. [Conway v. Gray] 10 East's Rep. 536 ; [Consequa v. Fanning] 3 John. Ch. Rep. 598. Nor is this position at all affected by the seventh section of the act of 1793, ch. 11.

Mr. Sergeant, contra.

A patent is intended to secure to an inventor the exclusive right for a limited time to his invention. At the expiration of the period, the thing thus secured is to become public property, which any one is at liberty to use. In the meantime, every one is to abstain from using the thing patented, at the peril of a severe responsibility in damages. The provisions of the Patent Law have a view to these several objects, all of which are to be promoted as far as possible, and reconciled with each other, the public security and the benefit being protected, as well as the interests of the inventor. He is to enjoy the fruits of his ingenuity upon terms and conditions which are compatible with the safety, the peace, and the interests of other citizens.

A patent, therefore, in the first place, can only be for an *original invention*. It is of no importance that a man

Argument of counsel.

really believes himself to be the inventor, or is the *true* inventor, having made the discovery himself, without even the knowledge that the thing he supposes himself to have invented was known or used before, or described in some public work. However honest he may be, he has not merit, as respects the rest of the community, in discovering what was already known and open to common use, nor will he be allowed to appropriate the thing to himself because he has made a mistake. The *truth* of his invention, though not an original one, will protect him against a summary proceeding to set aside his patent *under the tenth section of the act of 1793, ch. 11* ; but it will not avail him to enforce his claim in an action against an individual. The want of originality, proved by showing that the thing was used or known before, or described in some public work, is, in every case, a valid and conclusive defence.

Again, an invention may be of a machine, or of an improvement on a machine, of something that was entirely unknown before, or of an addition to, or alteration in, what was previously known, so as to make it more useful. Each of these is a patentable object ; but the patent, as to both, is to be for the *invention* only, and the laws that govern it, thus understood, will be found to be exactly the same. Novelty is an essential part of the merit, and it is only what is *new* that is to be secured by the patent. A mistake is just as fatal to the patentee in the one case as in another ; and if he should really believe himself to have invented an improvement, when, in truth, it was known, used, or described before, he could not give legal effect to his patent. There is, however, one peculiarity in the case of patents for improvements. Improvement being a relative term, presupposes the existence of something to which it refers, known to the inventor at the time of making the supposed improvement. If he does not know of it, he cannot know he has improved upon it ; and if he does know of it, he can readily describe the improvement he has made—that is, his own invention. A man who has never heard of a time-keeper, might suppose himself the inventor of one ; but it

Argument of counsel.

is impossible to conceive that a man who has never heard of such a thing should believe himself to be the inventor of an improvement upon the time-keeper.

A patent for an entire machine covers the whole ; a patent for an improvement, on the contrary, covers only the improvement, and necessarily *supposes there are parts which are not patented*. It is the line between these and the parts which are patented that defines the respective pretensions of the patentee and the public ; and unless that line be somehow marked, it is impossible to say where the one terminates and the other begins. Confusion, uncertainty, extortion, fraud, and litigation would be the inevitable consequence.

It is the business and duty of the inventor, then, at the time of applying for his patent, and before he can receive a patent, to deliver a "written description of his *invention*, and of the manner of using or process of compounding the same, in such full, clear, and exact terms *as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same,*" &c. Section 3. This *specification* is to remain in the office of the Secretary of State, and a copy of it is everywhere made evidence. The design of this provision is manifest : it is to secure to the public the use of the invention, after the expiration of the period for which the patent is granted, and to enable individuals, in the meantime, to know what it is that is intended to be secured, so that they may avoid interference, or, if they think proper, dispute the claim of originality. For both these purposes, it was necessary that there should be authentic and recorded evidence, accessible to all, and remaining unchangeable and unchanged. Without a specification, the patent would be void. A specification which does not comply with the requirements of the act of Congress is, to all legal intents, no specification, and the patent would be equally void, as if there were literally no specification.

Argument of counsel.

In the present case, the patent is to be regarded either (1) as a patent for the whole machine, or (2) as a patent for an improvement on an old and known machine. The utmost that can be contended is, that the patentee has an election to consider it as the one or the other; and that is a very liberal concession, inasmuch as it is founded upon the ambiguity of his own specification, from which, generally, a man ought not to be permitted to derive an advantage. But it is clear that it cannot be a patent for both. That would be a legal absurdity, involving a plain contradiction in terms.

1. As a patent for the whole machine, including the plaintiff's alleged improvement, it is void, because the plaintiff was not the original inventor of the machine. The fact that a hopper-boy, known by the name of an S. or Stouffer hopper-boy, having all the essential parts of the plaintiff's machine, and applied to the same uses and purposes, (whether more or less perfectly is not material to inquire,) existed, and was in use before the date of the plaintiff's earliest alleged discovery, has twice been proved to the satisfaction of intelligent juries in each of these cases, and is now to be taken for granted as conclusively established. At the former trial, the learned judge who presided (Mr. Justice WASHINGTON) instructed the jury, if they should be of opinion that Oliver Evans was not the original inventor, to find for the defendant; which they did accordingly, being fully satisfied of the fact. Upon error to this court, the judgment was reversed, on the ground that the patent was not for the machine, but for an improvement, the phrase "improved hopper-boy" being, after much hesitation, deemed equivalent to "improvement" on a hopper-boy. But the opinion of the court distinctly admits what, indeed, cannot be questioned, that if, as respects the hopper-boy, the patent had been for the whole machine, the direction of the learned judge would have been right.

In giving to the plaintiff the benefit of the alternative, the case was put in the most favorable view for him. He might claim as inventor of the whole machine, or he might

Argument of counsel.

claim as inventor of the improvement ; but, under this patent, he could not claim for both ; and in claiming for either, he must, of course, abide by the settled principles of law applicable to the construction of the patent thus adopted. Each must be taken singly. The two could be confounded, so as to entitle him upon the one to the benefit of principles belonging to the other. If the patent be for the whole machine, it is void if he is not the original inventor ; and that he is not, has been fully established.

It is intimated, however, and will probably be insisted upon hereafter, that, admitting the S. or Stouffer hopper-boy to have been previously known and used, the two machines are so entirely different that Mr. Evans might well be entitled to a patent for the whole. As a question of fact, that has been decided by the verdict of the jury ; and the identity of the machine must now be taken for granted, unless the jury were led to the conclusion by an erroneous charge from the court. What constitutes identity, and what diversity, is frequently a question of great difficulty. It was the right and the duty of the judge to inform the jury what were the principles to guide their deliberations in deciding it, and this he has done with admirable clearness, and in conformity with the best authority upon this abstruse part of the law. “ Where a specific machine already exists,” (says Mr. Justice STORY,) “ producing certain effects, if a mere addition is made to such machine, to produce the same effects in a better manner, a patent cannot be taken for the whole machine, but for an improvement only.” *Whittemore v. Cutter*, 1 Gallis. 430. And the same learned judge says : “ The material question, therefore, is not whether the same elements of motion, or the same component parts, are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers, in both machines.” *Odiorne v. Winkley*, 2 Gallis. 54. The identity here is perfectly apparent upon the description, and still more so upon inspection of the models. The *object* of both is the same—to dispense with manual labor, and supply the

Argument of counsel.

hopper ; to supply it gradually, in small, successive, regular portions, by means of the power that moves the mill—substituting mechanical contrivances for human agency. The *effect* is the same—to turn, stir, and cool the flour, and thus prepare it for bolting before it is delivered. The *construction* of the machines, as to the “mode of operation” and “the combination of powers,” is the same. In both there is an upright shaft, with a cog, turned by the power that moves the mill ; an arm resting lightly on the meal, and turned by the upright shaft ; something on the under part of the arm, whether flights or sweepers, to gather in the meal to the hopper. So far they are the same. Now for the differences. The plaintiff’s machine has a round shaft instead of a square one ; it has leading lines, which are necessary in consequence of the shaft being round, and a weight to balance the arm. These may all be improvements, but they are only *improvements*, and do not make a different machine. The name itself bespeaks identity ; the old machine was called a bolt-filler, or hopper-boy, and the plaintiff’s is called “an improved hopper-boy.”

But if the machines be so entirely different as to entitle the plaintiff to a patent for the whole, though the S. hopper-boy was previously known and used, then it would necessarily follow that, even if the plaintiff were the original inventor of the improved machine, and that was the first invention, yet any one might, with impunity, make and use such a machine as the S. hopper-boy : that is to say, by stripping off some of the parts, he might entitle himself to use the residue. This is a proposition too monstrous to be maintained. If it be sound, it decides this case without any regard to the question of the original invention, for the defendant Eaton used only the S. hopper boy.

A sure test, however, of the identity, is to consider what parts are indispensable to both machines. They are, the upright shaft with a cog in it, the arm, and the sweeps. With these, the machine will work ; without them, it will not. These parts are common to both machines. What is it that the plaintiff has added ? What is not indispensable,

Argument of counsel.

but perhaps better. This is exactly the definition of an improvement. Can he, in his improved machine, dispense with any one of the parts that belong to the old machine? The answer is clear: he cannot. Can we dispense with any of his additions? Yes, with all of them. The machine is complete—an efficient agent for its purpose—without them; the evidence even leaves it doubtful whether, apart from the elevator, it is not the better of the two. It is certainly in use, and is the very machine for the use of which Mr. Eaton is sued. There can be no serious doubt that, if the plaintiff has any claim, it is only for an improvement.

2. As a patent for an improvement, it is void, because the specification does not show in what the improvement consists, or, in other words, what it is that the plaintiff claims as his invention—"the nature and extent of the improvement are not stated in his specification." This was the precise ground of the decision below.

The counsel for the plaintiff who opened the argument was understood to concede that, if the patent be for an improvement, and there be nothing in the circumstances of this particular case to make it an exception from the general rule, the law was correctly laid down. And certainly there can be no doubt of this, whether we consider the spirit and terms of the act of Congress, the decisions in England, or the adjudged cases in the United States.

The current authority of every sort is uniform to establish that the invention, to be patented, must be described in such full and exact terms as to "distinguish the same from all things before known." The second section of the act has no relation to this question. That provides for the case where one man has a patent for a machine, and another for an improvement, declaring that the one shall not be at liberty to use the invention of the other, and thus precisely limiting their respective rights. Does it follow that, if a machine has not been patented, he who improves upon it has a right to appropriate the whole to himself, and withdraw what was before public property from the public use?—that no one can afterward make use of the old and known

Argument of counsel.

machine, without the license of the patentee? The section was made with a different view, and leaves what is not provided for upon the same footing on which it before stood. What was common property, remains so; the patentee of the improvement is at liberty to *use* it, because it is common, and the legislation was necessary to enable him; but he is not allowed to appropriate it to himself, to the exclusion of others, any more than to appropriate the invention of a prior patentee. The sixth section, which makes it a good defence that the patentee has stated more or less than the truth in his specification, “for the purpose of deceiving the public,” has no relation to the question. There is no allegation here that the machine will not produce the described effect, or that more or less has been stated for the purpose of deceiving or misleading the public. Nor is this, the court will recollect, a summary proceeding to set aside the patent under the tenth section.

But the question, and the only question, is, whether, in an action by a patentee against a person charged with infringing his patent, it is not necessary for the plaintiff to show in what his invention consists. In the former argument of this case, this court have laid it down expressly that “in all cases where his claim is for an improvement, it will be incumbent on *him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.*” 3 Wheat. Rep. 518 [*ante*]. How is this to be shown? The answer is obvious: it is to be shown from the specification. That such was the meaning of the court, is evident from their adopting almost the very words of the act of Congress which are employed to describe the office of the specification, “so that a person understanding,” &c. That nothing else could be their meaning, is evident; for such, it cannot be denied, is the clear design of the act of Congress, and such is the established law as collected from authoritative decisions. The patent must not be more extensive than the invention; therefore, if the invention consists of an addition or improvement only, and the patent is for the whole machine or

Argument of counsel.

manufacture, it is void. Bull. N. P. 76 ; Boulton v. Bull, H. Bl. Rep. 463 [1 Am. & Eng. 59]. In England, the specification is not annexed to the patent, but is enrolled in Chancery. Yet, the specification is a part of the patent, for the purpose of ascertaining the nature and extent of the alleged invention. Boulton v. Bull ; Hornblower v. Boulton, 3 Term Rep. 95 [1 Am. & Eng. 98].

In this country, it is filed in the Department of State. An authenticated copy of it is always annexed to the patent, and forms a part of the patent, absolutely essential, because the patent, properly so called, in fact gives no description, referring for that to the specification. The established formula used in all patents, and to be found in the present patent, is, "the said improvement, a description whereof is given in the words of the said Oliver Evans himself, in the schedule hereto annexed, *and is made a part of these presents.*" Now, what should the patent comprehend ? Where the combination of a certain number of the parts has existed, up to a certain point, in former machines, the patentee merely adding other combinations, the patent should *comprehend such improvements only.* Bovill v. Moore, 2 Marsh. Rep. 211 [1 Am. & Eng. 268]. And the cases that have been already referred to clearly decide that, if the invention be of an improvement only, it is indispensable that the patent should not be broader than the invention ; and the *specification should be drawn up in terms that do not include anything but the improvement.* It is essential to point out what is new and what is old, so as to show precisely the extent of the alleged improvement. "The patentee ought, in his specification, to inform the person who consults it what is new and what is old. He should say, my improvement consists in this, describing it by words, if he can, or, if not, by reference to figures." But here the *improvement* is neither described in words nor figures ; and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was old and what was new. A person ought to be warned by the specification against the use

Argument of counsel.

of a particular invention. Per Lord ELLENBOROUGH : *M'Farlane v. Price*, 1 Starkie's Rep. 199 [1 Am. & Eng. 227]. It need not be denied that this description might be sufficiently given by reference, as to some other patented machine, or to some well-known machine in familiar use. For instance, to use the illustration employed by Lord Ellenborough, if we should say, take a common watch, and add or alter such and such parts, describing them. All that is contended, and that is fully supported by authority and by reason of the case, is, that the specification must, in some way or other, distinguish the new from the old, the improvement from what was known before, so as to show what the patented invention is, or else the patent is broader than the invention, and void. The decided cases in the United States are to the same effect. If the inventor of an improvement obtain a patent for the whole machine, the patent, being more extensive than the invention, is void. *Woodworth v. Parker*, 1 Gallis. Rep. 439 ; *Whittemore v. Cutter*, 1 Gallis. Rep. 429 ; *Odiorne v. Winkley*, 2 Gallis. Rep. 51.

The cases are brought together, well digested, and the principles stated, in the Appendix to 3 Wheat. Rep. 13 [*ante*].

How else can the extent of the improvement be shown ? Shall it be by evidence at the trial ? Then the design of the act would be entirely defeated, and the specification useless. The argument of the court below upon this point is perfectly conclusive. To say that the patent may be for the whole machine, and the claim for as much as the plaintiff can prove to be original, or rather the defendant cannot disprove, is to make the right depend, not upon the patent, nor even upon the fact of originality, but upon the evidence the party may have it in his power to produce, and his intelligence and skill in applying it. The right, instead of being uniform everywhere, might be one thing in one State, and another in another. In different courts of the same State, it might be different. And even in the same court, at different times, as the particular evidence happened to

Argument of counsel.

vary, it would be more or less extensive. The patent would, in effect, be nothing but an outline, large enough, of course, to be filled up as occasion might serve. This is an absurdity, and, what is worse, a great temptation to fraud. Besides, under this supposition, how is any man to inform himself what it is that is patented, so that he may avoid the danger of the infringement? It is too late, at the time of trial, to answer any good purpose to the defendant. And how are the public to be informed at the expiration of the time, or how is a person of skill to be able to make the improvement? In short, of what use is the specification, unless it be to define, with precision, the extent and nature of the improvement? The act of Congress emphatically refers to the specification, and to that alone, as furnishing everything, without extrinsic aid; and so it must do. If it be broader than the invention, the patent is void.

But it is objected here that this was a question for the jury, and not for the court. Whether the specification is broader than the invention may, perhaps, in some cases, be a question of fact, or a mixed question of fact and of law, the construction of the written instrument of specification being for the court, and the other evidence in the case for the jury. But if it be "incumbent upon the plaintiff to show the extent and nature of his improvement," and that is to be shown from the specification, then it is plainly incumbent upon him to show from the specification, where he claims for an improvement, that he has described an improvement, as distinguished from a known machine. And that, it is submitted, being exclusively a question arising upon the face of the instrument, is a question for the court. Let us examine the specification. Is there anything in it which even professes to describe an improvement, as distinguished from a machine known or used before? Does it not plainly, and in terms, include the whole machine? That is evidently a question of law upon the face of the instrument, and it may be confidently pronounced that it does include the whole, and that no man can so read the specification as to ascertain which parts are claimed by the

Argument of counsel.

plaintiff and which are not, or that there are any parts which are not claimed by him. But it is due to the court further to say that the charge in this respect must, as in all other cases, be understood with reference to the allegations and to the evidence. If there had been an attempt to prove, or even an assertion, the most distant intimation, that men of skill in mechanics, bringing to the study of this most difficult specification the aid of peculiar knowledge, could discern in it a line between new and old, or any defined limits of improvement, that would doubtless have been fit to be heard ; and whatever matter proper for the consideration of a jury might have arisen, would have been submitted to the jury. But no such evidence was offered ; the record shows it. No such suggestion even was made ; it was not pretended ; the charge shows it ; for the part excepted to was itself a reply by the court to an argument of the plaintiff's counsel, which admitted that the specification did not show in what the improvement consisted, by contending for the extravagant position that it was competent to show by evidence at the trial, which is in effect to say, that the plaintiff was entitled to whatever the defendant had not disproved.

It has been said, however, and to our very great surprise, that the court below erred in dealing with this patent as a patent for an improvement ; that it is not for an improvement, but for an *improved hopper-boy*. When this case was formerly before the Circuit Court, that court dealt with the patent as a patent for a hopper-boy, and not for an improvement. Upon error to this court, one error principally relied upon was, that the court below had thus construed it to be a patent for the machine. [Evans v. Eaton] 3 Wheat. Rep. 486, 502 [*ante*]. And it was contended that an "improved hopper-boy," and an "improvement on a hopper-boy," were one and the same. "This," says one of the counsel, "was a patent for an *improvement* on the particular machine in question, and not for its original invention." And of that opinion were the court, after much deliberation. 3 Wheat. Rep. 517 [*ante*]. And can it now be contended,

Argument of counsel.

in the same court and by the same party, that this is not to be dealt with as a patent for an improvement? But the truth is, it has been treated in this case as a patent for both the machine and the improvement, so as to give the plaintiff the full benefit of either construction. The real aim of the argument is to maintain that a patent for the whole may be expounded as a patent for each of the parts, and legally covering as many as the patentee may be able to prove he has invented; that it may be a patent in words for one thing, and in law for another; that it may have a sort of elastic ambiguity, capable of contraction, if not of expansion, so as to adapt itself to whatever it may be found convenient at any given time to embrace. This is against all settled principles; it is against good policy; and it is against the words and the spirit of the act of Congress.

Such being unquestionably the established law upon the subject of patents in general, it remains only to inquire whether the case of Oliver Evans is, on any account, an exception. And it is insisted here that the special act for his relief makes it an exception. The history of that act is sufficient to show that its only object was to authorize a new patent to be issued, by reason of the first having been declared void for irregularity of form, attributable to the officers of the government. This gave an equitable title to relief. The appropriate relief was an extension of the time, so that the inventor might enjoy the privileges of a patent for the same time that he would have enjoyed them if the irregularity had not occurred—that is to say, the same privileges. This was sufficiently liberal, for the first patent had actually expired before the new one was granted. The new patent, too, was made retrospective, and gave to Oliver Evans an exclusive right for twenty-eight years, double the usual period; yet it was contended formerly that this special act, liberal as it confessedly was, went the further length of dispensing altogether with the necessity of proving he was the inventor, and even precluded all right to question the invention, which was in effect to say that the exclusive privilege was secured to him, whether he was the

Argument of counsel.

inventor or not. That was overruled by this court, upon the plainest grounds. 3 Wheat. Rep. 513 [*ante*]. And the whole scope of the opinion then delivered distinctly establishes that, except the extension of time and the union of different inventions in the same patent, which otherwise perhaps could not be regularly joined, the patent to be issued was to be, in all respects, conformable to the general law and subject to the same regulations as other patents. Such was the interpretation of the plaintiff himself; he applied in the usual manner by petition, with a specification and oath. Such was the interpretation of the officers of the government; the patent underwent the usual examination, and is in the usual form. Such is at this moment the interpretation; for it is upon the adoption of the general law by reference that the jurisdiction of the Federal courts, in cases growing out of this patent, entirely rests. If that law be not applicable, this court has no power to adjudicate the cause. It is needless to pursue this further, being already decided by the former decision of this court. For the terms and conditions upon which the patent was to be granted—the jurisdiction to attach to it, the rules to govern it—the special act makes no provision, but by reference to the existing laws; and but for this reference, we could not advance a single step in the inquiry.

All that has been said of the act of the Legislature of Pennsylvania, passed in the year 1787, may be disposed of in a single word. What its provisions were, does not appear; and if it did, the right they conferred, whatever it may have been, was surrendered by accepting a patent under the law of the United States. The seventh section of the act of Congress is express.

In conclusion, then, it is confidently submitted that the patent of Oliver Evans must be considered as a patent either for the machine or for the improvement.

That if it be for the machine, it is void; because it is fully proved that he was not the original inventor, but the machine was known and used before.

That if it be for an improvement, it is void; because it is

Argument of counsel.

broad than his invention, and does not specify in what his improvement consists, so as to distinguish it from what was known and used before.

The learned counsel also argued the points of evidence in this and the next following case, (*Evans v. Hettich*,) but, as they are so fully noticed in the opinion of the court, it is not thought necessary to report that part of his argument.

Mr. Harper, in reply, observed that, in the opinion of the Circuit Court, two propositions were distinctly affirmed : (1.) That Evans's patent of the hopper-boy was a patent for an improvement, and not for an original invention or discovery. (2.) That, being for an improvement, it was void, because the specification did not in terms distinguish the improvements from the original machine, called the Stouffer hopper-boy. Both these propositions were indispensable for supporting the judgment below. He denied them both, and should endeavor to show that they were equally void of foundation. If he could succeed in overthrowing either, the judgment of the Circuit Court must be reversed, and the patent-right of the plaintiff supported ; but he believed, and should endeavor to show, that both were wholly unfounded.

And, first, is the patent of Oliver Evans a patent for an improvement, or for an original invention ? The decisions of the Circuit Court maintained the former. He should endeavor to demonstrate the latter.

In the outset of this investigation, it would be proper to remark that the specification makes part of the patent ; and he had the authority of this court, in the former decision in this case, (3 Wheat. Rep. 507 [*ante*],) for saying that, in order to ascertain what Oliver Evans obtained by his patent, one of the proper points of inquiry was, what did he ask for ?—what was it his wish and intention to obtain ? This question may be satisfactorily answered by referring to that part of his specification which relates to the hopper-boy. This specification is printed at length in a note to 3

Argument of counsel.

Wheat. Rep., and the part of it now in question is found at page 468. The description of the machine is very full, minute, and clear, and it concludes with this declaration : “ I claim as my invention the peculiar properties or principles which this machine possesses, namely, the spreading, turning, and gathering the meal at one operation, and the using and lowering its arms by its motion, to accommodate itself to any quantity of meal it has to operate on.”

This was what he claimed as his invention. For this he asked a patent. Not for the machine which he had thus improved, but for the principle on which it was made to operate. He has not very accurately expressed himself, or distinguished between the object to be obtained and the mode of proceeding for its attainment ; between the end and the means ; the result and the *modus operandi* by which it is produced. But still his meaning is obvious. The object, the end to be obtained, the result, was the “ spreading, turning, and gathering the meal at one operation.” The principle of the machine, the *modus operandi* by which the object was to be accomplished in a new and better way, was the power of the machine to raise and lower its arms by its own motion, so as to accommodate itself to any greater or less quantity of flour on which it may have to operate. This, then, is his invention or discovery which he claims as his own, and for which he demands a patent. His demand is complied with. He gets what he asked. This is what the grantors intended to give him ; and I appeal again to the former decision for the doctrine that, in order to ascertain what is given, we must look to the request of the receiver and the intention of the giver.

It is, then, a patent for the peculiar principle of his machine, for its new mode of operating, that Oliver Evans asked for and received. That a new *modus operandi*, by a new combination of old instruments or machines so as to produce either a new effect or an old effect in a new way, is the proper subject-matter of a patent, appears from numerous authorities, and may be considered as a settled principle of the Patent Law. It was on this principle that Watt's patent

Argument of counsel.

for his improvements on the steam-engine, which made so much noise in Westminster Hall and produced such important effects, was finally supported and established.

The English law of patents, though different from ours in its origin, was probably the same in its principles. Indeed, our act of Congress was a mere enactment of the principles and system which the English courts had established. That system grew out of the ancient prerogative of the crown in England to grant monopolies. This power, long and often most oppressively exercised, was abolished in the early part of James the First's reign, by an act of Parliament, which was one of the earliest fruits of the increase of knowledge, the progress of correct ideas, and the improvement in the condition of society, which, at that time, had begun to appear. But, for the encouragement of industry and ingenuity, a proviso was introduced into the statute, that the King might still grant a monopoly "of any manner of new manufactures" to the first inventors, for any term not exceeding fourteen years. See the case of *Hornblower v. Boulton*, 8 T. R. 105 [1 Am. & Eng. 98]; the opinion of Mr. Justice LAWRENCE. Upon this short proviso, this apparently scanty foundation, the whole structure of the English Patent Law was raised by the English government and courts. The system which they thus established was adopted by our act of Congress. This system required a specification. Nothing is said of it by the statute; but the government required it, by an express clause, of every patent. The principle on which it was required was this: The statute conferred a benefit on the inventor, by giving him a monopoly of his invention for a limited time. For this benefit conferred on the patentee by the community, it was thought just that he should make a return. That return consisted in the knowledge and free use of his invention, which, by his specification, he should enable the community to obtain after the expiration of his monopoly. This principle enables us not only to understand the origin and object of the specification, but also its nature and character, as its object was to put the public in possession of the in-

Argument of counsel.

vention, after the monopoly had ceased, so as to enable all persons to use it beneficially ; it was indispensable that the invention should be so fully and clearly explained as to enable persons skilled in the same art to make and use it. This was all that was to be effected by the specification, and consequently all that it was required to contain. The very same certainty of description which would enable persons skilled in the art to make and use the invention, after the monopoly should expire, would enable them to avoid making and using it, so as to subject themselves to penalties or loss, during the continuance of the monopoly.

In the same manner, it was established that improvements in old machines or processes might be combined as “ new manufactures,” and become the subject of patents. This principle was also incorporated into our act of Congress, in express terms. And here the same rule was adopted with respect to the specification. The “ new manufacture,” whether it consisted in a machine or process entirely new, or in the improvement of an old one, was to be described with such certainty as to enable persons skilled in the art to make and use the invention, after the monopoly should expire, and to avoid it while the monopoly should exist. The principle and object were the same in both cases, and the same rule was adopted in both, by our act of Congress, as well as by the English decisions.

We shall now be able to perceive the application of the case of Watt’s patent (8 T. R. 95 [1 Am. & Eng. 98]) to the point under consideration, which, let it be considered, is to ascertain how far the discovery of a new *modus operandi*, so as to produce a new effect, or an old one in a new way, is the proper subject of a patent, as a useful invention, and not as an improvement.

The expansive power of steam had been many years before discovered by the Marquis of Winchester, who applied it, though very imperfectly, to various mechanical purposes. Among the rest, he employed it to put machines in motion, by communicating to them the movement which the steam was made to produce in beams and levers. Thus was laid

Argument of counsel.

the foundation of that wonderful invention, the steam-engine. Various machines of this kind, more or less perfect, were, from time to time, brought into use; and at length Newcomen made a steam-engine, which was long considered as having attained the utmost point of perfection. It consisted of a cylinder, or large tube of iron, made perfectly smooth and uniform within, and completely closed at the bottom, but open at the top. Inside of this cylinder was placed, horizontally, a thick, strong plate of iron, so fitted at the edges to the inner surface of the cylinder as to be air-tight, and yet to play easily up and down. Into the centre of this plate was fitted a strong upright stem of iron, of the length required; and the stem and plate together made what is called the piston. The upper end of the piston stem was fastened by a joint to a horizontal beam, which was made fast by a joint, near the centre or at the farthest end, so as to allow its near end to play up and down with the piston to which it was attached. At the bottom of the cylinder, under the piston, was introduced a pipe, or tube, leading from the boiler where the steam was generated into the cylinder, and furnished with a valve. When this valve was opened, it let the steam through the pipe into the lower part of the cylinder under the piston, which was thus raised up by the explosive power of the steam, and raised with it the end of the horizontal beam to which it was attached. When the piston, and with it the beam, had been raised as high as was intended, the valve in the steam pipe was shut by the motion of the machine, and at the same moment a valve was opened by the same means in a pipe which connected the cylinder with a vessel of cold water. A quantity of this water was then introduced into the cylinder under the piston, where it condensed the steam more or less completely and created a vacuum more or less perfect, in consequence of which the piston was pressed down by the weight of the atmospheric air resting upon it, and carried down with it the end of the horizontal beam to which it was attached. When it had subsided as low as was desired, it opened the steam valve, and let in the steam

Argument of counsel.

under the piston, which was raised as before, and again pressed down by the weight of the air, on the steam being again condensed by the introduction of cold water. This operation went on continually, and thus an ascending and descending motion was produced, which was communicated by the horizontal beam to the whole machinery.

The defect of this engine at length began to be observed. It consisted in the cooling of the cylinder by the cold water let in to condense the steam. The cylinder being thus rendered colder than steam, a considerable portion of the steam introduced was condensed by this coldness while the piston was rising, and was thus destroyed before it had done its office. This rendered a greater generation of steam necessary, and of course a greater consumption of fuel. The steam, too, was not suddenly or perfectly condensed, so as to let the piston descend with sufficient rapidity or force, by which the power and effect of the machine were diminished. The water, also, into which the steam had been converted by condensation, remained in the bottom of the cylinder, and further impeded the descent of the piston. These defects were seriously felt in a country where fuel was dear, and became continually more and more so. At length they threatened to render the engine entirely useless, by creating a greater expense in fuel than could be compensated by the labor-saving power of the machine.

Then Watt arose, who, after long reflection and many experiments, conceived the happy idea of condensing the steam in a vessel different from that in which it was to perform its office. This he effected by connecting with the machine another vessel called a connector, which was connected with the cylinder by a pipe with a valve in it. This valve being opened by the motion of the machine, at the same moment when the piston had ascended to its greatest height, the steam rushed through it into the conductor, where it met a stream of cold water, introduced by the same means which had been before employed for letting it into the cylinder. This cold water condensed it as fast as it came in ; and a pump was also contrived, to work by the

Argument of counsel.

motion of the machine, and drew out of the conductor all the steam that remained uncondensed and all the water produced by the condensation. Thus a most perfect vacuum was created in the condenser, and consequently in the cylinder connected with it; the piston descended with freedom, rapidity, and force; and the cylinder, not being touched or affected by the cold water, retained a heat equal to that of steam; so that no portion of the steam introduced into it was condensed too soon.

This was the great improvement, but others were employed to increase its effect. The cylinder was surrounded by a case the best calculated to retain heat, and the space between this case and the cylinder was kept full of steam or boiling water. Thus the cylinder was kept in the hottest possible state—the state best adapted to the preservation of the steam while performing its office; and as steam thus preserved was found to be more effectual than atmospheric air in bringing down the piston, the top of the cylinder was closed, and steam was introduced above the piston as well as below it. This stream was conducted into the condenser, and there condensed and pumped out, in the same manner with that introduced below; and thus the piston, being alternately pressed up and down by the elastic power of steam, in its most efficacious condition gave a most powerful, steady, and uniform motion to the engine. Oily substances were employed, instead of water, in keeping the vessels air tight; especially the top of the cylinder, where the steam of the piston played through it. Thus the machine was rendered as perfect as it seems capable of becoming.

Now, in what does this machine differ from the steam-engine of Newcomen, which was in use before? Both had a boiler to produce the steam, and a cylinder to receive it. The piston was the same in both, and connected in the same manner with the horizontal beam, for the purpose of communicating the motion to the rest of the machinery. In both, the piston was raised by the expansive power of the steam; this steam, after its office had been performed, was

Argument of counsel.

condensed by cold water, so as to create a vacuum in the cylinder, and permit the piston to descend ; and in both, pipes and valves of the same construction were used, for introducing alternately the steam and the cold water. In what, then, did they differ ? Merely in a new *modus operandi*, by which, with the addition of another vessel, the cold water was prevented from cooling the cylinder, while it conducted the steam ; and the steam was made to operate in forcing the piston down as well as in forcing it up. In this new *modus operandi*, produced by a different arrangement and construction of the old machines, with the addition of one new vessel, to receive and condense the steam, consisted the great invention of Watt ; for which he obtained his patent, avowedly as for a new invention, or, in the language of the British statute, a “ new manufacture,” and not for an improvement. His specification is inserted at length in 8 T. R. 96, note (a), where it will appear that he speaks of his discovery as a new invention, and not as an improvement, and never once mentions or alludes to the old machine.

In what did this new discovery consist ? I answer, with the two judges of the Common Pleas in England who were in favor of this patent, and one of whom was Lord Chief Justice EYRE, (Boulton v. Bull, 2 H. Bl. 463 [1 Am. & Eng. 59],) and with the four judges of the King’s Bench, who were unanimous on the point, (8 T. R. 95 [1 Am. & Eng. 98],) that it consisted in the new principle on which the steam was condensed, and which was carried into effect by a new combination of the old machinery, with the addition of one new instrument.

The word “ principle,” as used in relation to this subject, is not taken in its general philosophical sense, where it means a law of motion or a property of matter ; but in what may be termed its mechanical sense, in which it signifies a method of doing a thing, or of effecting a purpose—in other words, a *modus operandi*.

It is therefore established by this solemn and elaborate decision of six English judges against two, after repeated

Argument of counsel.

arguments and great consideration, that a new principle, or *modus operandi*, carried into practical and useful effect by the use of new instruments, or by a new combination of old ones, with or without the addition of one or more new ones, is an original invention for which a patent may be supported, without reference to any former invention or machine, for performing the same or a similar operation. This may be taken as a maxim which the cases referred to will be found fully to support.

Let us now apply this maxim to the patent of Oliver Evans. We shall soon see that, according to the doctrine thus established, his discovery was not a mere "improvement," as the court below pronounced it to be, but an original invention.

The learned counsel here produced two models, one of Evans's hopper-boy and one of Stouffer's, and explained minutely the difference between their principles, or *modus operandi*, which consisted in this: that in Stouffer's hopper-boy, the arms, through a square mortise in which the square upright post was made to pass, were carried round by means of the upright post pressing upon the sides of the square mortise, which renders it impossible for the arms to rise and fall of themselves, as the meal under them might increase or diminish; while in the hopper-boy of Evans, the upright post is round, and it passes loosely through a round hole in the arms, which are carried round by two pieces of timber of the proper length, called leaders, which are inserted firmly into the upper part of the post, and attached at their ends by lines, or small cords, to the corresponding ends of the arms. These lines and leaders, being put in motion by the upright post, trail round the arms, which at the same time play loosely on the post, and rise and fall of themselves, as the meal under them increases or diminishes in quantity. And to make them press more lightly on the meal, and rise and fall with more facility, as occasion may require, a weight a little lighter than themselves is attached to them by a cord which passes over a pulley in the upper part of the post. This weight nearly

Argument of counsel.

balances the arms, and enables them to play up and down much more easily and effectually.

The counsel also produced a drawing of Evans's machine, from the Patent Office, to show that his model was correct, and referred to the facts of the evidence in the record, where the machine of Stouffer is described, and its properties and defects explained.

He then proceeded to remark that the machine of Evans was obviously constructed upon a new principle ; that the *modus operandi* was entirely new. The great object of both machines was to conduct the meal into the bolting-chest, and to stir, turn, dry, and cool it on its way thither. The essential agents in this operation were the arms, which if they remained stationary on the post, as they must of necessity do in Stouffer's machine, could not possibly perform this operation to advantage. They might sink down on the meal, as its quantity decreased, but could not possibly rise when it was increased ; consequently, when new meal was placed on the floor, the machine must be stopped, and the arms lifted up. Hence, its motion was unequal, and its operation necessarily very irregular and imperfect. It also required a hand constantly or frequently to be present, and thus increased the expense.

Thus, the condensation of the steam within the cylinder itself, in Newcomen's steam-engine, cooled the cylinder improperly, wasted steam, made more fuel necessary, and rendered the operation of the machine imperfect and too expensive. Here the similarity of imperfection is complete.

Evans removed the imperfection of the hopper-boy, not by merely adding to its parts, but by introducing a totally new principle and *modus operandi*. He detached the arms from the upright post entirely, and carried them round by means of the leaders and lines which have been described, leaving them to play freely up and down on the post, so as to accommodate themselves to the decreasing or increasing quantity of meal under them ; and their movement up and down he facilitated, regulated, and rendered perfect by means of the weight and pulley. The *modus operandi* of

Argument of counsel.

the two machines consisted in the manner of carrying round the arms. This was the principle of both machines. That of Evans was new, and infinitely superior.

So Watt remedied the defects of Newcomen's steam-engine, by condensing the steam in a different vessel from the cylinder, and increased the effect by introducing the steam above the piston as well as below it. This was a new principle ; and here again the resemblance between the two cases is complete.

It being, then, clear that Evans had made a new invention as to the hopper-boy, and not merely what the law on this subject calls an improvement, and the cases showing that such an invention is the subject-matter of a patent for an original invention, it follows that he might have obtained a patent for his invention as an original invention, and not merely as an improvement. This leads to the inquiry, for what was this patent granted ? Was it for an original invention of his own, or for an improvement on Stouffer's invention ?

We have the authority of this court, in its former decision in this case, ([Evans v. Eaton] 3 Wheat. Rep. 454 [*ante*],) for saying, that when we inquire what was granted, it is proper, in the first place, to ascertain what the grantee wished to obtain, and, next, what the grantor had the intention and the power to give. What Evans wished to obtain, is fully and most explicitly stated in the concluding sentence of his specification. *Ibid.* 468, note [*ante*]. After describing most fully and clearly the structure, principle, and operation of his hopper-boy, he concludes thus : "I claim as my invention the peculiar properties which this machine possesses, namely, the spreading, turning, and gathering the meal at one operation, *and the rising and lowering its arms by the motion, to accommodate itself to any quantity of meal it has to operate on.*" Here it is manifest that he describes the effect intended to be produced, which was the same in both machines, namely, the spreading, turning, and gathering the meal at one operation ; and his *modus operandi* for producing this effect,

Argument of counsel.

which was entirely new, namely, the rising and lowering of the arms of the machine by its own motion, so as to accommodate itself to the increasing or diminishing quantity of meal. For this *modus operandi*, this property or principle, he claims a patent.

It is equally clear that the grantor of the patent intended to give what he thus asked for ; that is, a patent for this new principle. This appears from the special act of Congress, on which the patent is founded, and to which it refers ; from the terms of the patent itself ; and from the specification, which is expressly incorporated into it as one of its constituent parts.

As a further illustration of this position, the most celebrated and important invention of modern times may be referred to—an invention which was destined to produce more important effects than any other single effort of the human mind. He alluded to the steamboat—that sublime conception, which had conferred so much glory on its author and his country. What was a steamboat but a new combination of these well-known machines, a boat, a steam-engine, and a flutter-wheel—machines most familiar to all who knew anything of such subjects. But they were so combined as to produce a new and most surprising effect, by a new *modus operandi*. This method consisted in attaching a steam-engine and two flutter-wheels to a boat of proper dimensions and strength, and arranging them in such a manner that the flutter-wheels were set in motion by the steam-engine, and struck against the water, instead of being struck by it, as they are in a common saw-mill. Thus striking against the water, they act as oars, or rather as paddles, and propel the boat forward. Now, what was there new in this machine ? Not the instruments, but the manner of combining them, and their manner of operating produced by this combination ; and yet no one has denied to the author of this beautiful and sublime idea the merit of an original invention, or called in question his patent, as a patent for an original invention. He, however, merely combined old machines, changing their forms and propor-

Argument of counsel.

tions so as to suit his new purpose. Evans not only combined old machines, but added new and essential parts, and by means of both produced a *modus operandi* altogether new and highly useful. Upon what ground, then, can it be said that he is not an original inventor, when Watt was solemnly adjudged and Fulton unanimously allowed to be so?

I therefore contend that Evans was an original inventor, and not an improver merely; and that his patent is for an original invention, and not for an improvement. If so, the decision of the Circuit Court in these two cases (the present case, and the subsequent case of Evans v. Hettich must be reversed, and the patent of my client is established.

But if it be not a patent for an original invention, but merely for an improvement, the decision below was erroneous, in declaring that the specification is defective. This defect consists, according to the decision below, in the omission to state particularly in what the improvement consists, and to distinguish it in terms from the pre-existent machine.

Here a very familiar maxim is applicable: *quod neminem ad vana aut ad impossibilia lex cogit*. The law requires nobody to do that which would be useless if done, or it is impossible to do. And *cui bono* make this discrimination? how can it be made? and by what provision of the law is it required? On the answer to these three questions the case must depend. If it can be shown that such a discrimination would be useless if made, or is impracticable, and that it is not expressly or positively required by the act of Congress, it will follow that the judgment below must be reversed.

And (1.) *cui bono* make the discrimination? What good would it or could it do to anybody? In order to answer these questions, we must revert again to the object and uses of the specification.

The Patent Law confers a benefit on the discoverer of any artful invention, which consists in a monopoly of his invention for a limited time. The consideration which it re-

Argument of counsel.

quires him to pay for this benefit is to put the public in possession of his invention, so as to enable all to use it after this monopoly shall expire, and all to avoid involving themselves in controversies and difficulties, by inadvertently infringing it, while it continues. Hence the necessity of a specification ; and here we find its uses, its extent, and its limitations. The British statute said nothing of a specification ; but it was introduced by the executive government as a condition of every patent, and its character, objects, and properties have been accurately settled by judicial decisions in England. From those decisions it was borrowed by our act of Congress, and incorporated into its positive enactments. In both systems, its objects and uses, and consequently its nature and properties, are the same. Its object and all is to enable the public to enjoy the invention, beneficially and fully, after the monopoly shall have expired, and to avoid interference with it while it shall continue. Now, what is necessary for attaining this object ? Certainly nothing more than this : that the invention should be so described in the specification by writing, and, where the nature of the subject will permit, by drawings and models, so that any one competently skilled in the art or science to which it relates may be enabled to understand, make, and use it. This is what the English decisions have established as the necessary properties of the specification, and what our statute expressly and in terms requires.

Now, it is obvious that, in the case of an improvement, the principle is exactly the same as in that of an original invention. The invention, that is, the thing in its improved state, must be accurately and fully described—by writing always, and by drawings and models where the nature of the case will permit. When this is done, it is manifest that any one who can understand the improved thing, so as to make and use it, may, in every possible case, distinguish the improvement from any and every original or antecedent thing of the same sort. Take these two hopper-boys as an example, and inspect the models which I hold in my hands. Cannot any man who has sufficient mechanical skill to

Argument of counsel.

make a hopper-boy, and understand its use, see at one glance in what these two machines differ from each other? Does not the court see it? Cannot any such mechanic, therefore, make and use the hopper-boy of Stouffer, if he should think proper, and avoid all interference with the improvement of Evans? It cannot be doubted that he may. And so may a person sufficiently skilled in the art or science to which an improvement relates, in every possible case. When he has the improvement, or the improved thing sufficiently described, as the hopper-boy of Evans is admitted to be, and is informed of any pre-existing machine or thing of the same general nature which he wishes to make, sell, or use, he can look at that thing, compare it with the improved machine or with the description, drawings, and models in the Patent Office, see the difference, and make and use the original or old one, without the least danger of interfering with the improvement. Where, then, is the use of describing the original or the old invention in the specification of the improvement, and of discriminating in terms between them? It is manifest that such a description would be perfectly useless and vain, and *neminem ad vana lex cogit*.

2. But admitting that it might be of some use, would it be possible? This is the next head of inquiry; and I contend that it would not.

And here let it be remembered that this doctrine of discrimination is not confined to such inventions as are express or avowed improvements on particular inventions. It extends necessarily to all inventions which improve anything that existed before. In the present case, there happened, so far at least as is now known, to be but one hopper-boy, that of Stouffer, in use before Evans's. But suppose there had been twenty, of as many different kinds: would they not all have been original with respect to Evans's, or antecedent to it? Undoubtedly; and every man, notwithstanding Evans's patent, would have had a right to use them all, or any of them. What reason or principle could require the description of one in the specifi-

Argument of counsel.

cation of Evans, which would not equally apply to all? There certainly is none. Let us take the example of a patent for an improved stove, for increasing the heat, or for any other object. How many millions of stoves, of what an endless variety of constructions, are used in the world. Must the patentee of this improved stove, or of this improvement on stoves, describe them all in his specification, and point out in terms the difference between each of them and his invention? It is manifest that he must, according to the doctrine of the Circuit Court; and it is equally manifest that he could not possibly do it. His specification would constitute a library of itself, which no man would or could read, and which the Patent Office could hardly contain. So, also, improved chimneys, improved carriages, and all the multitude of other improvements, real or imaginary, on things in general use, for which patents are obtained, having pre-existent things of the same nature, and used for the same general purpose, must be described in each specification; which, if it were possible to write it, as it would very seldom be, would be far too voluminous to be understood or read.

Thus, it is manifest that the discrimination contended for would be impossible as well as useless, in relation to improvements on unpatented machines. Where, indeed, a machine is already patented, it is very easy to describe it in the specification of the improvement, and point out all the particulars in which they differ from each other. The original specification is in the Patent Office, and may be referred to; the drawings and models are there, and may be seen. Here the rule requiring a discrimination in terms between the original invention and the improvement would not be unreasonable, and it might be useful, by tending to prevent disputes between the different patentees. The mistake of which we complain has probably arisen from not discriminating between improvements on patented and unpatented inventions. In the latter, the discrimination is manifestly impossible as well as useless. In the former, it would be easy, and might be of some use. It might be proper

Argument of counsel.

to require it in one case, whether the law positively enjoins it or not. To require it in the other, would be to make the law require what is both useless and impossible. This can never be done by the construction merely of a statute, which must always be reasonable. But it may be said that the statute positively enjoins it. If so, we must submit. When the legislature has clearly expressed its will, the court have no duty but to obey. This brings us to the question, what has the legislature enjoined on this subject?

3. All that can be supposed to relate to it is contained in the second and third sections. The second speaks of improvements; the third of specifications. It points out the object of the specification, and directs what shall be done for its attainment. The object is to put the public in complete possession of the invention, whether an improvement or an original discovery, so that interference with it may be avoided while the patent continues, and its benefits may be fully enjoyed by the public after the patent expires. To this end, it enjoins that the applicant "shall deliver a written description of his invention, and of the manner of using or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same." This is the directory part. The thing is to be described "so as to distinguish it from all other things before known." How distinguish it? By describing all the things before known, and pointing out in terms in what it differs from them all? Certainly not; but by giving a description of it so complete and accurate as "to enable any person skilled in the art, &c., to make, compound, and use the same." Is the discrimination contended for, but not mentioned in the statute, necessary for this purpose? By no means. Any person skilled in the art or science, in order to make, compound, and use the new invention, has but to look to the description of the invention itself. He need not know how nearly it resembles or how widely it differs from

Argument of counsel.

any other thing before known. With these he has no concern. And if, on the other hand, he wishes to use nothing before used and known, and to avoid interfering with the patented invention or improvement, he has only to compare the thing which he so wishes to make or use with the description of the patented invention or improvement contained in the specification, and he will immediately see wherein they differ, and be enabled to avoid the latter while he uses the former.

This section (the third) further directs, with a view to the same objects, that the applicant, the inventor, "in case of any machine," shall "fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions." Here, as in the rest of the section, nothing is said about improvements, as distinguished from original discoveries. They are all treated equally as "inventions," and are placed precisely on the same ground. They are all to be so described as that they may be distinguished in their principles and *modus operandi*, as well as in their construction and composition, from other inventions; and this is to be effected by means not of a formal discrimination in terms between them and any other thing or things of the same general nature, but of a full and accurate verbal description, aided by drawings, models, and specimens, where the matter is of such a nature as to admit their use. In all this, nothing is said or hinted about "improvements," as contradistinguished from "original discoveries." All are treated alike as "inventions," and the same means of enabling all concerned to distinguish them from things before used or known are provided in relation to both.

In fact, what is an "improvement" but a new invention? Every thing that is made better is improved, and every thing that makes another better, or does it in a better way, is an improvement. If it be new, it is an invention so far as it goes. The greater the improvement, the greater is the invention; and any improvement differs from any other, or

Argument of counsel.

from an original discovery, if there be any such thing, not in nature, but in degree. They may be greater inventions or less, more or less ingenious, or more or less useful ; but as far as they are, so they are all inventions, and are treated precisely alike by this portion of the Patent Law, which, I again repeat, makes no mention and gives no hint of a discrimination in the specification of an improvement, between the improvement, or the thing as improved, and the original thing on which the improvement is made. Treating them all alike as "inventions," it requires, with respect to all, that they shall be so described as clearly to distinguish them, that is, as to enable all concerned to distinguish them, from all other things of the same nature before in use or known. To construe the statute so as to make it require a description not only of the new invention, but of all things of the same general nature before known, and a discrimination in terms between them, would be as unreasonable in the case of an improvement as of an original discovery, and would be perfectly unreasonable in either. It would make the statute do that which its terms do not indicate, and which the law can never be presumed to intend. It would make it require what it is not only impossible in a great variety of cases to do, but what, if done, would in every case be wholly useless and vain. This it cannot be so construed as to require ; for *neminem ad vana aut ad impossibilia lex cogit*.

The counsel then adverted to the second section, where it was supposed, he said, that something might be found to support this doctrine of discrimination. That section spoke particularly of improvements, as to which the third was wholly silent. It said nothing whatever of the specification, its objects or motive. It made two provisions, both useful as declarations of the law, to put persons on their guard and prevent mistakes, but both undoubtedly law, without any such declaration. The first was, that the discoverer and patentee of an improvement in anything before patented should not be entitled to make, use, or vend the original ; nor the inventor and patentee of the original to

Argument of counsel.

make, use, or vend the improvement. Here again they were both considered as inventors, and both put on the same footing. It was declared, for general information, and to prevent doubts and mistakes, that one should not be entitled to the invention of the other ; but nothing was said about the manner of distinguishing these inventions one from the other. That was left to the third section, where it was done without the least mention or hint of the formal discrimination in terms contended for in the judgment below. It was manifest that this discrimination could derive no countenance from this branch of the second section. It obviously could derive none from the other branch, which, merely for giving information to the public and preventing mistakes, declared “ that simply changing the form or proportions of any machine or composition of matter, in any degree, shall not be deemed a discovery.” This merely amounts to saying, what would clearly have been the construction of the law without any such declaration, that to constitute a patentable discovery, either original or by improvement, there must be a new principle or *modus operandi*, and not merely a change of form or proportion. If the change of form or proportion should be such as to produce a new principle or *modus operandi*, then it would be a discovery or invention, whether it amounts to an original or an improvement only ; and here again improvements were treated as inventions, equally with original discoveries, the distinction between them being not in nature, but merely in degree.

But the point under consideration has been expressly settled by the former decision in this case ; the same objection for want of this discrimination was made in the court below, on the first trial, and the same doctrine on the subject expressly laid down by the Circuit Court. This doctrine formed one of the grounds of objection, distinctly stated in the argument of the former case in this court, and was distinctly noticed by the court ; and with this part of the opinion below, and the objection to it, distinctly in view, this court decided this patent on this same specifica-

Opinion of the court.

tion to be valid, notwithstanding its want of a discrimination in terms between the improvement and the original invention, which was an express decision on this point in favor of the plaintiff in error. He referred to various parts of the report of the former case of *Evans v. Eaton* (3 Wheat. Rep. 454 [p. 16, *ante*]) to support these positions ; remarking, that although the court certainly was not bound absolutely by its own decisions, and ought to overrule them when satisfied of their incorrectness, yet they were the great landmarks of the law, and ought not to be overturned or shaken without the strongest and clearest reasons.

The learned counsel also cited the authorities cited in the margin, as to the objection to the charge of the court below, upon the ground that it had invaded the proper province of the jury, in respect to the sufficiency of the specification, and to the nature of the patentee's invention as an improvement or an original discovery. [*Boulton v. Bull*] 12 H. Bl. 478, 484, 497 [1 Am. & Eng. 59, 97] ; [*Hornblower v. Boulton*] 8 T. R. 99, 101, 103 [1 Am. & Eng. 98] ; [*Whittemore v. Cutter*] 1 Gallis. 481 ; [*Lowell v. Lewis*] 1 Mason, 189, 191.

Mr. Justice STORY delivered the opinion of the court.

This is the same case which was formerly before this court, and is reported in 3 Wheat. Rep. 454, and by a reference to that report the form of the patent, the nature of the action, and the subsequent proceedings will fully appear. The cause now comes before us upon a writ of error to the judgment of the Circuit Court, rendered upon the new trial had in pursuance of the mandate of this court.

Upon the new trial, [*Evans v. Eaton*, 3 Wash. 443,] several exceptions were taken by the counsel for the plaintiff. The first was to the admission of a Mr. Frederick as a witness for the defendant. It is to be observed, that the sole controversy between the parties at the new trial was, whether the plaintiff was entitled to recover for an alleged breach of his patent by the defendant in using the improved hopper-boy. Frederick, in his examination on the *voir*

Opinion of the court.

dire, denied that he had any interest in the cause, or that he was bound to contribute to the expenses of it. He said he had not a hopper-boy in his mill at present, it being then in court; that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia; and that his hopper-boy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting-chest. Upon this evidence, the plaintiff's counsel contended that Frederick was not a competent witness, but the objection was overruled by the court. It does not appear from this examination whether the hopper-boy used by Frederick was that improved by the plaintiff or not; but, assuming it was, we are of opinion that the witness was rightly admitted. It is perfectly clear that a person having an interest only in the question, and not in the event of the suit, is a competent witness; and, in general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and does not exclude him. If nothing had been in controversy in this case as to the validity of the patent itself, and the general issue only had been pleaded, the present objection would have fallen within the general rule. But the special notice in this case asserts matter which, if true, and found specially by the jury, might authorize the court to adjudge the patent void, and it is supposed that this constitutes such an interest in Frederick in the event of the cause that he is thereby rendered incompetent. But, in this respect, Frederick stands in the same situation as every other person in the community. If the patent is declared void, the invention may be used by the whole community, and all persons may be said to have an interest in making it public property. But this results from a general principle of law, that a party can take nothing by a void patent; and so far as such an interest goes, we think it is to the credit and not to the competency of the witness. It is clear that the verdict in this case, if given for Evans, would not be evidence in a suit against Frederick, but Frederick would be

Opinion of the court.

entitled to contest every step in the cause, in the same manner as if no such suit had existed. *Non constat* that Frederick himself will ever be sued by the plaintiff, or that, if sued, any recovery can be had against him, even if the plaintiff's patent should not be avoided in this suit. It therefore rests in remote contingencies whether Frederick will, under any circumstances, have an interest in the event of this suit, and the law adjudges the party incompetent only when he has a certain, and not a contingent, interest. It has been the inclination of courts of law, in modern times, generally, to lean against exceptions to testimony. This is a case which may be considered somewhat anomalous ; and we think it safest to admit the testimony, leaving its credibility to the jury.

Another exception was to the refusal of the court to allow a deposition to be read by the plaintiff, which had been taken according to a prevalent practice of the State courts. It is not pretended that the deposition was admissible according to the positive rules of law, or the rules of the Circuit Court ; and it is not now produced, so that we can see what were the circumstances under which it was taken. No practice, however convenient, can give validity to depositions which are not taken according to law, or the rules of the Circuit Court, unless the parties expressly waive the objection, or, by previous consent, agree to have them taken and made evidence. This objection, therefore, may at once be dismissed.

The principal arguments, however, at the bar, have been urged against the charge given by the Circuit Court in summing up the charge to the jury. The charge is spread *in extenso* upon the record, a practice which is unnecessary and inconvenient, and may give rise to minute criticisms and observations upon points incidentally introduced for purposes of argument or illustration, and by no means essential to the merits of the cause. In causes of this nature, we think the substance only of the charge is to be examined ; and if it appears, upon the whole, that the law was justly expounded to the jury, general expressions,

Opinion of the court.

which may need and would receive qualification if they were the direct point in judgment, are to be understood in such restricted sense.

It has been already stated that the whole controversy at the trial turned upon the use of the plaintiff's hopper-boy ; and no other of the inventions included in this patent was asserted or supposed to be pirated by the defendant.

The plaintiff, with a view to the maintenance of his suit, contended that his patent, so far as respected the hopper-boy, had a double aspect : 1. That it was to be as a patent for the whole of the improved hopper-boy, that is, of the whole machine, as his own invention. 2. That if not susceptible of this construction, it was for an improvement upon the hopper-boy, and he was entitled to recover against the defendant for using his improvement. The defendant admitted that he used the improved hopper-boy, and put his defence upon two grounds : 1. That if the patent was for the whole machine, that is, the improved hopper-boy, the plaintiff was not the inventor of the improved hopper-boy so patented. 2. That if the patent was for an improvement only upon the hopper-boy, the specification did not describe the nature and extent of the improvement ; and if it did, still the patent comprehended the whole machine, and was broader than the invention. To the examination of these points, and summing up the evidence, the attention of the Circuit Court was exclusively directed ; and the question is, whether the charge, in respect to the matters of law involved in these points, was erroneous, to the injury of the plaintiff.

We will consider the points in the same order in which they were reviewed by the Circuit Court. Was the patent of the plaintiff, so far as respects his improved hopper-boy, a patent for the whole machine, as his own invention ? It is not disputed that the specification does contain a good and sufficient description of the improved hopper-boy, and of the manner of constructing it ; and if there had been any dispute on this subject, it would have been matter of fact for the jury, and not of law for the decision of the court.

Opinion of the court.

The plaintiff, in his specification, after describing his hopper-boy, its structure and use, sums up his invention as follows: "I claim as my invention the peculiar properties or principles which this machine possesses, in the spreading, turning, and gathering the meal at one operation, and the raising and lowering of its arms by its motion, to accommodate itself to any quantity of meal it has to operate upon." From this manner of stating his invention, without any other qualification, it is apparent that it is just such a claim as would be made use of by the plaintiff, if the whole machine was substantially, in its structure and combinations, new. The plaintiff does not state it to be a specific improvement upon an existing machine, confining his claim to that improvement, but as an invention substantially original. In short, he claims the machine as substantially new in its properties and principles, that is to say, in the *modus operandi*. If this be true, and this has been the construction strongly and earnestly pressed upon this court by the plaintiff's counsel, in the argument at the present term, what are the legal principles that flow from this doctrine? The Patent Act of the 21st of February, 1793, ch. 11, upon which the validity of our patents generally depends, authorizes a patent to the inventor, for his invention or improvement in any new and useful art, machine, manufacture, or composition of matter not known or used before the application. It also gives to any inventor of an improvement in the principle of any machine, or in the process of any composition of matter which has been patented, an exclusive right to a patent for his improvement; but he is not to be at liberty to use the original discovery, nor is the first inventor at liberty to use the improvement. It also declares that simply changing the form or the proportion of any machine or composition of matter, in any degree, shall not be deemed a discovery. It further provides that, on any trial for a violation of the patent, the party may give in evidence, having given due notice thereof, any special matter tending to prove that the plaintiff's specification does not contain the whole truth relative to

Opinion of the court.

his discovery, or contains more than is necessary to produce the effect, (where the addition or concealment shall appear to have been to deceive the public,) or that the thing secured by the patent was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a person's invention ; and provides that in either of these cases judgment shall be rendered for the plaintiff, with costs, and the patent shall be declared void. It further requires that every inventor, before he can receive a patent, shall swear or affirm to the truth of his invention, "and shall deliver a written description of his invention, and of the manner of using or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same ; and in the case of any machine, he shall fully explain the several modes in which he has contemplated the application of the principle or character by which it may be distinguished from other inventions."

From this enumeration of the provisions of the act, it is clear that the party cannot entitle himself to a patent for more than his own invention ; and if his patent includes things before known, or before in use, as his invention, he is not entitled to recover, for his patent is broader than his invention. If, therefore, the patent be for the whole of a machine, the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation. If the same combinations existed before in machines of the same nature, up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of operation, to the old, the patent should be limited to such improvement ; for if it includes the whole machinery, it includes more than his invention, and therefore cannot be supported. This is the view of the law on this point which was taken

Opinion of the court.

by the Circuit Court. That court went into a full examination of the testimony, and also of the structure of Evans's hopper-boy and Stouffer's hopper-boy, and left it to the jury to decide, whether, up to a certain point, the two machines were or were not the same in principle. If they were the same in principle, and merely differed in form and proportion, then it was declared that the plaintiff was not entitled to recover ; or, to use the language of the court, if the jury were of opinion that the plaintiff was not the inventor of the hopper-boy, he was not entitled to recover, unless his was a case excepted from the general operation of the act. We perceive no reason to be dissatisfied with this part of the charge ; it left the fact open for the jury, and instructed them correctly as to the law. And the verdict of the jury negatived the right of the plaintiff as the inventor of the whole machine. The next inquiry before the Circuit Court was, whether the plaintiff's case was excepted from the general operation of the act. Upon that, it is unnecessary to say more than that the point was expressly decided by this court in the negative, upon the former writ of error. And we think the opinion of this court, delivered on that occasion, is correctly understood and expounded by the Circuit Court. It could never have been intended by this court to declare, in direct opposition to the very terms of the Patent Act, that a party was entitled to recover, although he should be proved not to have been the inventor of the machine patented ; or that he should be entitled to recover, notwithstanding the machine patented was in use prior to his alleged discovery. There is undoubtedly a slight error in drawing up the judgment of the court upon the former writ of error ; but it is immediately corrected by an attentive perusal of the opinion itself. And we do not think that it can be better stated or explained than in the manner in which the Circuit Court has expounded it.

We are, then, led to the examination of the other point of view in which the plaintiff's counsel have attempted to maintain this patent : that is, by considering it not as a

Opinion of the court.

patent for the whole of the machine or improved hopper-boy, but as an improvement of the hopper-boy. Considered under this aspect, the point presents itself which was urged by the defendant's counsel, namely, that if it be a patent for an improvement, it is void, because the nature and extent of the improvement are not stated in the specification. The Circuit Court went into an elaborate examination of the law applicable to this point, and into a construction of the terms of the patent itself, and came to the conclusion that no distinct improvement was specified in the patent; that such specification was necessary in a patent for an improvement, and that for this defect the plaintiff was not entitled to recover, supposing his patent to be for an improvement only of an existing machine. It may be justly doubted whether this point at all arises in the cause; for the very terms of the patent, as they have been already considered, and as they have been construed at the bar by the plaintiff's counsel, at the present argument, seem almost conclusively to establish that the patent is for the whole machine, that is, for the whole of the improved hopper-boy, and not for a mere improvement upon the old hopper-boy. But, waiving this point, can the doctrine asserted at the bar be maintained, that no specification of an improvement is necessary in the patent; and that it is sufficient, if it be made out and shown at the trial, or may be established by comparing the machine specified in the patent with former machines in use? That there is no specification of any distinct improvement in the present patent, is not denied; that the patent is good without it, is the subject of inquiry. Let this be decided by reference to the Patent Act.

The third section of the Patent Act requires, as has been already stated, that the party "shall deliver a written description of his invention in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science, &c., &c., to make, compound, and use the same." The specification, then, has two objects: one is to make

Opinion of the court.

known the manner of constructing the machine, (if the invention is of a machine,) so as to enable artisans to make and use it, and thus to give the public the benefit of the discovery after the expiration of the patent. It is not pretended that the plaintiff's patent is not in this respect sufficiently exact and minute in the description. But whether it be so or not, is not material to the present inquiry. The other object of the specification is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent, and at the same time of taking from the inventor the means of practising upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification. Nothing can be more direct than the very words of the act. The specification must describe the invention "in such full, clear, and distinct terms as to distinguish the same *from all other things before known.*" How can that be a sufficient specification of an improvement in a machine which does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends—which describes the machine fully and accurately as a whole, mixing up the new and old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own? It seems to us perfectly clear that such a specification is indispensable. We do not say that the party is bound to describe the old machine, but we are of opinion that he ought to describe what his own improvement is, and to limit his patent to such improvement. For another purpose, indeed, with the view of enabling artisans to construct the machine, it may become necessary for him to

Dissenting opinion.

state so much of the old machine as will make his specification of the structure intelligible. But the law is sufficiently complied with in relation to the other point, by distinguishing, in full, clear, and exact terms, the nature and extent of his improvement only.

We do not consider that the opinion of the Circuit Court differs, in any material respect, from this exposition of the Patent Act on this point; and if the plaintiff's patent is to be considered as a patent for an improvement upon an existing hopper-boy, it is defective in not specifying that improvement, and therefore the plaintiff ought not to recover.

Upon the whole, it is the opinion of the majority of the court that the judgment of the Circuit Court ought to be

AFFIRMED WITH COSTS.

Mr. Justice LIVINGSTON dissented. At this late period, when the patentee is in his grave, and his patent has expired a natural death, we are called on to say whether his patent ever had a legal existence, and it may seem not very important to the representatives of the patentee what may be the decision of this court. But, understanding that many other actions are pending for a violation of this part of the patent-right, and that infractions have taken place for which actions may yet be commenced, and believing that the decision we are about to make will have a very extensive, if not a disastrous, bearing on many other patents for improvements, and will, in fact, amount to a repeal of many of them, I have thought proper to assign my reasons for dissenting from the opinion just delivered.

In doing this, my remarks will be confined principally to the charge of the court, so far as it applies to the claim of Evans for an improvement on a hopper-boy.

I was much struck with the argument of the plaintiff's counsel in favor of the patent being for an original invention, and not for an improvement; nor would it, in my opinion, be a forced construction to regard it as a patent for a combination of machines to produce certain results,

Dissenting opinion.

and not for any of the machines, nor the different parts of which the whole is composed.

But considering it as a patent for an improvement on a hopper-boy, in which light it had been regarded as well by the Circuit as by this court, when this cause was here before, I proceeded to examine the charge, so far as it relates to this part of the subject.

The court, after stating in what particulars the plaintiff's counsel contended that his improvement consists, which is unnecessary to repeat here, proceeds :

“The plaintiff has laid before you strong evidence to prove that his hopper-boy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered, which is, that the plaintiff's patent for an improvement *is void, because the nature and extent of his improvement is not stated in the specification.*

“The patent is for an improved hopper-boy, as described in the specification, which is referred to and made part of the patent. How does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating; and claims as his invention the peculiar properties or principles of the machine, namely, the spreading, turning, and gathering the meal, and the raising and lowering of its arms by its motion, to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the *original hopper-boy described*, either as to its construction, operation, or use, or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such originals stated? The undoubted truth is, that the specification communicates no information whatever upon any of these points.” And after some farther reasoning on the subject, and showing that the plaintiff's case is not excepted from the general rule of law by the act which was passed

Dissenting opinion.

for his relief, the court declares that for this imperfection or omission in the specification the “ plaintiff is not entitled to recover for an alleged infringement of his patent for the improvement on the hopper-boy.” This was equivalent to saying that for this defect in the specification the patent for the improved hopper-boy was void, and, of course, that no action at all, whatever might be the state of the evidence, could be maintained for the use of it. It left nothing, as it regarded the improved hopper-boy, for the jury to decide. Such is the charge, and it is delivered in terms too plain to be misunderstood.

The objections to it are now to be considered. In doing this, it will be shown :

1st. That the specification is not defective, and that although it does not discriminate in what particulars the machine in question does differ from other hopper-boys in use, yet if, from the whole of the description taken together, the machine is specified so minutely and so accurately as to be directly and easily distinguished from all other hopper-boys antecedently known, everything has been done which the law requires, and the patent is good.

2d. That if the specification be vicious in the points mentioned, the patent ought not to be considered as absolutely void ; but it is enough, and the public interest is sufficiently guarded, if care be taken that it shall not be extended to create a monopoly in any other machine, which may or may not be mentioned in the patent, which was previously known or in use. And—

3d. That if a patent must be set aside for such defect in the specification, it should be left to the jury, on the evidence before them, to decide whether the improvement patented be not set forth with all necessary precision.

1. I have said the specification is not defective.

In determining this question, it would seem but natural and just that the validity of a patent granted under a particular act of Congress should be tested by the terms there used, and by the decisions of our own courts, so far as they are of authority, and that we should be extremely cautious

Dissenting opinion.

in adopting the rules which have been introduced into other countries, and under laws not in every respect like our own, however respectable the tribunals may be which may have prescribed those rules; and this the more especially as most of the decisions in England, which are generally cited, and seem to have been implicitly followed in this country, are of a date long subsequent to the revolution, and many of them posterior to the passage of the Patent Laws in this country, and which could not therefore have been in the contemplation of Congress at the time. Besides, there is somewhat of hardship in constantly applying to a patentee in this country adjudications made on a British act of Parliament very unlike our own, and with which decisions he has no means of becoming acquainted until long after a knowledge of them can be of any service. Already have we extended to patents for improvements on old machines several recent decisions in England, although it was long doubted in that country, and as late as the year 1776, whether by the act of the 21 James I., ch. 3, there could be a patent for an addition only. When the English courts decided in favor of such patents, they also made rules for their construction as cases arose, there being no direct provisions in the statute on the subject. As we have provided by law, not only for the security of inventions entirely new, but also for the protection of those who may discover any new and useful improvement on any art, machine, &c., not known or used before, and have prescribed the terms on which patents under it may be obtained, it would seem, if all those terms are complied with, and the invention be really new and useful, that no court can have a right to add any other terms, or to require of a patentee anything more than what the law has enjoined on him. Let us now try the patent before us by this rule. The act of the 21st February, 1793, ch. 11, after stating in what cases letters patent for inventions may issue, and how they are to be obtained, requires, *inter alia*, that the inventor, before he receives his patent, shall take a certain oath, and shall deliver a written description of his invention, and of the manner of

Dissenting opinion.

using the same, in such full, clear, and exact terms as *to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same.* And in the case of a machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions ; and he is to accompany the whole with drawings and written references, where the nature of the case admits of it, and a model of his machine, if required by the Secretary of State, is also to be delivered.

In the present case, the patent is for an improved hopper-boy, a particular description of which, and its uses, will be found in 3 Wheat. Rep. 466. It is not pretended that this machine, if made in conformity with the description given by Mr. Evans, could not, in fact, be distinguished from everything else before known, when brought into comparison with it, nor that a skilful person, from its description, would not be able to make one like it ; which would seem to satisfy every requisition of the law. But the defendant's counsel say this is not enough. It should, not only in its organization and aggregate be different from everything else, but every respect in which it differs in its construction or operation from other machines should be minutely stated in the specification ; or, in other words, that other machines heretofore used for similar purposes should be either described or referred to therein, and the differences between the patented machines and those in former use be carefully designated.

The answer to this is, that the law does not require it—that it is impracticable, and would be of no use.

We have seen already that the law prescribes no precise form of specification, which would have been impracticable, and imposes no obligation to describe, in any particular mode, the machine in question. Not a word is said as to showing in what particulars the improvement patented

Dissenting opinion.

differs from all other machines for the same purpose then in use. If, on the whole description taken together, the machine of the plaintiff can be distinguished from other machines, when compared with his, the words and the object of the law are satisfied. The law appears to have nothing else in view, in requiring a specification, than the instruction of the public ; that is, to guard them against a violation of the patented improvement, and to enable them, when the letters patent expire, from the specification filed, to make a machine similar to the one which had been patented. The only inquiry, therefore, ought to be, whether this obvious intention of the legislature has been answered by the particular specification which may be the subject of litigation ; and if enough appears, either to prevent a person from encroaching on the right of the patentee, or to enable a skilful person to make a machine which shall not only resemble the one patented, but produce the like effect, more ought not to be required. Whether these ends be attained by a particular description of every part of the improved machine, or by describing in what respect it differs from other machines, can make no difference. The information to the public is as valuable and intelligible, if not more so, in the former case than in the latter. If it be, taken altogether, an improved machine, for the purpose of producing certain results, and so described that it may be distinguished from other machines, and that others may be made on the same model, it is a literal compliance with all that the law requires. If the different parts of the machine, and their combination or connection, be accurately described or intelligibly set forth, why should it not be supported, although no reference be made to other machines dissimilar in their construction, and which, although applied for the same purpose, are inferior in the beneficial results produced by them ? To the objection, that it does not precisely appear in what the patent hopper-boy differs from those antecedently in use, the answer is, and it ought to be conclusive, that the patentee does not mean to abridge or restrain the public from using those or any other machines, so that

Dissenting opinion.

they differ from the one described by him ; and that any mechanic, on having his specification before him, can avoid an interference with his invention. To confine our examination to the only hopper-boy which was produced on this trial, and which was called Stouffer's hopper-boy, and of which a model has been exhibited to the court, together with a model of Evans's improved hopper-boy, can a doubt be entertained for an instant that they are very dissimilar, and that any mechanic would not, in a moment, point out the distinctions between them, either from the specification or the model—or that he would not be able to make a Stouffer hopper-boy, or the improved hopper-boy of Evans, as he might be directed ; and in like manner he would be able, when brought together, to discriminate between any other hopper-boy and that of Evans, provided they were different, so that those who were desirous of having a hopper-boy, on an old construction, and of not interfering with the rights of Mr. Evans, would labor under no difficulty whatever ? But inasmuch as Evans himself has not discriminated or exhibited in his specification all the points of difference between his and other hopper-boys, it is supposed that his patent is for some hopper-boy already in use, as well as for his improvement thereon. The very terms of his specification precluded every supposition of that kind. If there were a thousand of those machines, on different constructions, in use before the date of his patent, he leaves to the public the undisturbed enjoyment of them. He meddles not, nor does he pretend to interfere with any of them, until they make or use one constructed, in all its parts, upon his model. That form, and that form alone, he claims as his invention or improvement. It would not have been difficult, even from British authorities, to show that this specification was sufficient ; but I prefer recurring to our own law as the only proper criterion of the validity or invalidity of the specification in question. My opinion is, that it has all the certainty which is required by law.

Such a specification as is required by the Circuit Court,

Dissenting opinion.

is not only not prescribed by law, but, to me, it appears to be one extremely difficult, if not impracticable.

If the inventor of an improved hopper-boy is to discriminate, in his specification, between his improvements and any particular hopper-boy which may be produced on the trial, and is to be nonsuited for not having done so, however correct and distinguishing it may be in every other respect, he must do the like as to all other hopper-boys; and if he must describe any, he must describe all others with which he may be acquainted; and, after all, some one may be introduced at the trial, of which he had never heard, or which he had never seen, and inasmuch as he had not stated in what respects it was improved by his machine, although this would immediately be seen on inspection, he must not only fail of recovering damages for a manifest violation of his right, but must have his patent declared void by the court, without a trial by jury, and be deprived of the fruits of a most valuable improvement, not because he was not the *bona fide* inventor—not because he had not described his improvement with sufficient certainty, according to the act of Congress—but because something more was required of him, of which he had no means of information. The only hopper-boy which made its appearance on this trial, except the plaintiff's, was that known by the name of the Stouffer hopper-boy; but *non constat* that there may not have been a hundred different kinds in use, and some entirely unknown to the plaintiff. If he could have described them all, which would not have been an easy task, and stated in what particulars his hopper-boy differed from them all, his specification would have extended to an immoderate length, and, after all, have been less intelligible and satisfactory than a full description, such as is given here, of all the parts of which his consisted, and of the manner in which they are put together. There may be cases in which an improvement may be so simple as to describe it at once by reference to the thing or machine improved, as in the case of an improvement of this kind on a common watch. But even in the case of a watch, if the

Dissenting opinion.

improvement pervades the whole machine, it would be a compliance with the terms of the law, if the patentee described every part of his improved watch, with its principle, without discriminating particularly in what respect his different wheels, &c., varied from all other watches then in use. Many patents have been obtained for improvements on stoves, locks, &c. ; but has it ever been required of the patentee, in such cases, not only to describe in what manner his stove or lock is constructed, and the benefits resulting from such construction, but to point out every particular in which they differ from those already in use ? This, to say the least, would be a work of great labor, and of little or no use to the public, who would be at liberty to use a stove or lock of any construction not interfering with the one described in the specification of the patentee.

A few observations will show that such a description as the defendant's counsel contend for would be of no greater use than the one which Mr. Evans has adopted. After all the pains to discriminate had been taken, the question would still recur, how is the improved hopper-boy to be constructed ? And if, from the specification, that could not be ascertained, then, and then only, ought it to be pronounced defective. But if, from the description, the improved hopper-boy could be made by a skilful mechanic, then the public is informed, not only of what has been patented, but of what still remains common as before, and if an action be brought for a violation of the patented right, and it should appear that the hopper-boy used is not of such construction, the plaintiff must fail in his suit. It cannot be said, with any justice, that if the discrimination be not made, the patent includes not only the improvement, but the old machine on which the improvement is ingrafted. The old machine still remains public property ; may be used by every one ; nor can any person be considered as infringing on the patent-right until he adds to the machine already in use the improvements of the patentee, or, in other words, until he makes a machine resembling, in all its parts, the one which is described in the specification.

Dissenting opinion.

2. But if the specification be defective in the points which have been mentioned, is the patent therefore necessarily void? This is a question of vital importance to every patentee.

I am aware that it has been said in England that the patent must not be more extensive than the invention; therefore, if the invention consists in an improvement only, and the patent is for the whole machine, it is void. But I am not aware that it has ever been decided there, that when a patent is for an "improved machine," and is taken out *only* for the machine *thus* improved, and not for the machine as before used, that such patent is void. But whatever may have been some of the late decisions in that country, I prefer, and think it the better course, to consider this question also under our own act, which, in this respect, is different from the English statute, and will therefore afford us more light and be a safer guide than either that statute or the judgment on it. In what part, then, of our act, may it be asked, is an authority given to the Federal courts to declare a patent void for a defective specification, however innocently made, and which in its consequences can injure no one? I state the question in this way, not because I think it necessary to show that if injurious consequences might flow from an imperfect specification, a patent must necessarily be declared void, but because I think it must be admitted that there is no evidence whatever in this cause to induce any one to believe that Mr. Evans either intended to take or that he did receive a patent for anything beyond his invention, which was the hopper-boy in the improved condition in which he describes it. To declare a patent for a highly-useful improvement absolutely void, merely for a defective specification, if this be one, is a very high penalty, and should not be lightly inflicted, unless rendered absolutely necessary by law; the more especially as, without recurring to so harsh a measure, a court and jury will always be able to confine a remedy on the patent to violations of the improvement actually secured, and if the patentee should be so foolish or ill-advised as to attempt to bring within its reach the machine in its unim-

Dissenting opinion.

proved state, or any other machine before common, he would do it, not only with no prospect of success, but with the certainty of a defeat, attended with a very heavy expense. As long, therefore, as he could maintain no action but for his improvement, it is not perceived why he should be visited with so heavy a denunciation as the forfeiture of his improvement, merely because, by some construction of his specification, which might after all be a mistaken one, he had included in his invention something of ever so trifling a nature which was already known. But if such be the law, and such the frail tenure on which these rights are held, however hard it may apply in particular cases, it must have its course. But I cannot think it our duty, or that we have any right, to pronounce a patent void on this account; but that this important office is exclusively confided to a jury. Whether we have this right or not, will now be examined. If such summary authority were intended to have been conferred on the Federal courts, the Patent Law ought to have been, and would have been, explicit. This is so far from being the case, that in the Patent Law, a provision, but of a different kind, is inserted on this very subject, which is not the case in the statute of James. It was foreseen that it must sometimes happen, either from the imperfection of language or the ignorance of a patentee, that defective specifications would be made; it was also foreseen that an imperfect specification might be made from design, and with a view of deceiving the public. We accordingly find it provided, by law, that among other matters which the defendant may rely on in an action for infringing a patent-right, is, "that the specification filed does not contain the *whole* truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition must *fully* appear to have been made for the purpose of *deceiving* the public." If judgment is rendered for the defendant on this ground, the patent is to be declared void. This section applies as well to patents for an improvement on an existing machine as for an invention entirely new, and was

Dissenting opinion.

intended to protect the patent in either case against an avoidance for an imperfect and innocent specification of the invention patented. If, therefore, the defect which is alleged really exist in the specification of the patented improvement, the court is not authorized, on its mere inspection, to declare it imperfect, and the patent on that account void. Both questions are clearly questions of fact, and are so treated by the legislature. The party has a right to insist with the jury, not only that his specification is perfect, but that, if it be otherwise, no deception was intended on the public ; and on either ground they may find a verdict in his favor. So if, on the allegation that the thing secured by patent was not originally discovered by the patentee, a verdict passes against the plaintiff, he loses his patent. In like manner, in this case, if it had appeared that the "improved hopper-boy," which was the thing secured by patent, had not been originally discovered by Mr. Evans, and a verdict had passed against him on that ground, there would have been an end of his patent. From the tenth section, also, an argument may be drawn against the right of a court to declare a patent void, on mere inspection, for redundancy or deficiency in a specification. This section provides a mode of proceeding before the District Court, where there may be reason to believe a patent was obtained surreptitiously, or upon false suggestions ; and if, on such proceeding, it shall appear that the patentee was not the *true inventor*, judgment shall be rendered by such court for a repeal of the patent. This is the only case in which a power is conferred on a court to vacate a patent without the intervention of a jury. If a proceeding of this kind had been instituted before the proper tribunal against Mr. Evans, the court would have examined witnesses, and have formed its opinion on their testimony ; and it is not clear that even in this case a jury might not have been called in. This section has been taken notice of, to show that it could never have been the intention of the legislature that a patent should be avoided, on any account whatever, on the opinion of the court alone, without some examination other

Dissenting opinion.

than that of the specification, whatever might be its excess or poverty of description. If it had been intended to vest so important a power in the court, it would not have been left to mere implication, but would have been conferred in terms admitting of no doubt. My opinion, therefore, on this part of the charge is, that the court erred in taking upon itself to pronounce the patent void, even if the specification had been defective or imperfect in not particularly describing what the improvements of the patentee were, this being a power expressly delegated to a jury, who, under all the circumstances of the case, are to decide both questions of fact ; that is, whether the specification be deficient or superfluous, and the *intention* with which it was made so. I repeat once more, that whatever may have been the decisions in England, which are not admitted to be contrary to the view which has here been taken of the subject, they are not of authority, and are upon an act so very different in its structure from our own as to afford little or no useful information upon the subject. One great and important difference in the two laws is, that the statute of James I. has not prescribed a mode in which a patent for a vicious specification is to be set aside. The patent is granted on condition that a specification be enrolled.

I give no opinion on the questions which arise from the admission of certain witnesses who were supposed to be disqualified on the score of being interested ; for if the patent for the hopper-boy be void for a defect in its specification, and that question is not to be referred to the jury, and such I understand to be the opinion of four of the judges, it is very unimportant whether any error was committed in this respect by the court before which the cause was tried, as a verdict must ever be rendered against the representatives of the patentee on this ground, whatever may be the state of the evidence.

Mr. Justice JOHNSON and Mr. Justice DUVALL also dissented.

JUDGMENT AFFIRMED WITH COSTS.

Notes and Citations.

Notes :

6. Wood *v.* Underhill, 5 How. 1.
Battin *v.* Taggert, 17 How. 74.
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8. Act 1790, §§ 1, 2 ; **Act 1793, § 1** ; Act 1800, § 1 ; Act 1836, §§ 5, 6 ; Act 1863, § 1 ; Act 1870, §§ 22, 24, 26 ; R. S., §§ 4884, 4886, 4888.
Act 1793, § 3 ; Act 1836, § 6 ; Act 1837, § 6 ; Act 1842, § 4 ; Act 1870, §§ 27, 28, 29, 30 ; R. S., §§ 4889, 4890, 4891, 4892.
Act 1790, § 6 ; **Act 1793, § 6** ; Act 1836, § 15 ; Act 1870, § 61 ; R. S., § 4920.
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9. Aliter, Act 1837, § 7 ; Act 1870, § 54 ; R. S., § 4917.
See Cantrell *v.* Wallick, 117 U. S. 689.
O'Reilly *v.* Morse, 15 How. 62 and note.
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11. Identity, when a question for jury.
See Turrill *v.* Railroad, 1 Wall. 491.
Bischoff *v.* Wethered, 9 Wall. 812.
Heald *v.* Rice, 104 U. S. 737.
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12. Sufficient description of improvement.
Hogg *v.* Emerson, 6 How. 437.
Corn Planter Patents, 23 Wall. 181.
Ives *v.* Hamilton, 92 U. S. 426.
Parks *v.* Booth, 102 U. S. 96.

Notes and Citations.

13. *Vide ante*, note 8.

Patent in suit :

No. . Evans, O. December 18, 1790. Hopper-boy.

OTHER SUITS ON SAME PATENT :

Evans v. Chambers, 1807. 2 Wash. 125 ; 1 Robb. 7.

Evans v. Weiss, 1813. 2 Wash. 342 ; 1 Robb. 10.

Evans v. Robinson, 1813. 1 Car. L. R. (N. C.) 209 ; 1 Brunn.
Coll. Cases, 400.

Evans v. Jordan, 1813. 1 Brock. 248 ; 1 Robb. 20.

Evans v. Jordan, 1815. 9 Cranch, 199 ; 1 Robb. 57 ; 1 Whit. 3.

Evans v. Kremer, 1816 ; 1 Pet. C. C. 215 ; 1 Robb. 66.

Evans v. Eaton, 1816. 1 Pet. C. C. 322 ; 1 Robb. 68.

Evans v. Hettich, 1818. 3 Wash. 408 ; 1 Robb. 166.

Evans v. Eaton, 1818. 3 Wheat. 454 ; 1 Robb. 243 ; 1 Whit. 8.

Evans v. Eaton, 1818. 3 Wash. 443 ; 1 Robb. 193.

Evans v. Hettich, 1822. 7 Wheat. 453 ; 1 Robb. 417 ; 1 Whit. 104.

Citations :**IN SUPREME COURT OF UNITED STATES :**

Evans v. Hettich, 1822. 7 Wheat. 453 ; Bk. 5, L. ed. 496 [p. 182
post].

Carver v. Jackson, January, 1830. 4 Peters, 81 ; Bk. 7, L. ed.
761.

Green v. Lessee of Neal, January, 1832. 6 Peters, 297 ; Bk. 8,
L. ed. 402.

Hogg v. Emerson, 1848. 6 How. 437 ; Bk. 12, L. ed. 436.

Smith v. Kernochen, January, 1849. 7 How. 219 ; Bk. 12, L. ed.
666.

Notes and Citations.

Brooks *v.* Fiske, December, 1853. 15 How. 212 ; Bk. 14, L. ed. 665.

IN CIRCUIT COURTS :

Pettibone *v.* Derringer, April, 1818. 4 Wash. 215 ; 1 Robb. 152.
 Whitney *v.* Emmett, April, 1831. 1 Bald. 303 ; 1 Robb. 567.
 Blanchard *v.* Sprague, May, 1839. 2 Story, 164 ; 1 Robb. 742.
 Wyeth *v.* Stone, October, 1840. 1 Story, 273 ; 2 Robb. 23.
 Bork *v.* Norton, June, 1841. 2 McLean, 422.
 Brooks *v.* Bicknell, July, 1843. 3 McLean, 250 ; 2 Robb. 118.
 Brooks *v.* Jenkins, July, 1844. 3 McLean, 432 ; Fish. Pat. Rep. 41.
 Hovey *v.* Stevens, October, 1846. 3 Wood and Minot, 17 ; 2 Robb. 567.
 Webster Loom Co. *v.* Higgins, January, 1879. 15 Blatch. 446 ;
 4 Ban. & Ard. 88 ; 16 O. G. 675.
 Sawyer *v.* Miller, May, 1882. 4 Woods, 472 ; 12 Fed. Rep. 725.

IN STATE COURTS :

Cross *v.* Huntley, January, 1835. 13 Wend. 385.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 41, 68.
 Walker on Pats., 1883, p. 384.
 Curt. on Pats., 4th ed., §§ 227, 232, 492.

Statement of the case.

EVANS v. HETTICH.

7 Wheat. 458-470. Feb., 1822.

[Bk. 5, L. ed. 496 ; 1 Robb. 417 ; 1 Whit. 104.]

Affirming *ibid.*, 3 Wash. 408.

Competency of witness. Taking depositions.

1. Where witness was sued for infringement of plaintiff's patent-right in another cause, *held* that it did not render him incompetent (p. 194).
2. Where witness was asked as to the identity of defendant's machine with plaintiff's model in court, *held* that it was not included in the class of cases of which notice was necessary under Act 1793, § 6, and was perfectly proper under the general issue (p. 194).
3. Questions put to witness as to acts among strangers, *held* properly overruled (p. 195).
4. Deposition introduced with the acquiescence and consent of plaintiff, cannot afterward be objected to (p. 195).
5. If witness is sane at the time of giving his testimony, the fact that he is subject to fits of derangement is no objection either to his competency or credibility (p. 195).

[Citations in the opinion of the Court :]

(1) Evans v. Eaton [p. 105, *ante*]. Pp. 193, 194.

ERROR to the Circuit Court of Pennsylvania.

This was an action for the infringement of the same patent as in the preceding case of Evans v. Eaton, and was argued by the same counsel. The points involved will be found to be fully discussed in the argument of that case, to which the learned reader is referred. The following is the charge delivered to the jury in the court below, which it is thought necessary here to insert.

Statement of the case.

After stating the evidence on both sides, Mr. Justice WASHINGTON proceeded as follows :

The facts intended to be proved by the evidence given in this cause may be arranged under the following heads :

(1.) Such as respect the value of the plaintiff's hopper-boy. (2.) The time of its discovery. (3.) The kind of machine used by the defendant. (4.) The time of its discovery and use.

1st. As to the first, the court has no observations to make, except that if you should find a verdict for the plaintiff, you will give the actual damages which the plaintiff has sustained by reason of the defendant's use of his invention, which the court will treble.

2d. The evidence applicable to this head, if believed by the jury, proves that, in 1783, Oliver Evans commenced his investigation of the subject of an improvement in the manufacture of flour ; and in the summer of the same year he declared that he had accomplished it. In 1784, he made a model of his hopper-boy, which had no cords, weight, or pulley ; and consequently the lower arm was, for the sake of the experiment, turned by the hand. In 1785, it was in operation in a mill, in as perfect a state as it now is.

3d. If the witness who was called to prove the kind of machine used by the defendant is believed by the jury, it consists of an upright square shaft, with a cog that turns it, and which is moved by the water-power of the mill. This shaft is inserted into a square mortise, in an arm or board somewhat resembling an S, with strips of wood fixed on its under side, and so arranged as to turn the meal below it, cool, dry, and conduct it to the bolting-chest. This arm slips, with ease, up and down the shaft, and must be raised by hand, and kept suspended until the meal is put under it. It has no upper arm, pulley, weight, or leading lines ; and the strips below the arm are like the rake, as it is called, in the plaintiff's hopper-boy. This machine has acquired the name of the S, or the Stouffer hopper-boy.

4th. The witnesses examined to prove the originality and use of the defendant's hopper-boy, if believed by the jury,

Statement of the case.

date it as early as about the year 1765 ; and its erection and actual use in mills, in 1775 and 1778 ; and progressively to later periods. Objections have been made, on both sides, to the credit of some of the witnesses who have been examined, not on the ground of want of veracity or of character, but of interest, short of that which can affect their competency. These objections have been pressed so far beyond their just limits as to require from the court an explanation of their real value. Where the evidence of witnesses opposed by other witnesses is relied upon, by either side, to prove a particular fact, the jury must necessarily weigh their credit, in order to satisfy their own minds on which side the truth is most likely to be ; and, in making this inquiry, every circumstance which can affect the veracity of the witnesses, whether it concerns their moral character, or whether it arises from some interest which they may have in the question, or from feelings favorable to one or the other of the parties, should be taken into the calculation. But if the fact in controversy may exist without a violation of probability, and the proof is by witnesses exclusively on that side, there is nothing to put into the opposite scale against which to weigh the credit of those witnesses ; and if the objection to their credit be worth anything, it must be to the full extent of rejecting their testimony altogether, or else it is worth nothing. The jury cannot compromise the matter, or halt between two opinions,—they must decide that the fact is so, or is not so ; and if the latter be cause of objection to the credit of the witnesses, it would amount to the confounding of the questions of competency and credibility ; for the effect would be the same, whether the court refused to permit the witnesses to testify on the ground of incompetency, or the jury should reject their testimony, when given, on that of want of credibility. I have thought it proper to submit these general observations to the consideration of the jury.

We come now to the question of law which arises out of these facts, which is : “ What are *the things* in which the plaintiff alleges, and has proved, he has an exclusive prop-

Statement of the case.

erty, which he asserts the defendant has used, and which the defendant denies ?”

The first claim is for an improved hopper-boy, which the plaintiff insists is granted by his patent, which has received the sanction of the Supreme Court, and which the defendant acknowledges. This being, then, conceded ground, the court will proceed to examine it ; and the inquiry will be, whether the plaintiff is entitled to a verdict for an infringement of his patent for his improved hopper-boy. The objection relied upon by the defendant is, that the plaintiff has not set forth in his specification what are the improvements of which he claims to be the inventor so that a person skilled in the art might comprehend distinctly in what they consist. This objection, in point of fact, is fully supported. Neither the specification nor any other document connected with the patent states, or even alludes to, any specific improvement in the hopper-boy. Taking this as true, how stands the law ? The third section of the Patent Law declares that “ before an inventor can receive a patent he shall deliver a written description of his *invention*, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable a person skilled in the art, &c., of which it is a branch, &c., to make and use the same.”

What, then, is the plaintiff's invention, as asserted by his counsel, conceded by the defendant, and sanctioned by the Supreme Court in the case of *Evans v. Eaton* ? The answer is, an improvement of the hopper-boy, or an improved hopper-boy, which that court has decided to be substantially the same. If this be so, then the above section of the law has declared that he must specify this improvement in full, clear, and exact terms. If he has not done so, he has no valid patent on which he can recover.

The English decisions correspond with the injunctions of our law. *Boulton v. Bull* [1 Am. & Eng. 59], *Bovill v. Moore* [1 Am. & Eng. 268], *M'Farlane v. Price* [1 Am. & Eng. 227], *Harmer v. Playne* [1 Am. & Eng. 171]. See 3 Wheat. Rep., App. 21 [*ante*]. The American decisions,

Statement of the case.

so far as we have any reports of them, maintain the same doctrine. Mr. Justice STORY, in the case of *Lowell v. Lewis* [1 Mason, 182], lays it down "that if the patent be for an *improvement* in an existing machine, the patentee must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new ; for if both are mixed together, and a patent taken for the whole, it is void." What is the reason for all this ?

In the first place, it is to enable the public to enjoy the full benefit of the discovery, when the patentee's monopoly is expired, by having it so described on record that any person skilled in the art of which the invention is a branch may be able to construct it. The next reason is, to put every citizen upon his guard, that he may not, through ignorance, violate the law by infringing the rights of the patentee, and subjecting himself to the consequences of litigation. The inventor of the original machine, if he has obtained a patent for it, and all persons claiming under him, may lawfully enjoy all the benefits of that discovery, notwithstanding the improvement made upon it by a subsequent discoverer. If he has not chosen to ask for a monopoly, but abandoned it to the public, then it becomes public property, and any person has a right to use it. The inventor of an improvement may also obtain a patent for his discovery, which cannot legally be invaded by the inventor of the original machine or by any other person. These rights of each are secured by law, and there is no incompatibility between them. But if a man, wishing to use the original discovery, and honestly disposed to avoid an infraction of the improver's right, is unable to discover, from any certain and known standard, where the original invention ends and the improvement commences, how is it possible for him to exercise his own acknowledged right, freed from the danger of invading that of another ? And to what acts of oppression might not this lead ? Might not the patentee of this mysterious improvement obtain from the ignorant, the timid, and even the prudent members of society, who wish to use only the original discovery, the price he chooses

Statement of the case.

to ask for a license to use his improvement, and in this way compel them to purchase it, rather than incur expenses and inconveniences far greater than the sum demanded? If this may happen, then the improver enjoys, in a degree, the benefit of a discoverer, both of the original machine and also of the improvement. In short, the patentee of the improvement may, to a certain extent, keep men at arm's length as to the use of the original invention, or make them pay for it, in derogation of the rights of the inventor of the original machine. If the law, as applicable to cases in general, be rightly laid down, the next inquiry is, is the present an excepted case? The plaintiff's counsel have not directly asserted it to be so; but they have referred, with some emphasis, to what is said by the Supreme Court in the case of *Evans v. Eaton*. 3 Wheat. Rep. 518 [*ante*]. The expressions are, "In all cases where the plaintiff's claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists."

This decision does not state in what way the extent of the plaintiff's improvement is to be proved; nor did the case require that the Supreme Court should be more explicit. The obvious conclusion is that the court left that matter undecided, and meant that the extent of the plaintiff's improvement should be shown according to rules of law. A contrary construction would be most unfair and unwarranted.

Is it possible to believe that if the Supreme Court intended to decide contrary to the provisions of the third section of the Patent Law, and of the English and American decisions, that this was a case without the influence of that law and those decisions, that such intention would have been expressed in such general terms? This cannot be admitted; neither can the private act for the relief of Oliver Evans warrant the argument that this case is freed from the restrictions contained in the third section of the Patent Law, because, except as to the extent of the grant, it refers

Statement of the case.

to, and the Supreme Court in the before-mentioned case considers it as within, the provisions of that law.

Is it likely that the Supreme Court could have meant that the plaintiff might cure the defects of his specification by *proving to the jury* in what his improvement consisted? If so, then, as to the present defendant, such an explanation would be unavailing to save him from the consequences of an error against which the sagacity of man could not have guarded him. He has sinned already, if he has invaded the plaintiff's right, and it is too late to convince him of his error, if he must be a victim of it for the want of that light which is now shed upon the act long after his supposed transgression. But of what avail would that explanation be after the expiration of the plaintiff's monopoly? The parol evidence given in a court of justice being seldom recollected with accuracy, it affords the most unsafe notice of facts, particularly when they respect matters of art, that can well be supposed. What man, who wishes not to invade the plaintiff's patent, would venture to erect a hopper-boy merely upon the information which he could gather from this trial? He could obtain none upon which he could safely rely; nor could any artist, after the expiration of the plaintiff's right, be enabled from such a source to know how to construct the improved hopper-boy. But even if the extent of the improvement could be proved in this way, the plaintiff has not attempted to prove it, and, what is more, his counsel, though repeatedly called upon to point it out, have not been able to do it.

Can the jury, without evidence, and without the aid of the plaintiff or his counsel, say in what those improvements consist? If they had never seen another hopper-boy, supposed to be the original, this would be impossible. If, having seen the Stouffer hopper-boy, they can do so by comparing with it the plaintiff's improved hopper-boy, then the consequence seems almost to be inevitable that the Stouffer hopper-boy is the original one—the point which, under the next head, is denied by the plaintiff. But if the specification had stated in what the plaintiff's improvement con-

Statement of the case.

sisted, still he is not entitled to a verdict for a violation of his patent, unless he has proved, to your satisfaction, that the defendant has infringed it.

Upon the whole, then, this patent, so far as it is for an improvement, cannot be supported ; and, as to any claim founded on this right, the plaintiff is not entitled to your verdict.

2. The plaintiff contends that he is the original inventor, not only of the improved hopper-boy, but of the whole machine ; that his patent grants him the exclusive right for both ; and that this claim has received the sanction of the Supreme Court. Whether, in point of fact, he is the original inventor of the hopper-boy, will be attended to hereafter. Neither shall I stop to inquire whether the plaintiff's patent grants him the right, because, if the Supreme Court has sanctioned the claim, that is law to this court. The part of the decision of that court relied upon by the plaintiff's counsel is found in 3 Wheat. Rep. 517, where the Chief Justice says : " The opinion of the court, then, is, that Oliver Evans may claim under his patent the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered."

It would seem almost impossible to misunderstand this positive declaration of the court. It appears to be the result of the previous reasoning. It states that the plaintiff may claim : (1.) The exclusive use of improvements and inventions in the art of manufacturing flour. (2.) In the *several machines* which he has invented. (3.) In his *improvements* on machines previously discovered. As to the first, there is no dispute in the cause. The third has been already disposed of, and the second will now be examined. It is contended, by the defendant's counsel, that this is not the correct construction of the above sentence of the court, because it is inconsistent with the pretensions of the plaintiff's counsel, and with the argument of the Chief Justice, throughout the opinion, which led to the above conclusion.

Statement of the case.

This supposed inconsistency may, in the opinion of this court, be explained by the following observations :

The exceptions taken to the charge of this court, in the case of *Evans v. Eaton*, were, first, that Oliver Evans's patent was only for the combined effect of all the machines mentioned in his patent, and, second, in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made by Oliver Evans. These were the only questions presented to the view of the Supreme Court, upon which it was deemed proper by that court to give an opinion. The reasoning of the Chief Justice, therefore, is intended to prove and correct these errors in the charge, by showing that Oliver Evans was entitled, by his patent and the accompanying documents, not only to the general combination of the different machines, but to an *improvement* on the hopper-boy, one of the machines used in combination. If he had a right to an improvement on the hopper-boy, then this court was clearly wrong in directing the jury to find a verdict for the defendant, if they should be of opinion that the hopper boy was in use prior to the plaintiff's improvement, because it was unimportant who was the original discoverer of the hopper-boy, provided the plaintiff had a patent for an improved hopper-boy, and the defendant used that improvement, and the charge precluded that inquiry. But while the Chief Justice aims to prove that Oliver Evans was entitled to this double claim, he does not exclude any other claim. There is an expression relied upon, by the defendant's counsel, as having this appearance ; but it is more likely that the word relied on is a typographical error, than that the court should both deny and affirm the plaintiff's right as an original inventor of the hopper-boy. When the court came to state definitely what were the plaintiff's claims under this patent, the whole are distinctly stated. The act for the relief of Oliver Evans authorizes a grant to him of his improvement in the art of manufacturing flour, and in the several machines which he has invented, and in his improvement, &c. The court says

Statement of the case.

that "the application is for a patent coextensive with the act," &c. 3 Wheat. Rep. 508 [*ante*].

If, then, in this enumeration of the plaintiff's rights under the patent, those to the machines had been omitted, it might have been supposed that it was not recognized by that court, and it is, consequently, introduced in order to prevent a conclusion against its validity, although it had not been brought into view in the previous argument, because a matter not in dispute. This course of reasoning is, we think, strongly fortified by what the court says, page 518, [p. 83, *ante*,] "In all cases where his claim is for an *improvement*," &c. Now, if his claim was confined to an improvement produced by the combined operation of all the machines, and if an improvement in the separate machines, why should the court have stated hypothetically that which was to be proved in case the plaintiff claims for an improvement? The sentence following immediately that which was relied on by the defendant's counsel seems to explain it, and to fortify the construction which we have given to it. Upon the whole, we are of opinion that the question who is the original inventor of the hopper-boy is left open by the Supreme Court, and is now to be decided by the jury. If, then, the jury should be opinion, upon the evidence, that the hopper-boy which the defendant uses was invented and was in use prior to the discovery of Oliver Evans, then your verdict ought to be for the defendant. But to this construction there are objections made which it is proper to notice.

1. It is contended that the *judgment* of the Supreme Court in Evans v. Eaton, (3 Wheat. Rep. 519 [*ante*],) where it is said that there is error in the proceedings below, in this, that in the charge the opinion is expressed "that Oliver Evans was not entitled to recover if the hopper-boy *in his declaration mentioned* had been in use previous to his alleged discovery," entitles the plaintiff to a verdict, although the jury should be of opinion that he is not the original inventor of the hopper-boy. That the court did not mean this, is most obvious, from what is said on page 517,

Statement of the case.

[p. 83, *ante*,] that Oliver Evans may claim the exclusive use in the several machines *which he has invented*. Could the Supreme Court intend to say, immediately after, that he is entitled to a verdict for a machine which he has not invented? Can it be supposed that the court meant to ride over the third section of the Patent Law, and set up a different rule to govern this case, without having stated the reasons for so extraordinary a distinction? This is altogether inadmissible. It is also worthy of remark, that the words "in his declaration mentioned," in the judgment of the Supreme Court, are not in the charge of the Circuit Court, as stated by the Chief Justice; and it is the insertion of those words in the judgment which produces all the difficulty. Leave them out, and then the judgment is consistent with the whole reasoning of the Chief Justice, which condemned the charge of the Circuit Court, because it precluded Oliver Evans from obtaining a verdict for his *improvement*, if he was not the original inventor of the elementary parts of this machine. Retain them, and it follows that if Oliver Evans was proved not to be the inventor of the hopper-boy in his declaration mentioned, still the defendant was not entitled to a verdict. This would be in such direct opposition to the sixth section of the Patent Law, that we cannot suppose this was the meaning of the Supreme Court.

2. The next objection to the construction is, that the act of the Legislature of Pennsylvania, of 1787, conveyed to Oliver Evans the original hopper-boy, and, consequently, the existence and use of the Stouffer hopper-boy, at a period prior to the plaintiff's discovery, cannot now be urged to invalidate his patent. It is by no means to be admitted that the act operates to make such a transfer. But if it did, still the plaintiff cannot recover, if he appears not to be the first or original discoverer of the hopper-boy. His claim is not derivative either from the State or from an individual. His suit is founded on his patent, and unless he was himself the original inventor of the hopper-boy, he cannot recover.

Opinion of the court.

3. Another objection stated by the plaintiff's counsel is, that the Stouffer hopper-boy, although the jury should believe it was in use in many mills before the plaintiff's discovery, had fallen into disuse, and therefore cannot be urged to invalidate the plaintiff's right of recovery. The answer to this is, that, whether it fell into disuse or not, if it was used before the plaintiff's discovery, the plaintiff could not obtain a patent for it, so as to exclude the defendant from using it, if he chose to do so.

4. The last objection is, that the use of the Stouffer machine cannot affect the plaintiff's patent, unless it was public. Whether that hopper-boy was in public use or not, the jury will judge from the evidence. It was erected and used in four or five mills, if the defendant's witnesses are believed. But this argument has no foundation in the act of Congress, which does not speak of public use. It is material whether the patentee had notice of the prior invention or not. If it was in actual use, in any part of the world, however unlikely or impossible that the fact could come to the knowledge of the patentee, his patent for the same machine cannot be supported.

A verdict was rendered for the defendant, and, exceptions being taken to the above charge, the cause was brought by a writ of error before this court.

Mr. Justice STORY delivered the opinion of the court.

This case is an action for an infringement of the same patent as in *Evans v. Eaton*, [*ante*,] and many of the remarks in that case are applicable to this; and therefore the opinion now delivered will refer to such points only as are not completely disposed of by the opinion already delivered. The evidence in this case does not establish that the defendant used the plaintiff's improved hopper-boy; but the hopper-boy used by the defendant is asserted to be Stouffer's hopper-boy. At the new trial, a Mr. Aby was offered as a witness by the defendant, to prove the nature and character of the hopper-boy used by the defendant.

Opinion of the court.

The plaintiff objected to his testimony as incompetent, because he was sued by the plaintiff for an infringement of his patent-right, under circumstances similar to those alleged in proof against the defendant. The court overruled the objection, and the witness was then sworn on the *voir dire* as to his interest in the suit ; but, upon a full examination, it did not appear that he was really interested, and the court therefore permitted him to be sworn in chief. The plaintiff took an exception to this decision of the court. The objection to the competency of Aby, so far as he has an interest from being sued, cannot be distinguished, in principle, from that already overruled in the case of *Evans v. Eaton* [7 Wheat. 356, p. 105, *ante*]. There is this additional circumstance in this case, that Aby was not called as a general witness, but to establish a single fact, namely, the nature of the hopper-boy used by the defendant. The other objection, upon his answers on the *voir dire*, is disposed of by the single remark that he purged himself of any real interest in the event of the suit. A question was asked of this witness, on his examination in chief, whether the hopper-boy in the defendant's mill was like the model exhibited in court of the plaintiff's patented hopper-boy. The plaintiff objected to the question, because such testimony could not be given in this case, for want of notice thereof. But the objection was overruled by the court, and, in our judgment, with perfect correctness. No notice was necessary to authorize the inquiry ; and if the plaintiff meant to rely on the notice required by the sixth section of the Patent Act in certain cases, it is only necessary to say that this was not within the provision of that class of cases. The question was perfectly proper under the general issue. Similar objections were taken to other witnesses, but it is unnecessary to remark on them.

An inquiry was proposed by the plaintiff to one of the witnesses, whether one Peter Stouffer had paid the plaintiff for a license for his mill, but the court refused to allow the question to be asked ; and we see no reason why it should have been allowed, for it merely referred to an act among

Notes and Citations.

strangers, which ought not to prejudice the defendant. A similar question was proposed to be asked of the same witness, whether the executors of Jacob Stouffer had paid the plaintiff for a license for the mill of Jacob. The court overruled the question ; and, for the same reason, it was rightly overruled.

The deposition of one John Shetter was read in evidence by the defendant, without opposition, and afterward the plaintiff moved to have the same rejected, because not taken according to the rules of the court ; but the court refused to reject it, and, in our judgment, rightly, because it having been once introduced with the acquiescence and consent of the plaintiff, he could not afterward avail himself of the objection.

The plaintiff then proposed to ask a question of a witness, whether Daniel Stouffer was subject to fits of derangement, and whether the witness had said so ; but the court overruled the question. It does not appear distinctly in the record that Daniel Stouffer was a witness in the cause ; but if he was so, the question was properly overruled, because a person being subject to fits of derangement is no objection either to his competency or credibility, if he is sane at the time of giving his testimony.

The next objection of the plaintiff's counsel is to the charge of the court, in summing up the cause to the jury ; but the points on which that charge materially depends have been so fully discussed in the opinion just delivered in *Evans v. Eaton*, that it is unnecessary to examine them at large.

Upon the whole, it is the opinion of the majority of the court that the judgment ought to be

AFFIRMED WITH COSTS.

Patent in suit :

No. . Evans, O. December 18, 1790. Hopper-boy.

OTHER SUITS ON SAME PATENT :

Evans v. Chambers, 1807. 2 Wash. 125 ; 1 Robb. 7.

Evans v. Jordan, 1813. 1 Brock. 248 ; 1 Robb. 20.

Notes and Citations.

Evans *v.* Robinson, 1813. 1 Car. L. R. (N. C.) 209 ; 1 Brunn. Coll. Cases, 400.

Evans *v.* Weiss, 1813. 2 Wash. 342 ; 1 Robb. 10.

Evans *v.* Jordan, 1815. 9 Cranch, 199 ; 1 Robb. 57 ; 1 Whit. 3.

Evans *v.* Eaton, 1816. Pet. C. C. 322 ; 1 Robb. 68.

Evans *v.* Kremer, 1816. 1 Pet. C. C. 215 ; 1 Robb. 66.

Evans *v.* Eaton, 1818. 3 Wash. 443 ; 1 Robb. 193.

Evans *v.* Eaton, 1818. 3 Wheat. 454 ; 1 Robb. 243 ; 1 Whit. 8.

Evans *v.* Hettich, 1818. 3 Wash. 408 ; 1 Robb. 166.

Evans *v.* Eaton, 1822. 7 Wheat. 356 ; 1 Robb. 336 ; 1 Whit. 48.

Citations :**IN SUPREME COURT OF UNITED STATES :**

Hogg *v.* Emerson, 1847. 6 How. 457 ; Bk. 12, L. ed. 505.

IN CIRCUIT COURTS :

Whitney *v.* Emmett, April, 1831. 1 Bald. 303 ; 1 Robb. 567.

Blanchard *v.* Sprague, May, 1839. 3 Sumn. 535 ; 1 Robb. 734.

Blanchard *v.* Sprague, May, 1839. 2 Story, 164 ; 1 Robb. 742.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 73, 434, 435, 461.

Curt. on Pats., 4th ed., §§ 492, 494.

Walker on Pats., 1883, p. 371.

Opinion of the court.

Ex parte WOOD & BRUNDAGE.

9 Wheat. 608-615. Feb., 1824.

[Bk. 6, L. ed. 170 ; 1 Robb. 438 ; 1 Whit. 115.]

Record. Proceedings to repeal patent. Scire facias.

1. Where a special jurisdiction is given to a court, all the preliminary proceedings required to found that jurisdiction should appear of record, as they constitute an essential part of the case (p. 200).
2. Where a rule is the sole foundation of a suit, the record must not only show that it was granted, but it must appear by the proceedings that it was rightfully granted (p. 201).
3. Under Act 1793, § 10, proceedings to repeal a patent require a record of the preliminary proceedings under the rule to show cause and a process in the nature of a *scire facias* to issue to repeal the patent, if upon a future trial the same should be found invalid (p. 201).

THIS cause was argued by *Mr. Haines* * in support of the rule, and by *Mr. Emmett* † against it.

Mr. Justice STORY delivered the opinion of the court.

The district judge of the Southern District of New York, under the tenth section of the Patent Act of the 21st of February, 1793, ch. 11, granted a rule upon Charles Wood and Gilbert Brundage, at the instance and complaint of Jethro Wood, to show cause why process should not issue against them to repeal a patent granted to them for a certain invention in due form of law ; and, upon hearing the parties, no sufficient cause being, in his judgment, shown

* He cited *Stearns v. Barrett*, 1 Mason's Rep. 153 ; [*The King v. Dean of Trinity Chapel*] 8 Mod. 28 ; [*Groenwelt v. Burwell*] 1 Salk. 144.

† He cited 1 U. S. Law Journal, 88 ; *Ex parte* O'Reilly, 1 Ves. jun. 112 ; *Ex parte* Fox, 1 Ves. & Beames, 67 [1 Am. & Eng. 185] ; *Jefferson's Case*, 2 Saund. 15.

Opinion of the court.

to the contrary, he, on the 2d day of July, 1823, passed an order that the said rule be made absolute, and that the said patent be repealed, and that process issue to repeal the said patent, and for the costs of the complainant. The patentees, by their counsel, moved the court to direct a record to be made of the whole proceedings, and that process, in the nature of a *scire facias*, should be issued, to try the validity of the patent. The court denied the motion, upon the ground that these were summary proceedings, and that the patent was repealed *de facto* by making the rule absolute, and that the process to be issued was not in the nature of a *scire facias* to try the validity of the patent, but merely process repealing the patent.

A motion was made, on a former day of this term, in behalf of the patentees, for a rule upon the district judge to show cause why a mandamus should not issue from this court, directing him to make a record of the proceedings in the cause, and to issue a *scire facias* for the purpose of trying the validity of the patent. The rule having been granted, and due service had, the case has since been argued by counsel for and against the rule ; and the opinion of this court is now to be delivered.

Two objections have been urged at the bar against the making this rule absolute. The first is, that these proceedings, being summary, are not properly matters of record. The second, that this is not a case in which, by law, a *scire facias*, or process in the nature of a *scire facias*, can be awarded to try the validity of the patent.

Both of these objections are founded upon the provisions of the tenth section of the patent act, and must be decided by a careful examination of those provisions. The words are, "That upon oath or affirmation being made before the judge of the District Court where the patentee, his executors, &c., reside, that any patent which shall be issued in pursuance of this act was obtained surreptitiously, or upon false suggestion, and motion made to the said court within three years after issuing the said patent, but not afterward, it shall and may be lawful for the judge of the said District

Opinion of the court.

Court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee, or his executor, &c., show cause why process should not issue against him to repeal such patent; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute; and thereupon the judge shall order process to be issued against such patentee, or his executors, &c., *with costs of suit*. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of the said patent. And if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court and recovered in due course of law."

Upon the slightest inspection of this section, it will be at once perceived that, however summary the proceedings may be, they are of vast importance to the parties, and involve the whole right and interest of the patentee. The jurisdiction given to the court is not general and unlimited, but is confined to cases where the patent was obtained surreptitiously, or upon false suggestions, where the patentee resides within the district, and where the application is made within three years after the issuing of the patent. It is, therefore, certainly necessary that all these facts, which are indispensable to found the jurisdiction, should be stated in the motion and accompanying affidavits; and without them the court cannot be justified in awarding the rule. It follows, of course, that in any record that is to be made of the proceedings they constitute the preliminary part, and ought not be omitted. In the present case they have been wholly omitted, and the record is, in this respect, incomplete and inaccurate.

But it is said that, technically speaking, these proceedings are not matters of record. They are certainly proceedings of a court of record, for such are all the courts of the United States, in virtue of their organization, both upon principles of the common law and the express intendment

Opinion of the court.

of Congress. In general, the interlocutory proceedings in suits are not entered of record, as they are deemed merely collateral incidents. But where a special jurisdiction is given to a court, as in the present instance, it appears to us that, in conformity to the course of decisions in this court upon the subject of jurisdiction, all the preliminary proceedings required to found that jurisdiction should appear of record, as they constitute an essential part of the case. In general, motions and rules made in the course of suits over which the court has an acknowledged jurisdiction are not entered of record. But where a rule is the sole foundation of the suit, and the first step in its progress, that rule can only be granted under special circumstances prescribed by law. It is not sufficient to show that the rule itself was granted, but it must also appear by the proceedings that it was rightfully granted.

But the more material question is, whether the proceedings, so far as the rights of the patentees are concerned, terminated with the rule being made absolute, so that *ipso facto* the patent was repealed, and the process to be issued was only process to enforce or declare the repeal; or whether the process was in the nature of a *scire facias* at common law to repeal the patent, if, upon a future trial, the same should be found invalid.

This question must be decided by the terms of the section in controversy; but, in the interpretation of those terms, if their meaning is somewhat equivocal, that construction ought certainly to be adopted which, not departing from the sense, is most congenial to our institutions, and is most convenient in the administration of public justice. The securing to inventors of an exclusive right to their inventions was deemed of so much importance, as a means of promoting the progress of science and the useful arts, that the Constitution has expressly delegated to Congress the power to secure such rights to them for a limited period. The inventor has, during this period, a property in his inventions—a property which is often of very great value, and of which the law intended to give him the absolute

Opinion of the court.

enjoyment and possession. In suits at common law, where the value in controversy exceeds twenty dollars, the Constitution has secured to the citizens a trial by jury. In cases of equity and admiralty jurisdiction, they have the security of a regular and settled course of proceedings, where the rules of evidence and the principles of decision are well established. And in all these cases, there is the farther benefit, conferred by our laws, of revising the judgments of the inferior courts by the exercise of appellate jurisdiction. It is not lightly to be presumed, therefore, that Congress, in a class of cases placed peculiarly within its patronage and protection, involving some of the dearest and most valuable rights which society acknowledges and the Constitution itself means to favor, would institute a new and summary process, which should finally adjudge upon those rights without a trial by jury, without a right of appeal, and without any of those guards with which, in equity suits, it has fenced round the general administration of justice. The Patent Acts have given to the patentee a right to sue at common law for damages for any violation of his invention, and have given him a farther right to claim the interference of a court of equity, by way of injunction, to protect the enjoyment of his patent. It would be somewhat surprising if, after such anxious legislation, there should exist in the act a clause which, in a summary manner, enables any person to repeal his patent, and thus sweep away his exclusive property, without interposing any guards by way of appeal, or any regular proceedings by which the validity of titles, in ordinary cases, is examined and contested.

With these considerations in view, let the tenth section of the act be examined. Its object is to provide some means to repeal patents which have been obtained surreptitiously, or upon false suggestions—the very cases for which a *scire facias* issues at the common law. As the patents are not enrolled in the records of any court, but among the rolls of the Department of State, it was necessary to give some directions as to the correct time and manner of instituting

Opinion of the court.

proceedings to repeal them. It accordingly directs that the district judge may, upon proper evidence, under oath and motion made to the court, in his discretion, "grant a rule that the patentee, &c., show cause why process should not issue against him to repeal such patent; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the judge shall order process to be issued against such patentee, &c., with costs of suit." It is obvious, from the language of this clause, that the rule is a rule not to repeal the patent, if it is made absolute, but a rule for process to issue to repeal the patent. It is not, then, the rule, but the process contemplated by the act, that repeals the patent. It is not a mere form, but it is of the essence of the proceedings, without which the rule has no efficacy. Is the process to be issued a process which *per se* repeals the patent, or are the words "to repeal such patent" to be construed as merely descriptive of the nature of the process, and of the effect of it, if judgment shall be finally pronounced in support of it? In other words, is it a process in the nature of an execution, or a judicial process in the nature of a *scire facias*, calling for further proceedings? If the words of the section had stopped at the clause already referred to, it would, perhaps, have been difficult to find a sufficient explanation of the legislative will to have led the court to the conclusion that judicial process, in the nature of a *scire facias*, was certainly intended; there would have been some reason for hesitation; but even then an interpretation against such process would not have been without serious embarrassments. It could not be arrived at without leaving much of questionable reasoning behind. But the section does not stop here. It goes on to make further provisions, which, if the process absolutely repealed the patent, could have no operation and no intelligible meaning. On the other hand, if the process was to be in the nature of a *scire facias*, all the words are sensible and operative, and describe the proper progress and proceedings upon such a writ. The clause is in these words: "And in case no sufficient cause shall be shown to

Opinion of the court.

the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of the patent." These words follow after the clause awarding the process, and, of course, suppose the process already issued. The party is supposed to be called upon to show cause, which is precisely what a *scire facias* requires in its official mandate ; and if no sufficient cause is shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, then the patent is to be repealed. If the process is merely to repeal the patent, and not to institute a trial, how can the party show cause ?—how can it judicially appear that the patentee is not the inventor ? These provisions are intelligible in a *scire facias*, for that authorizes subsequent inquiry into the law and the facts. But, farther, "judgment" is to be rendered. Now, it is not necessary to lay any particular stress on this word, as a known juridical phrase, expressive of the final decision of the court ; but if the making the rule absolute repealed the patent, and the process is merely an execution, how could any subsequent judgment be rendered in the case ? It would be contrary to all analogy, to all rules of judicial interpretation, to suppose that judgment is to succeed, and not to precede, the writ of execution. The clause goes on : " And if the party at whose complaint the process issued shall have judgment against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court and recovered in due course of law." The language is here still more distinct and persuasive. It imports, in a clear manner, that some proceedings were to be had after the process issued, by which the case might be farther investigated ; and if, upon such investigation, judgment should be against the complainant, the patentee should recover his costs. The language is, that the party at whose complaint the *process issued*, not the rule issued, shall have judgment against him. Upon what ?—the rule ? Certainly not ; but upon the *process issued*. He shall pay the

Opinion of the court.

costs to which the defendant is put in defending the suit. What suit is here intended? We think it is clear that it means the suit upon the process, that is, upon the *scire facias*; for the proceedings upon the rule are not, in a technical or in any accurate sense, a suit. The costs of *defending* the suit are to be paid. But how can any costs arise from a defence upon a process which is final and absolute? It appears to the court, that to give the construction contended for by the counsel against the rule would be to reject the plain and obvious purport of the whole of the last clauses of the section, and make them a perfect nullity. In the other view, they have the entire effect, and are as reasonable and just in themselves as they are promotive of the security of vested rights and property.

Nor does the occurrence of the words "costs of suit," in the preceding part of the section, where it is said that "the process shall be issued, &c., with costs of suit," in the slightest degree impugn this interpretation. The true meaning of these words, in this connection, is not that costs of suit already incurred shall be paid and collected, but that the process shall be to show cause why the patent shall not be repealed, and costs of suit given to the complainant. In this view, it fortifies the construction already asserted by the court. That this is the true exposition of the words, is made apparent by examining the fifth section of the Patent Act of 1790, ch. 34, which is exactly similar in terms to the tenth section of the present act, except that it omits, in this place, the words "costs of suit." These words, therefore, were not intended to change, and cannot be admitted to change, the natural meaning of other parts of the section. And if the other words used in this connection are descriptive of the nature of the process, these words are merely explanatory of the legislative intent, that the costs of the suit should follow upon the final judgment in favor of the complainant. Without this provision, as the other clause giving costs applies to the patentee only, the complainant, although he should prevail in the suit, would

Opinion of the court.

not be entitled to any costs. This was a real defect in the first act, and is cured by the insertion of the words under consideration.

Nor are there any public mischiefs which will result from the view which the court takes of this section. On the contrary, it will subserve the purposes of general justice. If a patent has been fraudulently obtained, or upon false suggestions, it may be repealed within three years, if a jury upon a trial shall be satisfied of the fact. If such a repeal be not had, still the public have a perfect security. They may violate the patent with impunity, and, if sued for the violation, any person may show the same facts in his defence, and they will constitute a complete bar to the suit, by the express provisions of the sixth section of the Patent Act. Here, also, the trial will be ordinarily by a jury, and if the verdict is found upon such facts in favor of the defendant, the law expressly declares that "judgment shall be rendered for the defendant, with costs, and the patent shall be declared void." Many patents under this section have already, in such suits, been adjudged void; so that the danger of extensive imposition or injury is wholly chimerical. On the other hand, if, by any accident or mistake, the patentee should neglect to appear to oppose the rule, upon the argument on the other side, he may be remediless. But, upon the exposition of the statute adopted by the court, he will still be entitled to appear to the *scire facias*, and have a more deliberate opportunity to defend his right.

Upon the whole, it is the opinion of the court that the rule ought to be made absolute, and that a peremptory mandamus issue to the judge of the District Court, directing him to enter upon record the proceedings in this cause antecedent to the granting of the rule, and upon which it was founded; that he award a process, in the nature of a *scire facias*, to the patentees, to show cause why the patent should not be repealed, with costs of suit; that upon such process being returned, duly executed, he proceed to try the same cause, upon the pleadings filed by the parties

Notes and Citations.

and the issue joined thereon ; and that if the issue so joined be an issue of fact, then the trial thereof to be by a jury ; if an issue of law, then by the court, as in other cases.

MANDAMUS ACCORDINGLY.

JUDGMENT. Upon the hearing of this cause, upon the rule to show cause heretofore awarded by this court, and on consideration of the arguments of counsel for and against making the same rule absolute, it is ordered and adjudged by the court that the same rule be, and hereby is, made absolute. And it is further ordered by the court that a peremptory mandamus issue to the district judge of the Southern District of New York, commanding him to enter upon record the proceedings in this cause, antecedent to the granting by him of the rule to show cause why process should not issue to repeal the patent in the proceedings mentioned, and upon which the said rule was founded ; that the said judge do award a process in the nature of a *scire facias* to the patentees, to show cause why the said patent should not be repealed, with costs of suit ; that upon the return of such process, as duly served, the said judge do proceed to try the cause, upon the pleadings filed by the parties and the issue joined thereon ; and that if the issue be an issue of fact, the trial thereof be by a jury ; if an issue of law, then by the court, as in other cases.

Note :

3. Act 1790, § 5 ; Act 1793, § 10 ; Act 1836, § 16 ; Act 1870, § 58 ; R. S., § 4918.

See *Bourne v. Goodyear*, 9 Wall. 811.

Mowry v. Whitney, 14 Wall. 434.

Patent in suit :

No. . Wood & Brundage. November 9, 1820. Plough.

Notes and Citations.

Citations:

IN CIRCUIT COURTS :

Delano v. Scott, 1834. Gilp. 489 ; 1 Robb. 700.

Opinion of the court.

KEPLINGER v. DE YOUNG.

10 Wheat. 358-367. Feb., 1825.

[Bk. 6, L. ed. 841 ; 1 Robb. 458 ; 1 Whit. 122.]

Contract. Infringement.

1. A contract with a party to purchase all the articles made by him upon an infringing machine does not render the purchaser an infringer, unless the contract was colorable only (Act 1800, § 3) (p. 209).

ERROR to the Circuit Court of Maryland.

This cause was argued by *Mr. Webster* and *Mr. Sergeant* for the plaintiff, and by the *Attorney-General* for the defendant.

Mr. Justice WASHINGTON delivered the opinion of the court.

This was a suit commenced by the plaintiff, Keplinger, in the Fourth Circuit for the District of Maryland, against the defendant, for the violation of the plaintiff's patent-right, secured to him according to law, in a certain new and useful improvement, to wit, a machine for making watch-chains, &c. The third count in the declaration, upon which alone this cause has been argued, is in the usual form, charging the defendant with having unlawfully used the said improvement, without the consent of the plaintiff first had and obtained in writing. The defendant pleaded the general issue, and gave notice to the plaintiff that he should deny that the exclusive right of using the improvement mentioned in the declaration was vested in the plaintiff, or that he was the original and first inventor of the said improvement, and that he should give evidence to establish those facts.

Opinion of the court.

At the trial, the plaintiff read in evidence the letters patent, duly granted, bearing date the 4th of May, 1820, and proved that he was the true and original inventor of the machine specified in the patent, and that the defendant, together with John Hatch and John C. Kirkner, did use the said machine in the making of watch-chains from steel, from the 4th of May till some time in the month of December, 1820.

The defendant, in order to prove that any concern or connection which he had with the said Hatch & Kirkner, in the making of watch-chains by means of the said machine, was merely as a purchaser of watch-chains from them under the following contract, produced and gave the same in evidence. The agreement referred to, bearing date the 3d of May, 1820, is between M. De Young, and J. Hatch, and J. Kirkner, and witnesses: "That the said Hatch & Kirkner do hereby engage and obligate themselves to manufacture and deliver to M. De Young, or at his store in said city, not less than three gross, but as many as five gross, of wire watch-chains, agreeably to a sample to be deposited with T. Barly, (if practicable to manufacture so many,) in each week, from the date hereof, for the term of six months, one half of which number to be with turned slides, and the other half wire slides; the whole number to be four strands, if the said De Young so choose; but he is to have the privilege of directing the description to be furnished, that is to say, what number of four, five, six, or eight strands,—the prices of which to be as follows: four strands, two dollars per dozen; six strands, two dollars sixty-six cents and two thirds per dozen, and eight strands at the rate of three dollars thirty-three cents per dozen; said Hatch & Kirkner to devote their whole time and attention to said manufacture, and neither to sell, barter, nor dispose of, in any manner, or way, or means whatever, of any goods of the description hereinbefore described, or which may, in any manner or way whatsoever, interfere with the exclusive privilege hereinbefore granted, but will faithfully manufacture for said De Young, and none other, as far as five gross

Opinion of the court.

of chains per week, if practicable, and not less than three gross per week, at the prices hereinbefore stipulated, and payable as follows : one half in cash at the end of every week, for the total number delivered within the week, and the other half in said De Young's promissory note, payable at sixty days from the date thereof. And the said De Young, on his part, doth hereby promise to receive from the said Hatch & Kirkner such quantity of watch-chains, answering the description of the sample, as it may be in their power to manufacture, not exceeding five gross per week, reserving to himself the privilege of directing what proportion thereof shall be four, six, or eight strands, and pay for the same weekly in the following manner, namely : the one half amount of the week's delivery in cash, the other half in a note at sixty days, the same to be settled for weekly, in manner aforesaid, if required."

The defendant also gave evidence to prove that all the connection he ever had with the said Hatch & Kirkner, relative to watch-chains made by them, with the said machine or otherwise, was merely as a purchaser of such chains from them, under and in pursuance of the said contract.

The plaintiff then proved that, at the time of making the said contract, the defendant was fully apprised of the existence of the machine described and specified in the patent, and of its prior and original invention by the plaintiff, and of the intention of the plaintiff to obtain the said patent ; and that the said contract was made with a view to the employment by the said Hatch & Kirkner, in the manufacture of watch-chains, of a machine precisely similar to that invented by the plaintiff, after the plaintiff should have obtained his patent ; and that a machine precisely similar to that invented by the plaintiff was employed by the said Hatch & Kirkner, in the manufacture of watch-chains by them under the said contract, and with the knowledge and consent of the defendant during the whole period aforesaid, he and they having received notice, on the 5th of May, 1820, of the plaintiff's patent ; and that the watch-chains

Opinion of the court.

so manufactured by Hatch & Kirkner, during the whole of the said period, were delivered by them to the defendant, and by him received, under and in conformity with the said contract.

Upon this evidence, the court, at the request of the defendant's counsel, instructed the jury that the plaintiff was not entitled to a verdict on the first and second counts in his declaration, because the acts which they charge, if true, constitute no offence against the plaintiff's patent; and that, if the jury should be of opinion, on the evidence, that the plaintiff is the sole and original inventor of the whole machine; and that the defendant had no other connection with Hatch & Kirkner, with regard to these chains, than that which arose from his said contract with them, under which he procured the chains to be made by Hatch & Kirkner, and sold them when so made; and that the said contract is a real contract,—then these acts constituted no breach of the plaintiff's patent-right on the part of De Young, and that the verdict must be for the defendant; and that this legal aspect would not be changed, although the defendant may, on any occasion, have supplied, at the cost of Hatch & Kirkner, the wire from which the chains so manufactured were made.

To this instruction, the plaintiff's counsel took a bill of exceptions, and a verdict and judgment having been rendered for the defendant, the cause was brought into this court by a writ of error.

The only question which is presented by the bill of exceptions to the consideration of this court is, whether the court below erred in the instruction given to the jury; and this must depend upon the correct construction of the third section of the act of Congress, of the 17th April, 1800, ch. 179, which enacts: "That where any patent shall be granted pursuant to the act of the 21st of February, 1793, ch. 156, and any person, without the consent of the patentee, his executors, &c., first obtained in writing, shall make, devise, use, or sell the thing whereof the exclusive right is secured to the said patentee, by such patent, such person so offending

Opinion of the court.

shall profit and pay to the said patentee a sum equal to three times the actual damage sustained by such patentee," &c.

The contract, taken in connection with the whole of the evidence stated in the bill of exceptions, if the same were believed by the jury, formed most certainly a strong case against the defendant, sufficient to have warranted the jury in inferring, either that the machine which was to be employed in the manufacture of the watch-chains was owned in the whole or in part by the defendant, or that it was hired to the defendant for six months, under the color of a sale of the articles which might be manufactured with it, and with intent to invade the plaintiff's patent-right. Whether the contract, taken in connection with the whole of the evidence, does or does not amount to a hiring by the defendant of the machine, or the use of it for six months, is a point which is not to be considered as being decided either way by the court. The bill of exceptions does not call for an opinion upon it.

But the contract, taken by itself, amounted to no more than an agreement by the defendant to purchase, at a fixed price, all the watch-chains, not exceeding five gross a week, which Hatch & Kirkner might be able to manufacture in the course of six months, with any machine they might choose to employ ; and an agreement on the part of Hatch & Kirkner, to devote their whole time and attention to the manufacture of the chains, and not to sell or dispose of any of them so as to interfere with the exclusive privilege secured to the defendant, of purchasing the whole quantity which it might be practicable for them to make.

If this contract was real, and not colorable, which is the obvious meaning of the instruction, and the defendant had no other connection with Hatch & Kirkner in regard to these chains than what grew out of it, it would, in the opinion of the court, be an extravagant construction of the Patent Law, to pronounce that it amounted to a breach of the plaintiff's patent-right, by fixing upon the defendant the charge of having *used* the plaintiff's machine. Such a construction would be highly inconvenient and unjust to

Opinion of the court.

the rest of the community, since it might subject any man, who might innocently contract with a manufacturer to purchase all the articles which he might be able to make within a limited period, to the heavy penalty inflicted by the act, although he might have been ignorant of the plaintiff's patent, or that a violation of it would be the necessary consequence of the contract. It might possibly extend farther, and affect contracts express or implied, though of a more limited character, but equally innocent, as to which, however, it is not the intention of the court to express any opinion, as this case does not call for it.

This cause was argued, by the plaintiff's counsel, as if the opinion of the court below had been given upon the whole of the evidence. But this was not the case. No instruction was asked for but by the defendant's counsel, and that was confined to a single part of the case: the connection between the defendant and Hatch & Kirkner in regard to the watch-chains which the latter bound themselves, by their contract, to manufacture and deliver to the former. If the jury had been of opinion, upon the whole of the evidence, that the contract was not a real one, or that that instrument did not constitute the sole connection between those parties, or that the transaction was merely colorable, with a view to evade the law, the jury were not precluded by the instruction from considering the plaintiff's patent-right as violated, and finding a verdict accordingly.

Had the plaintiff's counsel thought proper to call upon the court for an opinion and instruction to the jury, upon any points arising out of the whole or any part of the evidence, it would have been their duty to give an opinion upon such points, leaving the conclusion of fact from the evidence to be drawn by the jury. But this course not having been pursued, this court can take no notice of the evidence, although spread upon the record, except so far as it is connected with the single point upon which the opinion which is excepted to was given. As to the residue of that opinion, that "the legal aspect of the case would not be changed, although the defendant might, on any occasion,

Notes and Citations.

have supplied, at the cost of Hatch & Kirkner, the wire from which the chains so manufactured were made," it is quite as free from the objection as the preceding part of it, since it stands upon precisely the same principle.

JUDGMENT AFFIRMED WITH COSTS.

Note:

1. Act 1790, § 4 ; Act 1793, § 5 ; Act 1800, § 3 ; Act 1836, § 14 ;
 Act 1870, § 59 ; R. S., § 4919.
 See *Simpson v. Wilson*, 4 How. 709 [p. 533 *post*].

Patent in suit :

No. . Keplinger, S. May 4, 1820. Watch-chain
 machine.

Citations :

IN SUPREME COURT OF UNITED STATES :

Hogg v. Emerson, 1850. 11 How. 587 ; Bk. 13, L. ed. 824.

IN CIRCUIT COURTS :

Boyd v. M'Alpin, July, 1844. 3 McLean, 427 ; 2 Robb. 277.

Byam v. Bullard, May, 1852 ; 1 Curt. 100.

Putnam v. Sudhoff, April, 1874. 1 Ban. & Ard. 198.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, p. 268.

Curt. on Pats., 4th ed., § 292.

Walker on Pats., 1883, p. 295.

Syllabus.

ABRAHAM L. PENNOCK AND JAMES SELLERS
v. ADAM DIALOGUE.

2 Pet. 1-24. Jan., 1829.

[Bk. 7, L. ed. 827; 1 Robb. 542; 1 Whit. 127.]

Affirming *Ibid.*, 4 Wash. 588.

Evidence. Exceptions. Record. Abandonment. Use prior to application.

1. Evidence to which no exception is taken should not be made a part of the record, and will not be considered by the court (p. 230).
2. It is no ground of reversal that the court below omitted to give directions to the jury upon any point of law which might arise in the cause, where it was not requested by either party at the trial (p. 230).
3. Abandonment of an invention is absolute, and cannot afterward be resumed, and is generally a question of fact (p. 231).
4. The constitutional provision relating to patents contemplates that the term of the patent shall be subject to the discretion of Congress (p. 231).
5. Act 1793, ch. 11, §§ 1, 3 and 6, "abandonment," reviewed and construed (p. 232).
6. Act 1793, § 1, words "not known or used before the application" mean not known or used by the public before the application (p. 233).
7. 21 Jac., ch. 3, Statute of Monopolies examined on the question of abandonment (p. 235).
8. Act 1790, § 1, examined on the question of abandonment (p. 236).
9. Act 1800, § 1, examined (p. 237).
10. Under Act 1793 the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent (p. 239).

Statement of the case.

[Citations in the opinion of the Court :]

(1) 3 Coke's Inst. 184, p. 235.

(2) Wood v. Zimmer, 1 Holt's N. P. Rep 58 [1 Am. & Eng. 202], p. 235.

THIS case was brought before the court on a writ of error to the Circuit Court for the Eastern District of Pennsylvania.

In that court, the plaintiffs in error had instituted their suit against the defendants, for an infringement of a patent-right, for "an improvement in the art of making tubes or hose for conveying air, water, and other fluids." The invention claimed by the patentees was in the mode of making the hose, so that the parts so joined together would be tight, and as capable of resisting the pressure as any other part of the machine.

The bill of exceptions which came up with the record contained the whole evidence given in the trial of the cause in the Circuit Court. The invention for which the patent-right was claimed was completed in 1811, and the letters patent were obtained in 1818. In this interval, upward of *thirteen thousand feet of hose*, constructed according to the invention of the patentees, had been made and sold in the city of Philadelphia. One Samuel Jenkins, by the permission of, and under an agreement between the plaintiffs as to the price, had made and sold the hose invented by the plaintiffs, and supplied several hose companies in the city of Philadelphia with the same. Jenkins, during much of the time, was in the service of the plaintiffs, and had been instructed by them in the art of making the hose. There was no positive evidence that the agreement between Jenkins and the plaintiffs in error was known to or concealed from the public. The plaintiffs, on the trial, did not allege or offer evidence to prove that they had delayed making application for a patent for the purpose of improving their invention, or that from 1811 to 1818 any important modifications or alterations had been made in their riveted hose. The plaintiffs claimed before the jury that all the hose which had been made and sold to the public prior to their patent had been constructed and vended by Jenkins under their permission.

Argument of counsel.

Upon the whole evidence in the case, the Circuit Court charged the jury :

“ We are clearly of opinion that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention to which a patent would have entitled him had it been applied for before such use. And we think it makes no difference in the principle, that the article so publicly used, and afterward patented, was made by a particular individual, who did so by the private permission of the inventor. As long as an inventor keeps to himself the subject of his discovery, the public cannot be injured ; and even if it be made public, but accompanied by an assertion of the inventor's claim to the discovery, those who should make or use the subject of the invention would at least be put upon their guard. But if the public, with the knowledge and the tacit consent of the inventor, is permitted to use the invention without opposition, it is a fraud upon the public afterward to take out a patent. It is possible that the inventor may not have intended to give the benefit of his discovery to the public, and may have supposed that by giving permission to a particular individual to construct for others the thing patented, he could not be presumed to have done so. But it is not a question of intention which is involved in the principle which we have laid down, but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say whether the evidence brings this case within the principle which has been stated. If it does, the court is of opinion that the plaintiffs are not entitled to a verdict.”

To this charge the plaintiffs excepted, and the jury gave a verdict for the defendant.

Mr. Webster, for plaintiff in error, contended :

1. That the invention being of such a nature that the use of it, for the purpose of trying its utility and bringing it to

Argument of counsel.

perfection, must necessarily be open and public, the implication of a waiver or abandonment of the right, furnished by such public use, is rebutted by the circumstance that the article was made and sold only by one individual, and that individual was authorized and permitted so to do by the inventors.

2. That the use of an invention, however public, if it be by the permission and under the continual exclusive claim of the inventor, does not take away his right, except after an unreasonable lapse of time, or gross negligence in applying for a patent.

3. That the jury should have been instructed, that if they found the riveted hose which was in use by the hose companies had been all made and sold by Jenkins, and by no one else, prior to the grant of the patent, and that he was permitted by the inventors under their agreement so to make and sell the same, that such use of the invention, not being adverse to their claim, did not take away their exclusive right, nor imply an abandonment of it to the public.

4. That if they found the hose had not been made or sold, prior to the grant of the patent, by any person but Jenkins, then the giving of permission to him, being in itself an assertion of claim, was not a dedication to the public ; and that the public, by purchasing and using the hose thus made by the permission of the inventors, acquired no title to the invention ; but, on the contrary, if the price paid included a premium for the invention, the public by so purchasing admitted the right of the inventors.

5. That, at any rate, there being no use *by the public* of this invention, it should have been left to the jury to say whether, under all the circumstances, considering the nature of the invention and the time necessary to perfect it, the plaintiffs have been guilty of negligence in not sooner applying for a patent.

Mr. Webster stated that the question to be decided by the court laid within a narrow compass. The defence set up was that the plaintiffs had suffered their invention to be

Argument of counsel.

used before their application for a patent, and had thus lost all right to the exclusive use of it.

The court, in this case, would be called upon to reverse the English decision relative to abandonments ; for it was admitted that those cases had gone to the whole extent of the principles applied to this case in the Circuit Court. Those cases have decided that any public use of an invention, even for experiment, renders it no longer a new machine. In the courts of the United States a more just view had been taken of the rights of inventors. The laws of the United States were intended to protect those rights, and to confer benefits ; while the provisions in the statute of England, under which patents are issued, are exceptions to the law prohibiting monopolies. Hence, the construction of the British statute had been exceedingly strait and narrow, and different from the more liberal interpretation of our laws.

By the decisions of our courts, there must be a *voluntary abandonment* or *negligence*, or *unreasonable* delay in obtaining letters patent, to destroy the right of the patentee. *Goodyear v. Mathews*, Paine's Rep. 300 ; *Morris v. Huntington*, *ibid.* 348.

The exception to the charge of the court is, that the jury should have been instructed to decide, upon the evidence, whether the plaintiff meant to abandon his invention by the permission to Jenkins to use it. Jenkins must be considered as the private agent of the inventors, and their agreement with him, under which he made the hose, is to be considered rather as an assertion of their exclusive right to the invention than a surrender of it. By omitting to leave to the jury this question of an intention to abandon, the case was erroneously withdrawn from them. The rights of the parties also entitled them to have the causes of their delay in patenting their invention inquired of by the jury. As the case is presented on the bill of exceptions, the court in their charge undertook to state the whole law of the subject-matter to the jury, and the omission to instruct them on any one point is error.

Argument of counsel.

If, in this charge of the court, anything is omitted which was matter of law for the jury, it is misdirection.

In a case in Massachusetts, said to be reported in 4 Mason's Rep., it was left to the jury to decide whether seventeen years' delay could be accounted for.

Under the provisions of the laws of the United States, the right is created by the *invention*, and not by the *patent*. The court, therefore, may have misled the jury, in stating that the plaintiffs allowed the invention to be used. The *thing invented* was only permitted to be used.

The suggestion that, by adopting the language of the English statute, the cases decided in England upon that statute are adopted, may be answered by a reference to those cases. They have all arisen within a few years since the enactment of our law ; and, except the dictum of Lord COKE in 2 Institute, the authorities are all of modern date.

If this court shall be of opinion that, as no instructions were particularly asked upon the questions raised here, the court below were not bound to notice them in the charge, and that the court did not undertake to decide the whole law, the plaintiff in error can make out no case here. But if this court shall consider the questions now submitted doubtful, as the rights of the plaintiffs may not have been fully investigated, by sending the case back to the Circuit Court a more full investigation of all the points involved in it may be made.

Mr. Sargeant, for the defendant, insisted :

1. That mere invention gives no right to an exclusive use, unless a patent is obtained ; and that if, at a time when no right is infringed, the public fairly acquire possession of it, the inventor cannot, by subsequently obtaining a patent, take it away.

2. That the inventor, by abstaining from getting a patent, encouraged the public to use the article freely, and thus benefited his own manufactory. And he is not at liberty, when this advantage is exhausted, to turn round and

Argument of counsel.

endeavor to reach another and a different kind of advantage, by appropriating the use exclusively to himself.

In the circuit where this cause was tried, it was not the practice to ask the court for special instructions to the jury. After the evidence had been closed and counsel heard, a charge was given to the jury, according to the nature of the case, upon the points made by counsel, or which might suggest themselves to the mind of the judge. It was competent, however, to either party, after the charge, to ask the opinion of the court upon any point supposed to have been omitted which was material to the decision. In this case, no such request had been made ; and no objection can now be made to the charge for any imputed omission. The only question was, whether the principles laid down to the jury for their guidance were correct, and according to law, in the particular excepted to.

The charge must of course be considered with reference to the facts, the whole of which appear upon the record. The petition of the plaintiffs to the Secretary of State stated, in the words of the Patent Law, that they were the inventors of a "new and useful improvement," "not *known* or *used* before their application." The "application" was made in July, 1818. Their averment, therefore, upon which they obtained their patent, was, that the rivet hose was a new invention, not "known or used" before the year 1818. The facts proved upon the trial were that the invention had been completed and published in the year 1811, seven years before the application ; that during that period it had been known and used as common public property, (and not as private property,) which any one might use as publicly known ; and that it was so known and used with the knowledge of those who now claim to be the inventors, without any assertion or claim on their part of exclusive property, and without notice of intention to make such claim. There was not a single circumstance offered to explain the delay.

There was an attempt to show that the making of the article for use was limited by the authority and permission of the plaintiffs, and thence to infer that they did not in-

Argument of counsel.

tered to give it to the public. A witness produced by them, and the only person who appeared to have made the article, declared, in substance, "that he was taught by the plaintiffs in 1811 to make hose; that in *that* year he made a certain quantity of it for the Philadelphia Hose Company, plaintiffs being members of the committee; and that by permission of the plaintiffs he made about thirteen thousand feet of hose, for different hose companies, from 1811 to the time of granting the patent."

Thus, in point of fact, nearly two miles and a half in length of hose had been made at different times in the course of seven years, before the patent, and had been sold to different hose companies, not to experiment with, in order to bring the invention to perfection, but for public use, as a thing already completed and adapted to the purpose of arresting the ravages of fire. It was so used; and from the year 1811 to the year 1818 it was never materially altered or improved. The thing patented in 1818 was precisely the thing invented, completed, and used in 1811.

Were the plaintiffs, under these circumstances, entitled to a patent? Or could a patent thus obtained be supported? The authorities upon the subject are decisive. He did not admit that the weight of judicial or legal opinion in England was lessened by the supposed difference in the policy of the two countries, or that in fact any such difference existed. It was true that the process or mode of legislation was varied according to the existing state of things. The statute of James was made to abolish monopolies; but it saved, by exception, the rights of the inventors of new and useful inventions who had before enjoyed exclusive privileges. The Constitution of the United States and the act of Congress, on the contrary, having no monopolies to deal with, created exclusive privileges in favor of the same description of persons. The one preserved to them a pre-existing monopoly, and the other conferred it upon them. Both were influenced by the merits of the inventor and the public advantage of encouraging inventive genius. And they were equally influenced by these considerations; for

Argument of counsel.

it required at least as strong a sense of their just claims to distinction, to except new and useful inventions from the statutory odium and denunciation of monopolies, as it did to confer upon them the benefits of monopoly by direct enactment. There was no reason, therefore, why the judicial construction of the statute of James, (from which our act of Congress was in this respect copied,) which had become, as it were, incorporated with and part of the statute, should not be as much respected as in the instance of any other statute. The adoption of the language of the statute was the adoption also of its settled interpretation. It could not surely be insisted that England was wanting in intelligence to discern the value of genius, or in liberality to reward it; or that there was a prevailing bias in her judiciary toward an unjust restriction of the rights of meritorious inventors. The sentiment of the nation and the government, in all its branches, was the opposite of this.

Before referring to the cases, it might be well, however, to examine the matter a little upon principle. What is the right of an inventor? It is the right, *given to him by the law*, to apply for and obtain a patent for his invention. The patent, when duly obtained, secures to him the exclusive enjoyment. Has he any other right, before he obtains a patent, than the one just stated? It is obvious that he has not. This, then, is what the learned judge in his charge styles, with peculiar aptness, an inchoate right; that is, a right to have a title upon complying with the terms and conditions of the law. It is like an inchoate right to land, or an inceptive right to land, well known in some of the States, and everywhere accompanied with the condition that, to be made available, it must be prosecuted with due diligence to the consummation or completion of the title. If the condition be not complied with, the right is abandoned or lost, and the rights of others are let in. The abandonment is not a question of intention of the party, but it is the legal construction of his acts or omissions.

Had the plaintiffs ever such an inchoate right? According to the opinion of the judge, they undoubtedly had such a

Argument of counsel.

right by their invention in 1811. *Then*, they could have made out the case required by the first section of the act of Congress—they could have stated with truth that the thing invented “was not known or used before their application.” But in the year 1818 it was no longer true. It might be stated, but it could not be truly stated. They were unable to comply with the condition of law. For if the inventor, as was the case here, voluntarily permit his invention to be known and used as a thing not intended to be patented, how can he make this statement? By so doing, he abandons his inchoate right; he proclaims to the world that he does not mean to secure it by patent, and every one is at liberty to consider it abandoned, because every one acquainted with the law knows that he has incurred a disability. This is the inevitable legal construction of his conduct, and is altogether independent of his intention, unless we suppose the act to be guilty of the absurdity of requiring that to be stated which it does not require to be true.

But the terms of the act are in this respect too plain to admit of a doubt. Suppose an applicant should state that his invention had been known and used for seven years before his application, could he obtain a patent? Suppose he should state that he had always intended to reserve to himself a right to obtain a patent, would that help him? Or, if he should state that it had been so known and used only by his permission? The language of the act is plain and imperative. There is no scope for interpretation. The prescribed condition is express. And there is no doubt that it was the intention of Congress to refer to the “application,” as the period before which the thing was not known or used; for in the subsequent act of 17th April, 1800, conferring the privileges of the Patent Law upon resident aliens, the same word is used for the same purpose. And it is declared that the patent shall be void if the thing patented was *known or used before the application*. Act of 17th April, 1800, section 1.

It is not contended, that if the invention should be pirated, the use or knowledge obtained by the piracy, or other-

Argument of counsel.

wise obtained without the knowledge or consent and without the fault of the inventor, would bar him from getting a patent. Nor is it contended that his own knowledge and use would be a bar. The latter is a necessary exception out of the generality of the terms of the law, because every inventor must know his invention, and must use it to the extent of ascertaining its usefulness, before he applies for a patent. The former is a case where there is no fault on the part of the inventor. But it is contended that the inventor who means to rely upon a patent must make his application within a reasonable time, and that if he permit his invention to be publicly known and used before he applies, he cannot obtain a patent. He abandons his right if he sell it for public use himself, and, *a fortiori*, if he permit another so to sell it.

There is a cautious intimation in the charge, that possibly there might be some saving efficacy in accompanying the use with an assertion of claim by the inventor. And it is also put as a circumstance against the plaintiffs (which was clearly in evidence) that there was no such assertion or notice. The charge is therefore applicable only to a case of unqualified public use, without notice or assertion of claim. That such a notice would be available, or that there can be any other assertion of claim than the legal assertion by applying for a patent, are propositions which it is not now necessary to examine. They were not affirmatively laid down by the court, nor otherwise adverted to than for the purpose of showing that the facts did not entitle the plaintiffs to the benefit of them. They cannot, therefore, complain. Whether such assertions or notice, contradicted by the acts of the inventor, will be available, is a question not decided below. Certain it is, that a secret permission, given to their own agent, can no more be an assertion or notice than a resolution locked up in their own breasts.

The construction contended for is in accordance with the policy of the law. Patents are intended to be granted for a limited time, beginning with the invention. He who asks for one must describe his invention with such certainty as

Argument of counsel.

will insure to the public its use when the patent expires ; and at the expiration of the time the thing invented is public property. The inventor, to enjoy its benefits, must place his whole reliance upon it. Is it competent for him, then, to secure to himself the advantages of his own peculiar knowledge and skill as long as these will avail him, and when they are exhausted to apply for a patent ? There are many inventions the secret of which is not at once discoverable from an inspection of the thing invented. The inventor may keep that as long as he can. He may have extraordinary skill or methods of working which will enable him to keep the market to himself. May he enjoy these exclusive privileges for seven years, and then obtain a patent for fourteen more ? He would then have the exclusive use for twenty-one years. If for seven, why not for fourteen, or twenty-one, or any other assignable time ? The moment that his invention comes into the most common or public use, is the moment when he applies for a patent. When the public have fully got possession of it, he seeks to withdraw it from the common stock and appropriate it to himself. This is directly contrary to the design of the law. It extends the term and inverts the order of proceeding. The inconveniences would be very great. Those who were engaged in making the article must stop. Those who had arranged for making it must abandon their arrangements. Those who had employed their time in learning to make it must lose their time and their labor. And even a *bona fide* inventor, who had discovered the same thing by his own study and experiments, would be deprived of the fruits of his ingenuity and exertions. And why ? Simply because the first inventor did not choose sooner to take out a patent, as he might have done. The conditions of the law being such as he can comply with, and ought to comply with, he postpones a compliance for his own profit, and leads the community into an injurious error. If it be designed, it is a wrong. If it be without design, it is negligence. Ought he to be benefited by his own wrong or negligence ?

Opinion of the court.

The authorities are against him. He cited 3 Inst. 184 ; Wood v. Zimmer, 1 Holt's N. P. Rep. 58 [1 Am. & Eng. 202] ; Whittemore v. Cutter, 1 Gall. 482 ; and referred to Evans v. Eaton, 1 Peters's C. C. Rep. 348 ; Thompson v. Haight, 1 U. S. Law Journal, 563.

He then examined the several points stated for the defendant, contending that some of them were unsupported by the facts and others by the law. Under the second, he argued that there had been an "unreasonable lapse of time" and "gross negligence." That seven years—the period here unexplained—were beyond all reasonable bounds.

He contended also that due diligence, where there were no circumstances of explanation, was a question of law ; and that it consisted in applying for a patent as soon after the invention was completed as could reasonably be done ; and, finally, that due diligence required that the application should be made before the thing invented was publicly known and used with the consent of the inventor.

Mr. Justice STORY delivered the opinion of the court.

This is a writ of error to the Circuit Court of Pennsylvania. The original action was brought by the plaintiffs in error for an asserted violation of a patent granted to them on the 6th of July, 1818, for a new and useful improvement in the art of making leather tubes, or hose, for conveying air, water, and other fluids. The cause was tried upon the general issue, and a verdict was found for the defendant, upon which judgment passed in his favor ; and the correctness of that judgment is now in controversy before this court.

At the trial, a bill of exceptions was taken to an opinion delivered by the court in the charge to the jury, as follows, namely : "That the law arising upon the case was, that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention to which a patent would have entitled

Opinion of the court.

him, had it been applied for before such use ; and that it makes no difference in the principle that the article so publicly used, and afterward patented, was made by a particular individual, who did so by the private permission of the inventor. And thereupon did charge the jury *that, if the evidence brings the case within the principle which had been stated*, the court were of opinion that the plaintiffs were not entitled to a verdict."

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial by each party in support of the issue. It is very voluminous, and as no exception was taken to its competency or sufficiency, either generally or for any particular purpose, it is not properly before this court for consideration, and forms an expensive and unnecessary burden upon the record. This court has had occasion in many cases to express its regret on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record, since the opinion of the court, delivered to the jury, presented a general principle of law, and the application of the evidence to it was left to the jury.

In the argument at the bar, much reliance has been placed upon this evidence by the counsel for both parties. It has been said, on behalf of the defendants in error, that it called for other and explanatory directions from the court, and that the omission of the court to give them in the charge furnishes a good ground for a reversal, as it would have furnished in the court below for a new trial. But it is no ground of reversal that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point. If he does not, it is a waiver of it. The court cannot be presumed to do more in ordinary

Opinion of the court.

cases than to express its opinion upon the questions which the parties themselves have raised at the trial.

On the other hand, the counsel for the defendant in error has endeavored to extract from the same evidence strong confirmations of the charge of the court. But, for the reason already suggested, the evidence must be laid out of the case, and all the reasoning founded on it falls.

The single question, then, is, whether the charge of the court was correct in point of law. It has not been, and indeed cannot be, denied that an inventor may abandon his invention and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterward be resumed at his pleasure ; for where gifts are once made to the public in this way, they become absolute. Thus, if a man dedicates a way or other easement to the public, it is supposed to carry with it a permanent right of user. The question which generally arises at trials is a question of fact rather than of law—whether the acts or acquiescence of the party furnish, in the given case, satisfactory proof of an abandonment or dedication of the invention to the public. But when all the facts are given, there does not seem any reason why the court may not state the legal conclusion deducible from them. In this view of the matter, the only question would be whether, upon general principles, the facts stated by the court would justify the conclusion.

In the case at bar, it is unnecessary to consider whether the facts stated in the charge of the court would, upon general principles, warrant the conclusion drawn by the court, independently of any statutory provisions, because we are of opinion that the proper answer depends upon the true exposition of the act of Congress under which the present patent was obtained. The Constitution of the United States has declared that Congress shall have power “to promote the progress of science and useful arts by securing, *for limited times*, to authors and inventors, the exclusive right to their respective writings and discoveries.” It contemplates, therefore, that this exclusive right shall exist but for a limited period, and that the period shall be subject to

Opinion of the court.

the discretion of Congress. The Patent Act of the 21st of February, 1793, ch. 11, prescribes the terms, and conditions, and manner of obtaining patents for inventions ; and proof of a strict compliance with them lies at the foundation of the title acquired by the patentee. The first section provides : " That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new or useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, or composition of matter *not known or used before the application*, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to the said petitioner, &c., *for a term not exceeding fourteen years*, the full and exclusive right and liberty of *making, constructing, using and vending to others to be used* the said invention or discovery, &c." The third section provides : " That every inventor, before he can receive a patent, shall swear or affirm that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent." The sixth section provides that the defendant shall be permitted to give in defence to any action brought against him for an infringement of the patent, among other things, " that the thing thus secured by patent was not originally discovered by the patentee, *but had been in use*, or had been described in some public work, *anterior to the supposed discovery of the patentee*."

These are the only material clauses bearing upon the question now before the court ; and upon the construction of them there has been no inconsiderable diversity of

Opinion of the court.

opinion entertained among the profession, in cases heretofore litigated.

It is obvious, to the careful inquirer, that many of the provisions of our Patent Act are derived from the principles and practice which have prevailed in the construction of that of England. It is doubtless true, as has been suggested at the bar, that where English statutes—such, for instance, as the statute of frauds and the statute of limitations—have been adopted into our own legislation, the known and settled construction of those statutes by courts of law has been considered as silently incorporated into the acts, or has been received with all the weight of authority. Strictly speaking, that is not the case in respect to the English statute of monopolies, which contains an exception on which the grants of patents for inventions have issued in that country. The language of that clause of the statute is not, as we shall presently see, identical with ours, but the construction of it adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it.

By the very terms of the first section of our statute, the Secretary of State is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c., “*not known or used before the application.*” The authority is a limited one, and a party must bring himself within the terms before he can derive any title to demand or to hold a patent. What, then, is the true meaning of the words “*not known or used before the application*”? They cannot mean that the thing invented was not known or used before the application by the inventor himself, for that would be to prohibit him from the only means of obtaining a patent. The use as well as the knowledge of his invention must be indispensable, to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts. The

Opinion of the court.

words, then, to have any rational interpretation, must mean, not known or used by others before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself, or if, before his application for a patent, his invention should be pirated by another, or used without his consent, it can scarcely be supposed that the legislature had within its contemplation such knowledge or use.

We think, then, the true meaning must be, not known or used by the public before the application. And, thus construed, there is much reason for the limitation thus imposed by the act. While one great object was, by holding out a reasonable reward to inventors and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius, the main object was "to promote the progress of science and useful arts;" and this could be done best by giving the public at large a right to make, construct, use, and vend the thing invented at as early a period as possible, having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly and make and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure, and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years—it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.

A provision, therefore, that should withhold from an inventor the privilege of an exclusive right, unless he should, as early as he should allow the public use, put the public in possession of his secret and commence the running of the period that should limit that right, would not be deemed

Opinion of the court.

unreasonable. It might be expected to find a place in a wise prospective legislation on such a subject. If it was already found in the jurisprudence of the mother country, and had not been considered inconvenient there, it would not be unnatural that it should find a place in our own.

Now, in point of fact, the statute of 21 Jac., ch. 3, commonly called the statute of monopolies, does contain exactly such a provision. That act, after prohibiting monopolies generally, contains, in the sixth section, an exception in favor of "letters patent and grants of privileges for *fourteen years or under*, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which *others at the time of making such letters patent and grants shall not use.*" Lord COKE, in his commentary upon this clause or proviso, (3 Inst. 184,) says that the letters patent "must be of such manufactures which *any other at the time of making such letters patent did not use*; for albeit it were newly invented, yet if any other did use it at the making of the letters patent or grant of the privilege, it is declared and enacted to be void by this act." The use here referred to has always been understood to be a public use, and not a private or surreptitious use in fraud of the inventor.

In the case of *Wood v. Zimmer*, 1 Holt's N. P. Rep. 58, [1 Am. & Eng. 202,] this doctrine was fully recognized by Lord Chief Justice GIBBS. There the inventor had suffered the thing invented to be sold, and go into public use for four months before the grant of his patent; and it was held by the court that, on this account, the patent was utterly void. Lord Chief Justice GIBBS said: "To entitle a man to a patent, the *invention* must be *new to the world*. The *public* sale of that which is afterward made the subject of a patent, *though sold by the inventor only*, makes the patent void." By "invention," the learned judge undoubtedly meant, as the context abundantly shows, not the abstract discovery, but the *thing* invented; not the new secret principle, but the manufacture resulting from it.

Opinion of the court.

The words of our statute are not identical with those of the statute of James, but it can scarcely admit of doubt that they must have been within the contemplation of those by whom it was framed, as well as the construction which had been put upon them by Lord COKE. But if there were no such illustrative comment, it is difficult to conceive how any other interpretation could fairly be put upon these words. We are not at liberty to reject words which are sensible in the place where they occur, merely because they may be thought in some cases to import a hardship, or tie up beneficial rights within very close limits. If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent, how can the court say that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, what other use is? If it be a use within the meaning of the statute, how can the court extract the case from its operation and support a patent, where the suggestions of the patentee are not true, and the conditions on which alone the grant was authorized to be made do not exist? In such a case, if the court could perceive no reason for the restrictions, the will of the legislature must still be obeyed. It cannot and ought not to be disregarded where it plainly applies to the case. But if the restriction may be perceived to have a foundation in sound policy, and be an effectual means of accomplishing the legislative objects by bringing inventions early into public and unrestricted use, and, above all, if such policy has been avowed and acted upon in like cases in laws having similar objects, there is very urgent reason to suppose that the act in those terms embodies the real legislative intent, and ought to receive that construction. It is not wholly insignificant, in this point of view, that the first Patent Act passed by Congress on this subject, (act of 1790, ch. 34, [ch. 7,]) which the present act repeals, uses the words "*not known or used before*," without adding the words "*the application*," and, in connection with the structure of the sentence in which they stand, might have

Opinion of the court.

referred either to the time of the invention or of the application. The addition of the latter words in the Patent Act of 1793 must, therefore, have been introduced *ex industria*, and with the cautious intention to clear away a doubt and fix the original and deliberate meaning of the legislature.

The act of the 17th of April, 1800, ch. 25, which extends the privileges of the act of 1793 to inventors who are *aliens*, contains a proviso declaring "that every patent which shall be obtained pursuant to the act for any invention, art, or discovery *which, it shall afterward appear, had been known or used previous to such application for a patent*, shall be void." This proviso certainly certifies the construction of the act of 1793 already asserted, for there is not any reason to suppose that the legislature intended to confer on *aliens* privileges essentially different from those belonging to *citizens*. On the contrary, the enacting clause of the act of 1800 purports to put both on the same footing, and the proviso seems added as a gloss or explanation of the original act.

The only real doubt which has arisen upon this exposition of the statute has been created by the words of the sixth section already quoted. That section admits the party sued to give in his defence, as a bar, that "the thing thus secured by patent was not originally discovered by the patentee, but had been in use *anterior to the supposed discovery* of the patentee." It has been asked, if the legislature intended to bar the party from a patent in consequence of a mere prior use, although he was the inventor, why were not the words "*anterior to the application*" substituted, instead of "*anterior to the supposed discovery*"? If a mere use of the thing invented before the application were sufficient to bar the right, then, although the party may have been the first and true inventor, if another person, either innocently as a second inventor or piratically, were to use it without the knowledge of the first inventor, his right would be gone. In respect to a use by piracy, it is not clear that any such fraudulent use is within the intent of the statute, and upon general principles it might

Opinion of the court.

well be held excluded. In respect to the case of a second invention, it is questionable at least whether if, by such second invention, a public use was already acquired, it could be deemed a case within the protection of the act. If the public were already in possession and common use of an invention fairly and without fraud, there might be sound reason for presuming that the legislature did not intend to grant an exclusive right to any one to monopolize that which was already common. There would be no *quid pro quo*—no price for the exclusive right or monopoly conferred upon the inventor for fourteen years.

Be this as it may, it is certain that the sixth section is not necessarily repugnant to the construction which the words of the first section require and justify. The sixth section certainly does not enumerate all the defences which a party may make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. The sixth section in the clause under consideration may well be deemed merely affirmative of what would be the result from the general principles of law applicable to other parts of the statute. It gives the right to the *first* and true inventor, and to him only ; if known or used before his supposed discovery, he is not the *first*, although he may be a *true* inventor, and that is the case to which the clause looks. But it is not inconsistent with this doctrine, that although he is the *first* as well as the *true* inventor, yet if he shall put it into public use, or sell it for public use, before he applies for a patent, that this should furnish another bar to his claim. In this view, an interpretation is given to every clause of the statute, without introducing any inconsistency or interfering with the ordinary meaning of its language. No public policy is overlooked, and no injury can ordinarily occur to the first inventor, which is not in some sort the result of his own laches or voluntary inaction.

It is admitted that the subject is not wholly free from difficulties ; but, upon most deliberate consideration, we are all of opinion that the true construction of the act is

Notes and Citations.

that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent. His voluntary act or acquiescence in the public sale and use is an abandonment of his right, or rather creates a disability to comply with the terms and conditions on which alone the Secretary of State is authorized to grant him a patent.

The opinion of the Circuit Court was therefore perfectly correct, and the judgment is affirmed with costs.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Pennsylvania, and was argued by counsel ; on consideration whereof, it is the opinion of this court that there is no error in the judgment of the said Circuit Court. Whereupon it is considered, ordered, and adjudged by this court that the said judgment of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

Notes :

3. *Kendall v. Winsor*, 21 How. 322.

4. Constitutional provision considered in

Bloomer v. McQuewan, 14 How. 539.

Webber v. Virginia, 103 U. S. 344.

Paterson v. Kentucky, 97 U. S. 501.

McKeever v. U. S., 18 Court of Claims, 757. Affirmed by
Sup. Court, without a written opinion.

5. Act 1793, §§ 1, 3 and 6.

Vide Evans v. Eaton, 7 Wheat. 356 [p. 178 *ante*, note 8].

Notes and Citations.

6. See 5.

7. Statute of Monopolies considered in
Grant v. Raymond, 6 Pet. 218 [p. 245 *post*].

8 and 9. See 5.

10. Aliter. Act 1836, § 6 ; Act 1870, § 24 ; R. S., § 4886.

What is public use and sale ?

Shaw v. Cooper, 7 Pet. 292 [p. 286 *post*].

McClurg v. Kingsland, 1 How. 202 [p. 382 *post*].

Gayler v. Wilder, 10 How. 477.

Coffin v. Ogden, 18 Wall. 120.

Elizabeth v. Pavement Co., 97 U. S. 126.

Bates v. Coe, 98 U. S. 31.

Egbert v. Lippman, 104 U. S. 333.

Hall v. Macneale, 107 U. S. 90.

Manning v. Cape Ann Co., 108 U. S. 462.

Foreign use.

Roemer v. Simon, 95 U. S. 214.

Burden of proof on defendant.

Cantrell v. Wallick, 117 U. S. 689.

Subsequent to application.

Planing Machine Co. v. Keith, 101 U. S. 479.

Rifle and Cartridge Co. v. Whitney Arms Co., 118 U. S. 22.

Notes and Citations.

Delay in reissuing as abandonment.

Battin v. Taggart, 17 How. 74.

Leggett v. Avery, 101 U. S. 256.

Miller v. Brass Co., 104 U. S. 350.

James v. Campbell, 104 U. S. 356.

Matthews v. Machine Co., 105 U. S. 54.

Bantz v. Frantz, 105 U. S. 160.

Johnson v. Railroad, 105 U. S. 539.

Clements v. Odorless Co., 109 U. S. 641.

Mahn v. Harwood, 112 U. S. 354.

Torrent Arms Lumber Co. v. Rodgers, 112 U. S. 659.

Wollensak v. Reiher, 115 U. S. 96.

Brown v. Davis, 116 U. S. 237.

Yale Lock M'fg Co. v. Sargent, 117 U. S. 536.

White v. Dunbar, 119 U. S. 47.

Newton v. M'fg Co., 119 U. S. 373.

Ives v. Sargent, 119 U. S. 652.

Hartshorn v. Saginaw Barrel Co., 119 U. S. 664.

Surrender to reissue an abandonment of original.

Peck v. Collins, 103 U. S. 660.

Abandonment.

See *Agawam Co. v. Jordan*, 7 Wall. 583.

Suffolk Co. v. Hayden, 3 Wall. 315.

Seymour v. Osborne, 11 Wall. 516.

Blake v. Robertson, 94 U. S. 728.

Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274.

Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92.

Manufacturing Co. v. Corbin, 103 U. S. 786.

Patent in Suit :

No. . Pennock and Sellers. July 6, 1818. Leather tubes or hose.

OTHER SUITS ON SAME PATENT :

Pennock v. Dialogue, 1825. 4 Wash. 538 ; 1 Robb. 466.

Notes and Citations.

Citations :

IN SUPREME COURT OF UNITED STATES :

Grant *v.* Raymond, 1832. 6 Peters, 218 ; Bk. 8, L. ed. 376 [p. 245 *post*].

Shaw *v.* Cooper, 1833. 7 Pet. 292 ; Bk. 8, L. ed. 689 [p. 286 *post*].

McClurg *v.* Kingsland, 1843. 1 How. 202 ; Bk. 11, L. ed. 102 [p. 382 *post*].

Hogg *v.* Emerson, 1847.. 6 How. 457 ; Bk. 12, L. ed. 505.

Kendall *v.* Winsor, 1858. 21 How. 322 ; Bk. 16, L. ed. 165.

Johnston *v.* Jones, 1861. 1 Black. 209 ; Bk. 17, L. ed. 117.

Burr *v.* Des Moines, 1863. 1 Wall. 99 ; Bk. 17, L. ed. 561.

Agawam Co. *v.* Jordan, 1868. 7 Wall. 583 ; Bk. 19, L. ed. 177.

Generes *v.* Campbell, 1870. 11 Wall. 193 ; Bk. 20, L. ed. 110.

Case of Sewing Machine Co., 1873. 18 Wall. 553 ; Bk. 21, L. ed. 914.

Bates *v.* Coe, 1878. 98 U. S. 31 ; Bk. 25, L. ed. 68.

McDonald *v.* Hovey, 1883. 110 U. S. 619 ; Bk. 28, L. ed. 269.

IN CIRCUIT COURTS :

Watson *v.* Bladen, April, 1826. 4 Wash. Rep. 580 ; 1 Robb. 510.

Whitney *v.* Emmett, April, 1831. 1 Bald. 303 ; 1 Robb. 567.

Ryan *v.* Goodwin, May, 1839. 3 Sumn. 514 ; 1 Robb. 725.

Reed *v.* Cutter, October, 1841. 1 Story, 590 ; 2 Robb. 81 ; 4 Law Rep.

Heath *v.* Hildreth, October, 1841. 1 MacA.'s Pat. Cases, 12.

Cooper *v.* Mattheys, May, 1842. 5 Penn. L. J. 38 ; 8 Law Rep. 413.

Pierson *v.* Eagle Screw Co., June, 1844. 3 Story, 402 ; 2 Robb. 268.

Emerson *v.* Hogg, December, 1845. 2 Blatch. 1 ; Fish. Pat. Rep. 77.

Notes and Citations.

Allen *v.* Blunt, October, 1846. 2 Wood. & Minot, 121 ; 2 Robb. 530.
Hunt *v.* Howe, February, 1855. 1 MacA.'s Pat. Cases, 366.
Ellithorpe *v.* Robertson, September, 1858. 1 MacA.'s Pat. Cases,
585.
Savary *v.* Lauth, August, 1859. 1 MacA.'s Pat. Cases, 691.
Spear *v.* Belson, August, 1859. 1 MacA.'s Pat. Cases, 699.
Marcy *v.* Trotter, April, 1860. Ms. D. C.
Lovering *v.* Ducher, May, 1861. Ms. D. C.
Silverthorne *v.* Mitchell, August, 1862. Ms. D. C.
Locke *v.* United States, September, 1866. 1 Cliff. 574.
Goodall *v.* Tuttle, June, 1872. 3 Biss. 219. 7 Nat. Bank Reg. 193.
Adams *v.* Jones, November, 1859. 1 Fish. 527 ; 2 Pitts. R. 73.
Locke *v.* U. S., September, 1866. 2 Cliff. 577.
Parton *v.* Prang, October, 1872. 3 Cliff. 537.
Kelleher *v.* Darling, September, 1878. 4 Cliff. 424 ; 3 Ban. &
Ard. 438 ; 14 O. G. 673.
Henry *v.* Providence Tool Co., October, 1878. 3 Ban. & Ard. 501 ;
14 O. G. 855.
Judson *v.* Bradford, October, 1878. 3 Ban. & Ard. 539 ; 16 O. G.
171.
Manning *v.* Cape Ann Isinglass and Glue Co., November, 1879.
4 Ban. & Ard. 612 ; 9 Rep. 337.

IN STATE COURTS :

Earl *v.* Page, July, 1834. 6 N. H. Rep. 477.
McCay *v.* Burr, July, 1847. 6 Penn. 147.

IN CANADIAN COURTS :

Summers *v.* Avell, 1869. 15 Grant's Chan. R. 532.

Notes and Citations.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 6, 39, 53, 215, 216, 323, 342, 462.

Curt. on Pats., 4th ed., §§ 83, 101, 381, 382, 385, 387, 391, 448, 469, 473.

Walker on Pats., 1883, pp. 58, 65, 385.

Statement of the case.

JOSEPH GRANT *et al.* v. E. & H. RAYMOND.

6 Pet. 218-249. Jan., 1832.

[Bk. 8, L. ed. 376 ; 1 Robb. 604 ; 1 Whit. 146.]

Appeal from divided court practice. Reissue, Conclusiveness of. Insufficient description.

1. Practice on appeal on a division of opinion on a motion for a new trial (p. 246).
2. The patent law should be construed in the spirit in which it is made (p. 271).
3. The grant of a reissue to correct an error committed in the department of State, as also for an error arising through inadvertence or mistake on the part of the inventor, though not expressly authorized by the act of 1793 is within its spirit (p. 272).
4. The correct performance of all those preliminaries on which the validity of the original patent depends are always examinable in the court in which a suit for its violation shall be brought. It is the same with a patent reissued under Act 1793 (p. 272).
5. Doubted whether the fact that rights acquired by third parties pending the original invalid patent would not be a valid defence to the reissue (Act 1793) (p. 273).
6. The reissue, and the proceedings on which it issues, have relation back to the original transaction ; and the term runs from the date of the original patent (p. 274).
7. Actions involving judgment for defendant in the particular case, and those requiring in addition a judgment declaring the patent void, distinguished (p. 277).
8. An insufficient description is a complete defence to the particular suit under Act 1793, § 3 ; but in order to justify a judgment under Act 1793, § 6, declaring the patent void, it must further fully appear to have been with intent to deceive the public (p. 277).

[Citations in the opinion of the Court :]

(1) *Pennock v. Dialogue*, 2 Pet. 1 [p. 217 *ante*], p. 278.

THIS case came before the court, in the first instance, on a certificate of division in opinion in the Circuit Court of the United States for the Southern District of New York.

Statement of the case.

On inspecting the record, it appeared that on the trial of the cause in the Circuit Court the counsel for the defendants had excepted to the decisions of the court on various matters which had been presented for the consideration of the court, and that a bill of exceptions had been sealed by the court on their motion.

The record proceeded to state that the cause afterward came on for argument on a motion for a new trial, when the opinions of the two judges of the Circuit Court were opposed upon questions presented for the decision of the court, excepted to on the trial, as stated in the bill of exceptions: "That upon the questions thus occurring before the court, the opinions of the said two judges were opposed; and, upon request of the counsel of the plaintiffs, the points upon which the disagreement happened were stated under the direction of the judges, and certified under the seal of the court to the Supreme Court."

Mr. Webster stated that a question, preliminary to the argument of the case, was presented for the decision of the court. It was, whether the court would entertain the case as it came up from the Circuit Court, on a division in that court on a motion for a new trial. This court had exercised their right to decide in cases where the opinions of the judges of the Circuit Court on questions of law had been opposed, when a motion for a new trial was before the court.

Mr. Justice Story. In the cases referred to, the division of the court took place on the trial of the cause before the jury, as well as on the motion for a new trial.

Mr. Chief Justice Marshall suggested that the case might be brought on if the parties would agree that it should stand as if a judgment had been given by the Circuit Court on the exceptions. The case, he said, could not be heard on a difference in opinion of the judges of the court on a motion for a new trial.

Statement of the case.

The counsel for the plaintiffs and defendants having agreed that the case should stand as suggested by the Chief Justice, and an agreement in writing to that effect having been filed, the court made the following order :

It is now here by the court considered and ordered, that this cause shall now be heard and decided, as on a writ of error brought after verdict and judgment in the Circuit Court, on the exceptions which were taken in that court ; that the cause shall now proceed, as if judgment had been actually entered in the Circuit Court for the plaintiffs there, and that the certificate in the case shall be taken, regarded, and treated as a writ of error sued out by the defendants below, on the judgment of the Circuit Court, and that the question shall be, as in other cases, whether the said judgment ought to be reversed or affirmed ; but that this court will reserve its opinion and judgment in this cause till the defendants in the court below shall have sued out a writ of error in this cause to the said Circuit Court, and filed a return thereto, with a bill of exceptions in this cause, in the usual form, signed by the court below, in this court.

The case came on for argument after the defendants had sued out a writ of error on a judgment entered in the Circuit Court for the plaintiffs, in conformity with the suggestion and order of this court. The case was as follows :

The action was brought to recover damages for an alleged infringement of a patent-right, and came on for trial in the Circuit Court in November, 1828, when a verdict was rendered for the plaintiffs for three thousand two hundred and sixty-six dollars sixty-six cents.

The plaintiffs gave in evidence a patent from the United States, in the following terms, the same being the patent declared upon :

“ Whereas Joseph Grant, a citizen of the United States, hath alleged that he hath invented a new and useful improvement in the mode of manufacturing hat-bodies by the combination of motions, namely, the rotary and revolving motion, with the vibrating or transverse motion, which

Statement of the case.

forms the two hat-bodies by machinery, and crosses the wool from one extremity of the hat-bodies to the other at one operation, called Grant's improved winding machine for setting up hat-bodies,—his former patent for the same invention, dated the 11th day of August, 1821, having been cancelled, owing to the defective specification on which the same was granted, which improvement he states had not been known or used before his application,—hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement, hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose :

“ These are, therefore, to grant, according to law, to the said Joseph Grant, his heirs, administrators, or assigns, for the term of fourteen years from the 11th day of August, 1821, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said Joseph Grant himself, in the schedule hereto annexed, and is made a part of these presents.

“ In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed. Given under my hand, at the city of Washington, this 28th day of April, in the year of our Lord 1825, and of the independence of the United States of America the forty-ninth.

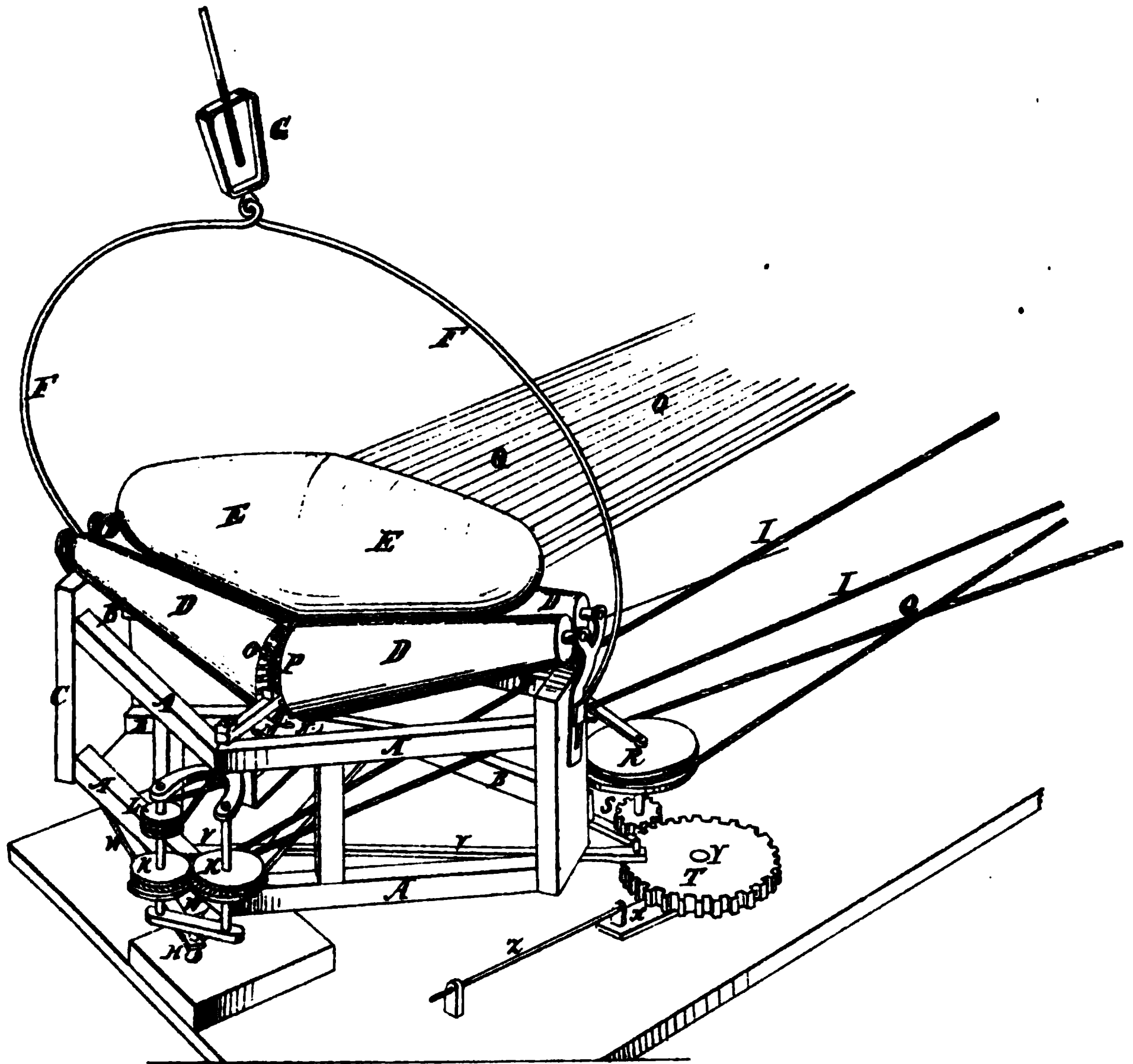
[L. S.]

“ J. Q. ADAMS.

“ By the President. H. CLAY, *Secretary of State.*”

City of Washington, to wit : I do hereby certify that the foregoing letters patent were delivered to me on the 28th day of April, in the year of our Lord 1825, to be examined ; that I have examined the same and find them conformable to law, and I do hereby return the same to the Secretary of

J. Grant.
Forming Bats.
Patented Apr. 28, 1825.



Statement of the case.

State within fifteen days from the date aforesaid, to wit, on this 28th day of April, in the year aforesaid.

WILLIAM WIRT,
Attorney-General of the U. S.

The schedule referred to in these letters patent, and making part of the same, contained a description, in the words of the said Joseph Grant himself, of his improvement in the mode of manufacturing hat-bodies by the combination of motions, namely, the rotary or revolving motion, with the vibrating or transverse motion, which forms the two hat-bodies by machinery, and crosses the wool from one extremity of the hat-bodies to the other at one operation, called Grant's improved winding machine for setting up hat-bodies, his former patent for the same invention, dated the 11th day of August, A.D. 1821, having been cancelled, owing to the defective specification on which the same was granted.

The schedule, which contained a full description of the invention, and of the mode of using it, was also given in evidence.

The counsel for the plaintiffs also produced and read in evidence a certificate of the Secretary of State, duly authenticated under his hand and official seal, and certain papers thereto annexed, in the words and figures following :

“ To all to whom these presents shall come, greeting :

“ I certify that the annexed is a true copy of the record of cancellation of a patent granted to Joseph Grant on the 11th of August, 1821, and cancelled on the 28th of April, A.D. 1825 ; also, that the annexed is a true copy of the petition praying for the cancellation, and the issuing of another patent for the same invention.

“ In testimony whereof, I, Henry Clay, Secretary of State of the United States, have hereunto subscribed my name, and caused the seal of the Department of State to be affixed. Done at the city of Washington, this 19th day of

Statement of the case.

May, A.D. 1828, and of the independence of the United States of America the fifty-second.

[L. S.]

“H. CLAY.”

This patent was returned to the Patent Office, the seal broken, and now stands cancelled, owing to the defective specification on which it was issued, and another patent granted (with a corrected specification) on the 28th day of April, 1825, bearing date with the first, and for the same invention.

The petition of Joseph Grant, of Providence, in the county of Providence and State of Rhode Island, hatter, a citizen of the United States of America, respectfully represents, that your petitioner has invented a new and useful improvement in the mode of manufacturing hat-bodies by the combination of motions, namely, the rotary or revolving motion, with the vibrating or transverse motion, which forms the two hat-bodies by machinery, and crosses the wool from one extremity of the hat-bodies to the other at one operation, called “Grant’s improved winding machine for setting up hat-bodies,” according to the specification, explanations, and drawings, herewith presented, which the subscriber prays may be taken as a part of his petition—an improvement not used or known before his application, the advantages of which your petitioner is desirous of securing to himself and his legal representatives.

Your petitioner would further state, that he has heretofore, namely, on the 11th day of August, A.D. 1821, obtained letters patent from the President of the United States for his said improvement, but, owing to a defective specification on which the same were granted, he prays that the said patent may be cancelled, and a new and correct one granted, embracing the same improvements, so far as the same are set forth in the accompanying specification, drawing, and explanations. Your petitioner therefore prays that letters patent of the United States may be issued, granting to your petitioner, his heirs, administrators, or assigns, the full and exclusive right of making,

Statement of the case.

constructing, using, and vending to others to be used his said improvement, according to the specification and drawings hereto annexed, agreeably to the act of Congress in such case made and provided, your petitioner having paid thirty dollars into the treasury of the United States, and complied with other provisions of the said act. As in duty bound, will ever pray.

JOSEPH GRANT.

To the Hon. HENRY CLAY, Secretary of State of the United States of America.

Providence, April 20, 1825.

As the assignee of David Curtis, who was the assignee of Joseph Grant, of one moiety of the original patent, I unite in the prayer of the above petitioner, that the original patent may be cancelled, and a new one granted to the said Joseph Grant, as above set forth.

SOLOMON TOWNSEND.

To the Hon. HENRY CLAY, Secretary of State of the United States of America.

Providence, April 20, 1825.

The counsel for the defendant objected that the Secretary of State had no power, by law, to accept a surrender of and to cancel said letters patent, or to inquire into or decide upon the causes for so doing, or to grant said second patent for the same invention, with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent.

The court decided that such surrender might be made, when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee; and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent, in manner aforesaid. To which decision the counsel for the defendant excepted.

The fourth plea, filed on the part of the defendant, after

Statement of the case.

reciting the specification annexed to the patent of the plaintiffs, averred as follows: "And the defendants aver that said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention; but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely: in said specification no proportions, sizes, or distances are given, and the bigness or size of none of the principal parts of said machine is given in said specification or drawings, but the same is wholly omitted; and, in other particulars, said specification and drawings are altogether defective. And the defendants aver that said specification, annexed to and making part of said letters patent, with the drawings thereto annexed, do not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art of which said machine or improvement is a branch, or with which it is most nearly connected, to make and use the same; and that, for the cause aforesaid, said letters patent are void. All which the defendants are ready to verify; wherefore they pray judgment if the said Joseph Grant and Solomon Townsend ought to have or maintain their aforesaid action against them, and for their costs." To which plea the following replication was filed:

"And as to the plea of the said Eliakim Raymond and Henry Raymond, by them fourthly above pleaded, the said Joseph Grant and Solomon Townsend say that, by reason of anything in the said last-mentioned plea alleged, they ought not to be barred from having and maintaining their aforesaid action thereof against them, the said Eliakim Raymond and Henry Raymond, because they say that the specification mentioned in the said last-mentioned plea does correctly and accurately describe the improvement claimed by the said Joseph Grant as his invention; and because they say, further, that neither the said specification nor the

Argument of counsel.

drawings thereto annexed are defective in any of the particulars in that behalf alleged in the said last-mentioned plea ; and this they, the said Joseph Grant and Solomon Townsend, pray may be inquired of by the country, and the said Eliakim Raymond and Henry Raymond do the like," &c.

The counsel for the defendants on the said trial introduced sundry witnesses to prove the allegations traversed in the said fourth plea, and insisted that they had proved the same, and that the said specification of the said Joseph Grant did not describe the improvement which he claimed to have invented in such full, clear, and exact terms as to distinguish the same from all other things before known, nor so as to enable a person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same ; and they requested the court to charge the jury, that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for the defendants—which instructions the court refused to give ; but instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public—to which opinion the counsel for the defendants also excepted.

The case was argued by *Mr. Webster*, for the defendants in the Circuit Court, now before the court as plaintiffs in error ; and by *Mr. Ogden*, for the defendants, plaintiffs in the Circuit Court.

Mr. Webster stated that the first question for the decision of the court was, whether the Secretary of State can accept the surrender of a patent, cancel it, and grant a new one for the unexpired term for which a patent had been granted, on a suggestion that the specification is defective through inadvertence or mistake ?

It cannot but be doubted whether such cancellation can be made anywhere, so as to take out a new patent.

Argument of counsel.

The whole system of patents rests on statute provision. There is no common-law power, or prerogative right, in the President to issue a patent. In this particular, our law is different from the English. *Ours* is a statute grant ; theirs is an emanation out of a statute prohibition. With us, the fountain is statute ; with them, *prerogative*. Our statute makes no provision for any surrender, and the issuing of a new patent thereon. Indeed, it seems impossible to reconcile such a proceeding to the requisitions of the act.

How can the patentee allege, or assign for his second patent, that *his improvement had not been known before that application* ? That is a statute requisition. Here, in the case before the court, it had been in use three years. The party must claim, and in this case does claim, under his second patent, as a new and substantive patent ; not under his first, with an amended specification.

On surrender or cancellation of the patent, the party comes for a new patent for the same invention. Now, in all such cases, it must be that the thing has been used or known before that application. In this very case, it does not appear that his petition contained the *statute requisites*. It refers it to *his former application*.

But however this may be, the Secretary of State has no authority to make a record of cancellation, and to issue a new patent. The Secretary of State is a merely ministerial officer. All the laws relating to granting patents regard him as merely ministerial. His department is denominated an executive department. He has nowhere any particle of judicial power. On the subject of patents, as well as all others, he acts wholly ministerially.

By the first Patent Law, April 10, 1790, the Secretaries of State, War, and Attorney-General were invested with authority to grant or refuse patents. But this was repealed by the existing law of February 21, 1793. The power of granting or withholding patents was by this act taken away from everybody. The Secretary was to give the patent out, on certain requisitions being complied with, without exercising any judgment, or making any inquiry ; and the patent

Argument of counsel.

was to avail the grantee what it might, according to the truth of the representations of the patentee. It is matter of right and matter of course to issue the patent if the requisites of the law be complied with. The Secretary has nothing to do but make out the patent.

He is applied to as keeper of the seal. And if a dispute arises between inventors, the Secretary cannot decide it; he is to appoint umpires. Section 9. He is not trusted to decide even whether the *form* of the letters patent be conformable to law; that belongs to the Attorney-General.

The general power of the Secretary is commented on in *Marbury v. Madison*, 1 Cranch, 159, 160. He is to record diplomatic transactions; but he cannot alter or cancel those records. He records treaties and acts of Congress; but those, of course, he cannot alter.

The Secretary has no power to record in his office any transaction not his own, except so far as authorized by statute.

In regard to patents, the statute declares what shall be recorded: 1. The patent itself. 2. The assignment of it, if requested. These are all. The Secretary has nothing more to do. As to cancelling a patent, he is *functus officio*.

The breaking the seal, or other cancellation by the patentee of his patent, is just as effectual if done anywhere else as if done at the State Department. It is not a transaction which the law has prescribed for recording anywhere. He can neither authorize this cancellation nor forbid it, nor make it matter of official record.

The vacating and cancelling the record of a patent is in its nature a judicial act. The act of 1793 treats it as such, *and provides two modes of such vacation*. Cited the sixth and tenth sections of the act.

The common law, also, provides a mode. *The court cannot add a new section to the act.*

In England, the repealing of patents is always regarded as a judicial act. Godson on Patents, 200.

The limitations under which the court below thought the Secretary could vacate one patent and issue another, show

Argument of counsel.

that the power he is expected to exercise is judicial. The defect must arise from inadvertence or mistake, without fraud or misconduct. The power of the Secretary to act, then, depends upon his having adjudged the case to be one of mistake, and not a case of fraud. This is judicial power. How can the Secretary make this judicial investigation?

1. He has no parties before him, and no power to bring persons before him. When done in court, this is done in the presence of *litigant parties*. 2. He cannot summon witnesses before him, and if they should come voluntarily, he cannot administer an oath to them. Such oaths would be extra-judicial and nugatory. He cannot require the party's own oath.

Now, whether the want of a proper specification be the effect of accident or of fraud, is a question of fact; and it is to be decided by the Secretary, without parties, oaths, or witnesses.

Besides, the surrender is to be accepted only when the specification is defective. Is not that very question a question of fact, or a mixed question of law and fact? Certainly it is. It is for the jury. Even a court cannot determine it without a jury.

By act of April 20, 1818, the Secretary of State appoints a *superintendent*. Does he delegate to him his judicial power?

There is but one way of answering this view of the subject. It must be contended, that in every case, on the mere suggestion of the patentee, a new patent is to be issued for the residue of the term, with an amended specification—leaving it to be decided, when suit should be brought, whether the defect was inadvertent or fraudulent.

This would change the whole patent system. Its effects would be monstrous. Patentees would try their claims under one specification; they might fail; and they would call it *inadvertence*, and try another experiment.

A man builds an expensive factory, puts in costly machinery, not patented, not described in any specification; he expends much money; by-and-by he is sued for violat-

Argument of counsel.

ing a patent, and he finds that since he built, an old patent has come out with a new specification. A hearing, of which he knew nothing, has been had before the Secretary, and a new patent has issued, and he is called on to stop his factory. Now, this supposed case is the very case before the court. The defendants erected their works in 1823, 1824. They knew of the plaintiff's patent of August 11, 1821, but it did not describe any machinery used by them. But in 1825 he surrendered his first patent, took out another, with a specification *describing their machinery*, and sued them. Under the direction of the court, he has recovered a verdict for three thousand two hundred and sixty-six dollars, and is entitled, of course, to have this *trebled*, and the defendants are ruined. *Is this legal?* A bill in equity is pending, also, to stop the defendants' factory.

Now, what reason is there for saying that defendants shall suffer these losses, even by the mistake or inadvertence of the patentee? The invention had become public, and, if not protected by the first patent, it was gone forever. A bad patent is no patent. 1 Barn. & Ald. 386. It may be well for Congress to give the courts or judges power to vacate patents on patentee's own motion; but then Congress would provide limitations and securities for innocent persons. On the doctrine of this case, there are no securities.

What are the consequences of such a principle? A man finds out that there are other machines made like his, which he would like to *stop*; he sets up inadvertence, gets a new patent, and stops them. *If he swears it, who can deny it? It is of younger date, and he swears he meant to describe it.* This would furnish irresistible temptation to perjury.

There is a deeper objection. A man makes an invention; he gets a patent; but his specification does not describe it, but describes something else. In the mean time the public use, not what he has patented, but what he has not. Now, how is the public to be deprived of the use of this? It is denied that they can be prevented this use. The decision of this court, in *Pennock v. Dialogue*, proves this cannot

Argument of counsel.

be. The invention was used and known before it was patented. A patent not describing an invention is void as to that invention, and does not protect it. The invention, by a single month's use, unprotected by a patent, becomes public property and can never be resumed.

Whether the patent be void through fraud or inadvertence, if it does not describe the invention, then the invention is not protected, but *has become public property*. Pennock v. Dialogue so decides.

In England, a *scire facias* to repeal a patent is a criminal proceeding, and does not allow costs. [The King v. Miles] 7 Term Rep. 367 ; Godson, 201.

This case was tried, in New York, before Pennock v. Dialogue was decided in this court.

The only case applicable to the one now before the court is Morris v. Huntington, 1 Paine, 348. That was decided in 1824. Its doctrine was materially changed by Pennock v. Dialogue. After all, that case only decides that a patent, while another is in existence, is void. The judge then goes on to say it may be surrendered.

It seems admitted that the new patent ought not to reach back so as to affect those who had already used the invention. But how can this distinction be made ? Cited to this point, Brooke v. Clarke, 1 B. & A. 396, note.

The great and conclusive objection is this : the new patent is granted on the new application, and the invention had been public four years. This is fully settled in the case of Pennock v. Dialogue.

The second point is presented on the defendants' fourth plea. The court instructed the jury that the patent would not be void, unless the defective or imperfect specification arose from design or the purpose of deceiving the public.

This point presents two questions :

1. Whether the patent would be void or not for the reasons stated, the direction of the court was not pertinent to the issue. The parties were at issue on a question of fact ; witnesses were examined, and counsel had summed up ; but the court told the jury the issue was *immaterial*, and

Argument of counsel.

under this question the jury found a verdict for plaintiff.

It can require no argument to prove that this is an illegal direction. [State v. Woodruff] 2 Day's Reports, 519 ; [Moreland v. Leigh] 1 Starkie, 388 ; [Otis v. Walkins] 9 Cranch, 339, 355.

2. If the question had legally arisen, the law was wrongly stated.

It is insisted that the plea was a good bar. If the specification was defective, as set forth in the plea, the plaintiff could not recover, whether that defect arose from accident or design. The very words of the third section of the statute require this. There are certain conditions precedent to be complied with *before an inventor can obtain a patent*. This is one of them. The language of this section is emphatic and absolute ; it could not be stronger. Courts may just as well *dispense with the oath*.

Suppose he omit to deliver any written specification whatever, can he afterward say that omission was owing to inadvertence ? *Yet a defective specification, or bad specification, is no specification*. The same law that requires a written specification, requires *a full and accurate one*. A defective one is no better than none at all. Suppose he omit to sign the specification, can that be cured ?

A party is to describe his invention so as to answer two purposes :

1. To distinguish it from all other things before known.
2. To enable any person skilled in the art to make and use it. If he fail in either of these, he fails in a condition precedent.

This is all very clear, and there would be no doubt about it but for the sixth section. That section has been supposed to raise the doubt.

This section, as has been observed by most judges, is *inartfully drawn*. It speaks of the right of the defendant to *give this act in evidence in an action founded on the act itself*. It is not grammatical. It seems borrowed from the law of 1791.

Argument of counsel.

The first important remark is, that the preceding sections have described the whole extent of the patentee's right. This section has for its object the giving of immunities and protection to those who may be sued by patentees. Therefore, its object was not to enlarge the right of patentees. Second, most of its provisions are only affirmative, and the right existed before. The action being case, all the material defences are competent. Third, it gives some matters as a defence not mentioned in the first act, such as license or abandonment to the public. Fourth, it does not repeat *the same* objections to specification.

It allows the defendant to prove three things as fatal defects in his specification : 1. That it does not contain the whole truth relative to the discovery, with intent to deceive the public. This provision may stand with the first section. 2. That it contains more than is necessary to produce the described effect, with intent to deceive the public. This may stand with the third section. 3. That the thing had been used or described in a public work. This may also stand.

Now, the fraudulent intent is applied only to the first two. In these cases Congress may say that fraud shall be proved, because, even with these defects, it may be a patent, and a very useful patent.

It may be a valid patent, though the patentee take it but for part of his invention ; yet if he fraudulently deceive the public, by keeping back part, it shall be void. So it may be a good and valuable patent, though it contain more than is necessary to produce the described effect. But if it be not so described as to be distinguished from other things before known, or so that skilful persons can use it, it is *no patent*, or *of no use at all*. These last objections go to its very existence, and are therefore made prerequisites. They are absolute conditions precedent.

But the main consideration yet is, that this sixth section has an object of its own. It looks not so much to the defence in its suits *as to the judicial vacation of the patent*. It does not look mainly to the defence of the suits, because

Argument of counsel.

it leaves out several known grounds of defence: 1. License. 2. Abandonment to the public. 3. That the patent is broader than the invention. 4. That the machine is not well described. All these are defences, and yet not mentioned here.

The object of the sixth section is, like that of the tenth, *to repeal for fraud proved*. All this may stand without contradicting the third section, or doing violence to its language.

Indeed, *Pennock v. Dialogue*, 2 Peters, 1, has apparently decided this. The sixth section speaks of inventions *known before the patentee's discovery*. This does not contradict the third section—“*known before application*.” The court has settled this, and it decides this case.

The plaintiff relied below on the following cases: *Park v. Little and Wood*, 3 Washington, 196, in April, 1813; *Gray et al. v. James*, 1 Peters, 401, 1817.

But it does not appear in this case whether the defendant was or was not proceeding with a view to vacate the patent. Most probably he was; for at that time such was the practice. This is rendered still more probable by a decision looking the other way, in 1820, by the same judge. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. Rep. 13. *This case is clearly for the plaintiffs in error*.

The case of *Whittemore v. Cutter*, 1 Gallis. 419, decided in May, 1813, was probably a case *to vacate*; at any rate, the judges doubted, and would have divided if the case had turned on this point. The case of *Lowell v. Lewis*, 1 Mason, 193, in 1817, was probably a similar case; page 189 cited particularly.

How can the court dispense with the express words of the third section? Here they are put in the form of a *special plea*. *Can they be disregarded?* Suppose there be but one witness, though this is merely a *formal* requisite, can the court dispense with it?

Besides, why should the statute require a specification, unless *it was to be full and accurate?* For what purpose should an insufficient *specification be enjoined?* The court

Argument of counsel.

may as well say *there shall be none*. The statute says as imperatively what the specification shall contain, as that there shall be a specification at all. If an imperfect or defective specification does not render a patent void, *what harm does it do to it?* Let this question be answered.

Now, the patentee says his specification, in 1821, was *defective* not through fraud, but *defective*. But why was not that patent good, or this? If defective through fraud, he could not get another. It must be presumed to be defective through *inadvertence*. If so, what need of a new one?

Compare the two rules of law decided in this case together:

1. The judge held, that a party might surrender his patent and take a new one, when the specification in the first was defective through mistake, and without fraud.
2. The court ruled, that though a specification be altogether defective, yet the patent is not void, unless such defect arise from design.

How can these things stand together? If the last proposition be true, all inquiry about the first is idle—unless the question be, whether a man having one good patent may surrender it and take out another good one for the same thing.

It is now matter of settled law, that if a patent be broader than the invention, it is void; and it is never inquired whether this arise from design or accident. In nine times out of ten, it arises from inadvertence. Now, on what principle is this? Not because the plaintiff's *invention* has not been invaded. It may have been exactly copied. It is because he has not rightly described what he *claimed*, and therefore his patent protects him in nothing. So, if a patent be for an improvement of an old machine, it must state the improvement accurately, and distinguish between what is old and what new. Finally, the English statute has always been construed the other way. Our sixth section is a substitute for the English *scire facias*.

Cited Davis's Patent Cases, 413; Godson, 124; Holroyd, 100, note. Cited, also, Dodson's Patents, 56; [Turner v. Win-

Argument of counsel.

ter] 1 Term Rep. 605 [1 Am. & Eng. 43]; [Hurst's Lessee v. M'Neil] 1 Wash. C. C. Rep. 71; [Park v. Little] 3 Wash. C. C. Rep. 198; [Lowell v. Lewis] 1 Mason, 189, 190; [Earle v. Sawyer] 4 *ibid.* 9, 10; [Evans v. Eaton] 3 Wheat. 518; [Boulton v. Bull] 2 Hen. Black. 478 [1 Am. & Eng. 59]; [*Ex parte* Fox] 1 Ves. & Beames, 67; [Hornblower v. Boulton] 8 Term Rep. 101 [1 Am. & Eng. 98]; [Paine v. Pritchard] 2 Car. & Paine, 558; [Cowles v. Dunbar, *ibid.*] 565; [Harmar v. Playne] 11 East, 107 [1 Am. & Eng. 171]; [Harmer v. Plane] 14 Ves. 131 [1 Am. & Eng. 166].

Mr. Ogden, for the defendants in error.

The first question is, whether the Secretary of State of the United States has a power by law to accept of the surrender of and to cancel a patent which had once been issued, and to grant a second patent for the same invention, with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent?

Upon this question, there is not known a single case where the point has been expressly decided in the United States. The Patent Law is silent upon the subject; and the question must, then, be decided upon general principles.

A patent for a useful machine is a grant of the exclusive privilege of making and using the machine for a limited time. Now, it would seem that a *grantee* may surrender his grant. A man who has a privilege may *surrender* that privilege. If a man cancels his patent upon record, it amounts to a surrender of it.

The difficulty in question, if there be any, must be in the other branch of it. Has the Secretary of State the power, after the surrender of one patent, to grant a new one for the same invention, with an amended specification for the unexpired portion of the term of fourteen years which had been granted by the first patent? Why should he not? When the first patent is cancelled, the invention is unprotected. If a useful one, why should not the inventor have the benefit of it?

Argument of counsel.

He certainly never intended to abandon the benefit of it to the public. His first patent is evidence of that.

A specification requires to be drawn with great accuracy. Mechanics, by whom machines are usually invented, it cannot be supposed are capable of drawing a proper specification. Can it be supposed that the law ever intended to punish their ignorance, in drawing a very special legal paper, by a forfeiture of all the advantages of their invention?

It is apprehended that the issuing a new patent in England, where there has been no sufficient specification to comply with the condition of the first patent, is pretty much a matter of course.

In the case *Ex parte Beck*, 1 Bro. Ch. Rep. 575 [1 Am. & Eng. 23], the Lord Chancellor says "that, perhaps, upon the petitioner's applying for a new patent, the officers might, under these circumstances, be induced to remit their fees, but that he could give no relief upon the present petition." Here the Lord Chancellor speaks of the issuing of a *new* patent as a matter of course.

In our Patent Law, the inventor must file his specification before he can procure his patent. In England, the patent contains upon its face a condition that if the patentee shall not make and file a specification within a limited time *after* the date of the patent, then the patent, and all the liberties and advantages under it, shall cease and be void.

One of the cases cited by the plaintiff in error shows that if the specification is not filed within the time mentioned in the patent, although the patent is void, a new one may be taken out by the inventor for the same invention.

This case, in principle, seems to support the proposition for which the defendant in error contends: that if a first patent is void for want of a specification, or for want of a sufficient specification, a new one may be issued for the same invention to the same inventor. In the case of *Morris v. Huntington*, 1 Paine's Rep. of Cases in the Second Circuit, 355, Mr. Justice Thompson says:

"I see no insuperable objection to entering a *vacatur* of

Argument of counsel.

the patent of record in the Department of State, if taken out inadvertently or by mistake. All the proceedings in that department on the subject of patents are *ex parte*, except in the case of interfering applications. The department acts rather ministerially than judicially, and upon the representation of the applicant, without entering into an examination of the question of right; and there seems to be no good reason why, on a like *ex parte* application, the patent may not be surrendered and cancelled of record, if no misconduct be imputable to the patentee in taking it out." Cited, also, page 356.

So far, then, as this question has ever arisen in any of our courts, the right to surrender an old patent and procure a new one has been recognized. Cited, also, Barrett *et al.* v. Hall, 1 Mason, 475, as to the *second* point.

The second point is settled by the express terms of the Patent Law, and by the adjudications which have taken place under it.

1. By the express terms of the Patent Law.

The sixth section of the Patent Act declares "that the defendant shall be permitted to plead the general issue, and give this act and any special matter in evidence, of which notice in writing must have been given, &c., thirty days before the trial, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made *for the purpose of deceiving the public*," &c., &c.

So, therefore, if the specification does not contain the whole truth relative to the discovery, or if it contains more than is necessary to produce the described effect, the patent shall not, for these causes, or either of them, be evidence, unless "the concealment or addition shall fully appear to have been made for the purpose of deceiving the public."

2. By the adjudications which have taken place under the law.

The first case in which the question came up, was the

Opinion of the court.

case of Whitney v. Carter, in the Circuit Court of Georgia. That case is cited in Mr. Fessenden's *Essay on the Law of Patents*, 123.

His Honor, Judge JOHNSON, in charging the jury in that case, said "he considered the defendants' second objection equally unsupported, and referred to the sixth section of the Patent Law, by which it is required that the concealment alleged (in order to defeat the patentee's recovery) must appear to have been made for the purpose of deceiving the public. That Mr. Whitney could have no motive for such concealment," &c., &c.

In the case of Gray & Osgood v. James *et al.*, 1 Peters's C. C. Rep. 394, this question came up before the Circuit Court in Pennsylvania. Judge WASHINGTON says: "But if the jury should be of opinion that the specification is materially defective, the objection will not be sufficient to invalidate the plaintiff's patent, unless they should also be satisfied that the concealment of the circumstances not described was intended to deceive the public."

In the case of Whittemore v. Cutter, 1 Gallis. 429, Mr. Justice STORY says: "Any defect or concealment in a specification, to avoid a patent, must arise from an intention to deceive the public." In the case of Lowell v. Lewis, 1 Mason, 189, the same learned judge makes a similar declaration.

Mr. Chief Justice MARSHALL delivered the opinion of the court.

This action was brought by Grant & Townsend against E. & H. Raymond, to recover damages for an infringement of their right under a patent granted to the plaintiff, Joseph Grant, in April, 1825. It recited that a former patent had been issued in August, 1821, to the same person for the same improvement, "which had been cancelled, owing to the defective specification on which the same was granted." The exclusive privilege given by the patent, on which the suit is brought, is to continue fourteen years from the day on which the original was issued.

Opinion of the court.

One of the pleas filed by the defendants contained the following averment: "And the defendants aver that the said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention; but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely: in said specification no proportion, sizes, or distances are given, and the bigness or size of none of the principal parts of said machine is given in said specification or drawings, but the same is wholly omitted; and, in other particulars, said specifications and drawings are wholly defective. And the defendants aver that said specification, annexed to and making part of said letters patent, with the drawings thereto annexed, do not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art of which said machine or improvement is a branch, or with which it is most nearly connected, to make and use the same; and that, for the cause aforesaid, said letters patent are void."

The plaintiffs reply that they ought not to be barred, "because they say that the specification mentioned in the said last-mentioned plea does correctly and accurately describe the improvement claimed by the said Joseph Grant as his invention; and because they say, further, that neither the said specification nor the drawings thereto annexed are defective in any of the particulars in that behalf alleged in the said last-mentioned plea, and this, they pray, may be inquired of by the country." On this replication issue was joined.

At the trial, the counsel for the defendants objected that the Secretary of State had no power, by law, to accept a surrender of and to cancel the said letters patent, or to inquire into or decide upon the causes for so doing, or to grant said second patent for the same invention, with an amended specification, for the unexpired portion of the

Opinion of the court.

term of fourteen years which had been granted by the first patent.

The court decided that such surrender might be made when the defect arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee; and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent, in manner aforesaid. To which decision the counsel for the defendants excepted.

After adducing the testimony on which they relied to support their plea hereinbefore stated, the counsel for the defendant moved the court to instruct the jury, that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for the defendants—which instructions the court refused to give; but instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public—to which opinion the counsel for the defendants also excepted.

The jury found a verdict for the plaintiffs, and assessed their damages to three thousand two hundred and sixty-six dollars sixty-six cents, the judgment on which is brought before this court by a writ of error.

The first question in the cause respects the power of the Secretary of State to receive a surrender of a patent, cancel the record thereof, and issue a new patent for the unexpired part of the fourteen years for which the original had been granted. The court was of opinion that this might be done “when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee.”

The right of the patentee to surrender his patent has not been denied, but the plaintiffs in error insist that no power exists to grant a new patent for the unexpired term. The words of the act, they say, do not confer this power. It

Opinion of the court.

cannot be exercised with its necessary guards by the Department of State, and inconvenience of no inconsiderable magnitude might result to the public from its exercise. The Secretary of State is, in the act of making out patents, a mere ministerial officer, and can exercise no power which is not expressly given.

It is undoubtedly true that the Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued. It is equally true that the act of Congress contains no words which expressly authorize the Secretary to issue a corrected patent, if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection, and of the argument founded on it, is felt. If the new patent can be sustained, it must be on the general spirit and object of the law,—not on its letter.

To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power “to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries,” is among those expressly given to Congress. This subject was among the first which followed the organization of our government. It was taken up by the first Congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, &c., on his petition, “granting to such petitioner, his heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, using, and vending to others to be used the said invention or discovery.” The law farther declares that the patent “shall be good and available to the grantee or grantees, by force of this act, to all and every intent and purpose herein contained.” The amendatory act, of 1793, contains the

Opinion of the court.

same language, and it cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made, and to execute the contract fairly on the part of the United States, where the full benefit has been actually received,—if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield ;—it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved ; and for his exclusive enjoyment of it during that time the public faith is pledged. That sense of justice and of right which all feel pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.

If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent, even in this case. Its emanation is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken, for the same purpose, if the mistake has been innocently committed by the inventor himself ?

The counsel for the plaintiffs in error have shown very clearly that the question of inadvertence or mistake is a judicial question, which cannot be decided by the Secretary

Opinion of the court.

of State. Neither can he decide those judicial questions on which the validity of the first patent depends. Yet he issues it without inquiring into them. Why may he not, in like manner, issue the second patent also? The correct performance of all those preliminaries on which the validity of the original depends are always examinable in the court in which a suit for its violation shall be brought. Why may not those points on which the validity of the amended patent depends be examined before the same tribunal? In the case under consideration, those questions were not supposed by the Circuit Court to have been decided in the Department of State, but were expressly submitted to the jury. The rightfulness of issuing the new patent is declared to depend on the fact that "the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee." The jury were, of course, to inquire into the fact. The condition on which the right to issue the patent depended, could be stated to them for no other purpose.

It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the act of Congress.

We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act.

An objection much relied on is, that after the invention has been brought into general use, those skilled in the art or science with which it is connected, perceiving the variance between the specification and the machine, and availing

Opinion of the court.

themselves of it, may have constructed, sold, and used the machine without infringing the legal rights of the patentee, or incurring the penalties of the law. The new patent would retroact on them, and expose them to penalties to which they were not liable when the act was committed.

This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examine it for the purpose of pirating the invention. They are not entitled to much favor. But the answer to the objection is, that this defence is not made in this case ; and the opinion of the Circuit Court does not go so far as to say that such a defence would not be successful. That question is not before the court, and is not involved in the opinion we are considering. The defence, when true in fact, may be sufficient in law, notwithstanding the validity of the new patent.

It has been also argued that the new patent must issue on the new specification, and on the application which accompanies it. Consequently, it will not be true that the machine was "not known or used before the application."

But the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application ; and, if the new patent is valid, the law must be considered as satisfied if the machine was not known or used before that application.

It has been urged that the public was put into possession of the machine by the open sale and use of it under the defective specification, and cannot be deprived of it by the grant of a new patent. The machine is no longer the subject of a patent.

This would be perfectly true if the second patent could be considered as independent of the first. But it is in no respect so considered. The communication of the discovery to the public has been made in pursuance of law, with the intent to exercise a privilege, which is the consideration

Opinion of the court.

paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a court of equity might interpose to restrain him.

It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the Circuit Court, and have considered it as settled. We would not willingly disregard this settled practice in a case where we are not satisfied it is contrary to law, and where we are satisfied that it is required by justice and good faith.

We will now proceed to the second exception.

The plea assigns the particular defect supposed to exist in the specification, and then proceeds to aver, in the very words of the act, that it "does not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art, &c., to make and use the same," &c.

The plea alleges, in the words of the act, that the prerequisites to the issuing a patent had not been complied with.

If the matter alleged in this plea constituted no bar to the action, the plaintiffs might have demanded and have submitted the question of law to the court. But they have chosen to deny the facts alleged in the plea, and to aver in their replication "that neither the specification nor the drawings thereto annexed are defective in any of the particulars in that behalf alleged." Issue was joined upon this replication, and it is that issue which the jury were sworn to try.

At the trial, the counsel for the defendants, after the evidence was closed, asked the court, in substance, to instruct the jury, that if they should be of opinion that the defendants had maintained and proved the facts alleged in their

Opinion of the court.

plea, they must find for the defendants. The court refused this instruction. Ought it to have been refused? If, in the opinion of the jury, the defendants have proved and maintained every fact alleged in the plea on which the issue they are sworn to try is joined, ought not the jury to find that issue for the defendants? Is not this required by their oaths? The conclusion, "and that for the cause aforesaid said letters patent are void," is an inference of law from the facts previously alleged,—not the allegation of a distinct fact, to be submitted to the jury.

The court proceeded to instruct the jury, "that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, or for the purpose of deceiving the public."

Now, this "*design*," this "*purpose of deceiving the public*," constituted no part of the issue. The defendants had not alleged it, and could not be supposed to come prepared to prove it. A verdict for them would not imply it. The instruction is understood to direct a verdict which finds in fact that the description or specification is not defective; and this verdict against the evidence is to be found because that defect "arose not from design, or for the purpose of deceiving the public."

But we must inquire whether the instruction, independent of its departure from the issue, be consistent with law. It is "that the patent would not be void unless," &c.

The fifth section of the act gives the party aggrieved an action for the infringement of his patent-right. The sixth provides "that the defendant in such action shall be permitted to plead the general issue, and give this act in evidence, and to give in evidence any special matter of which notice in writing may have been given to the plaintiff or his attorney thirty days before trial, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to this discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that

Opinion of the court.

the thing thus secured," &c., "in either of which cases judgment shall be rendered for the defendant with costs, and the patent shall be declared void."

Courts did not, perhaps, at first, distinguish clearly between a defence which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement, and one which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled.

If the party is content with defending himself, he may either plead specially or plead the general issue, and give the notice required by the sixth section of any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defence is complete ;—he is entitled to the verdict of the jury and the judgment of the court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to the sixth section. If he depends on evidence "tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect," it may avail him so far as respects himself, but will not justify a judgment declaring the patent void, unless such "concealment or addition shall fully appear to have been made for the purpose of deceiving the public," which purpose must be found by the jury, to justify a judgment of *vacatur* by the court. The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defence, except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only

Opinion of the court.

in the particular case and for the particular purpose stated in the sixth section.

This instruction was material if the verdict ought to have been for the defendants, provided the allegations of the plea were sustained, and if such verdict would have supported a judgment in their favor, although the defect in the specification might not have arisen from design, and for the purpose of deceiving the public. That such is the law, we are entirely satisfied. The third section requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary, in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent. The necessary consequence of the ministerial character in which the Secretary acts is, that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case was of the first impression, we should come to this conclusion ; but it is understood to be settled.

The act of Parliament concerning monopolies contains an exception on which the grants of patents for inventions have issued in that country. The construction of so much of that exception as connects the specification with the patent, and makes the validity of the latter dependent on the correctness of the former, is applicable, we think, to proceedings under the third section of the American act. The English books are full of cases in which it has been held that a defective specification is a good bar when pleaded to, or a sufficient defence when given in evidence on the general issue, on an action brought for the infringement of a patent-right. They are very well summed up in Godson's Law of Patents, title specification ; and also in the chapter respecting the infringement of patents ; also in Holroyd on Patents, where he treats of the specification, its form, and requisites. It is deemed unnecessary to go through the cases, because there is no contrariety in them, and because the question is supposed to be substantially settled in this country. *Pennock & Sellers v. Dialogue*, 2 Peters,

Opinion of the court.

1, was not, it is true, a case of defect in the specification or description required by the third section, but one in which the applicant did not bring himself within the provision of the first section, which requires that before a patent shall issue the petitioner shall allege that he has invented a new and useful art, machine, &c., "*not known or used before the application.*"

This prerequisite of the first section, so far as a failure in it may affect the validity of the patent, is not distinguishable from a failure of the prerequisites of the third section.

On the trial, evidence was given to show that the patentee had permitted his invention to be used before he took out his patent. The court declared its opinion to the jury, that if an inventor makes his discovery public, he abandons the inchoate right to the exclusive use of the invention. "It is possible," added the court, "that the inventor may not have intended to give the benefit of his discovery to the public." "But it is not a question of intention," "but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say whether the evidence brings this case within the principle which has been stated. If it does, the court is of opinion that the plaintiff is not entitled to a verdict."

The jury found a verdict for the defendants; an exception was taken to the opinion, and the judgment was affirmed by this court.

This case affirms the principle, that a failure on the part of the patentee in those prerequisites of the act which authorize a patent, is a bar to a recovery in an action for its infringement; and that the validity of this defence does not depend on the invention of the inventor, but is a legal inference upon his conduct.

Upon these authorities, and this reasoning, we are of opinion that the instruction was erroneous, and that the judgment ought to be reversed and the cause remanded. One of the judges composing the majority thinks that the direction would have been erroneous on a plea properly framed upon the third section of the act, and averring the

Notes and Citations.

facts of a defective specification and a non-compliance with the other requisitions of that section, for that such a plea would be a good bar and defence to the action ; but, in his view, the plea relies upon the facts as avoiding the patent entirely, and avers it to be void. He thinks, however, that the replication puts the facts, and not the point whether void or not, in issue ; and that the direction of the court was erroneous, since it was equivalent to a declaration that, if all the facts were proved, the issue ought not to be found for the defendants, unless the imperfection of the specification arose from a fraudulent design.

The judgment is reversed, and the cause remanded, with directions to issue a *venire facias de novo*.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel ; on consideration whereof, it is the opinion of this court that the said Circuit Court erred in instructing the jury, " that the patent would not be void on this ground unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public." Whereupon it is ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

Notes :

3. Office error properly corrected by reissue.

Morey v. Lockwood, 8 Wall. 230.

Accident, inadvertence or mistake.

Manufacturing Co. v. Ladd, 102 U. S. 408.

Miller v. Brass Co., 104 U. S. 350.

McMurray v. Mallory, 111 U. S. 97.

Wollensak v. Reiher, 115 U. S. 96.

Newton v. Furst & Bradley, 119 U. S. 373.

Notes and Citations.

Of solicitors.

Hartshorn *v.* Saginaw Barrel Co., 119 U. S. 664.
Ives *v.* Sargent, 119 U. S. 652.

4. Reissue proceedings, when conclusive and when not.

Shaw *v.* Cooper, 7 Pet. 292 [p. 286 *post*].
Stimpson *v.* Railroad, 4 How. 380.
Seymour *v.* Osborne, 11 Wall. 516.
Klein *v.* Russell, 19 Wall. 433.
Corn Planter Patents, 23 Wall. 181.
Russell *v.* Dodge, 93 U. S. 460.
Powder Co. *v.* Powder Works, 98 U. S. 126.
Ball *v.* Langles, 102 U. S. 128.

5. Intervening rights accruing.

Stimpson *v.* Railroad Co., 4 How. 380 [p. 398 *post*].
Battin *v.* Taggert, 17 How. 74.
James *v.* Campbell, 104 U. S. 356.
White *v.* Dunbar, 119 U. S. 47.

6. Reissue relates back to original.

Shaw *v.* Cooper, 7 Pet. 292 [p. 286 *post*].
Read *v.* Bowman, 2 Wall. 591.
Agawam Co. *v.* Jordan, 7 Wall. 583, and see 5.

8. Act 1790, § 2 ; Act 1793, § 3 ; Act 1836, § 6 ; Act 1837, § 6 ;
Act 1842, § 4 ; Act 1870, §§ 27-30 ; R. S., §§ 4889-
4892.

Notes and Citations.

Insufficient description a defence.

Mitchell v. Tilghman, 19 Wall. 287.

Sewall v. Jones, 91 U. S. 171.

Loom Co. v. Higgins, 105 U. S. 580.

Act 1790, § 6 ; Act 1793, § 6 ; Act 1836, § 15 ; Act 1870, § 61 ; R. S., § 4920.

Statutes relating to reissues are :

Act 1832, § 3 ; Act 1836, § 13 ; Act 1837, § 5 ; Act 1870, § 53 ; R. S., § 4916.

Patent in suit :

No. . Grant, J. August 11, 1821. Hat bodies. Re-issue, April 28, 1825.

Citations :

IN SUPREME COURT OF UNITED STATES :

Shaw v. Cooper, 1833. 7 Pet. 292 ; Bk. 8, L. ed. 689 [p. 286 *post*].

McClurg v. Kingsland, 1843. 1 How. 202 ; Bk. 11, L. ed. 102 [p. 382 *post*].

Wilson v. Rousseau, Diss. Opin., 1846. 4 How. 646 ; Bk. 11, L. ed. 1141 [p. 436 *post*].

Hogg v. Emerson, 1848. 6 How. 437 ; Bk. 12, L. ed. 505.

U. S. v. Chicago, 1849. 7 How. 185 ; Bk. 12, L. ed. 660.

Winans v. Denmead, 1853. 15 How. 330 ; Bk. 14, L. ed. 717.

Battin v. Taggart, 1854. 17 How. 74 ; Bk. 15, L. ed. 37.

Read v. Bowman, 1864. 2 Wall. 591 ; Bk. 17, L. ed. 812.

Loom Co. v. Higgins, 1882. 105 U. S. 580 ; Bk. 26, L. ed. 1177.

IN CIRCUIT COURTS :

Ames v. Howard, October, 1833. 1 Sumn. 482 ; 1 Robb. 689.

Pierson v. Eagle Screw Co., June, 1844. 3 Story, 402 ; 2 Robb. 268.

Notes and Citations.

Brooks *v.* Jenkins, July, 1844. 3 McLean, 432 ; Fish. Pat. Rep. 41.
 Davoll *v.* Brown, October, 1845. 1 Wood. & Minot, 53 ; 2 Robb.
 303.
 Woodworth *v.* Hall, May, 1846. 1 Wood. & Minot, 248 ; 2 Robb.
 495.
 Woodworth *v.* Hall, October, 1846. 1 Wood. & Minot, 401 ; 2 Robb.
 517.
 Allen *v.* Blunt, October, 1846. 2 Wood. & Minot, 121 ; 2 Robb.
 530.
 Blanchard *v.* Haynes, 1848. 6 West L. J. 82.
 Smith *v.* Downing, June 1850. 1 Fish. 64.
 French *v.* Rogers, November, 1851. 1 Fish. 133.
 Day *v.* New England Car Spring Co., May, 1854. 3 Blatch. 179.
 Child *v.* Adams, November, 1854. 3 Wall. Jr. 20 ; 1 Fish. 189.
 Laidley *v.* James, April, 1860. Ms. D. C.
In re Ball, June, 1860. Ms. D. C.
Ex parte Dyson, September, 1860. Ms. D. C.
 House *v.* Young, December, 1867. 3 Fish. 335.
 Carew *v.* Boston Elastic Fabric Co., March, 1871. 1 Holmes, 45.
 Manning *v.* Cape Ann Isinglass and Glue Co., November, 1879.
 4 Ban. & Ard. 612 ; 9 Rep. 337.
 Marsh *v.* Nichols, March, 1883. 15 Fed. Rep. 914 ; 24 O. G. 901.
 Willcox & Gibbs Sewing-Machine Co. *v.* Frame, August, 1883.
 24 O. G. 1272. 17 Fed. Rep. 623 ; 16 Rep. 290.
 Odell *v.* Stout, October, 1884. 22 Fed. Rep. 159 ; 29 O. G. 862.

IN OPINIONS OF ATTORNEY-GENERAL :

Goulding's Case, August, 1833. 2 Opinion of A. G. U. S., p. 572
 (Taney).

Notes and Citations.

IN DECISIONS OF COMMISSIONER OF PATENTS :

Sargent & Burge, 1876. 10 O. G. 285.

Carroll v. Morse, February, 1876. 9 O. G. 453.

C. W. Baldwin, March, 1876. 9 O. G. 639.

Ex parte Cottrell, March, 1876. 9 O. G. 495.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 5, 69, 204, 221.

Curt. on Pats., 4th ed., §§ 358, 367, 391, 395*a*, 448.

Walker on Pats. 1883. Pp. 68, 97, 128, 148, 155, 165, 181, 191,
324, 373.

Syllabus.

JOSEPH SHAW PLAINTIFF IN ERROR, v. JOSEPH COOPER.

7 Pet. 292-323, Jan., 1833.

[Bk. 8, L. ed. 689 ; 1 Whitt. 173 ; 1 Robb. 643.]

Right to reissue. Prior knowledge and use. Abandonment.
Acquiescence. Particular patented invention abandoned.

1. The holder of a defective patent may surrender it and obtain a new one, which is a continuation of and relates back to the original (Grant v. Raymond, 6 Pet. 220, affirmed) (p. 310).
2. The rights of the patentee of a reissue must be ascertained by the law under which the original application was made (p. 311).
3. Rights of alien patentee under Acts 1800 and 1793 are placed upon substantially the same grounds as those of citizens (p. 311).
4. The prior knowledge and use under Act 1793, § 1, refers to the public only, and when fraudulently obtained raises no presumption of abandonment (p. 315).
5. Under Act 1793 any acquiescence by the inventor in the public use of his invention prior to obtaining a patent is an abandonment, but acquiescence can in no case be presumed where he has no knowledge of such use (p. 317).
6. Want of diligence in asserting his right on becoming aware of the public use of his invention is evidence of inventor's acquiescence therein (p. 317).
7. Questions of fact that would defeat the patent or the application are left open to be controverted by any one who contests the patent (p. 317).
8. Patent granted Shaw, J., June 19, 1822, reissued May 7, 1829, for percussion gun, held to have been in public use with inventor's consent prior to the grant of his patent, and was abandoned (p. 318).
9. Whatever may be the inventor's intention, if he suffers his invention to go into public use through any means whatsoever without an immediate assertion of his right, he is not entitled to a patent (p. 319).

Statement of the case.

[Citations in the opinion of the Court :]

- (1) Grant v. Raymond, 6 Pet. 22 [p. 245 *ante*], p. 310.
- (2) Miller v. Taylor, 4 Burr. 2303, p. 312.
- (3) Whittemore v. Cutter, 1 Gall. 482, p. 313.
- (4) Goodyear v. Mathews, 1 Paine's Rep. 301, p. 313.
- (5) Morris v. Huntington, 1 Paine, 354, p. 313.
- (6) Mellus v. Silsbee, 4 Mason, 108, p. 313.
- (7) Conn. v. Penn., 4 Wash. 438, p. 313.
- (8) Treadwell v. Bladen, 4 Wash. 708, p. 313.
- (9) Pennock v. Dialogue, 2 Pet. 1 [p. 217 *ante*], p. 313.

IN error to the Circuit Court of the United States for the Southern District of New York.

At the October Term, 1829, of the Circuit Court for the Southern District of New York, the plaintiff in error, Joseph Shaw, instituted an action against the defendant, Joseph Cooper, for an alleged violation of a patent granted to him by the United States, dated the 7th of May, 1829, for "a new and useful improvement in guns and fire-arms, which improvement consisted in a priming head and case applied to arms and fire-arms, for the purpose of priming and giving them fire by the means or use of percussion, fulminating, or detonating powder," by which patent the plaintiff alleged that there was granted to him, &c., for the term of fourteen years, from the 19th of June, 1822, the exclusive right to the said invention, and by virtue of which he became entitled to the same for the residue of the term unexpired on the 7th day of May, 1829. The declaration averred that the defendant had violated the patent-right of the plaintiff, on the 1st day of August, 1829, and afterward, between that day and the institution of the suit.

The defendant pleaded not guilty, and gave the following notice of the matters of defence :

"Please to take notice that, on the trial of the above cause, the above-named Joseph Cooper will, under the plea of the general issue aforesaid, insist upon and give in evidence that the pretended new and useful improvement in guns and fire-arms, mentioned and referred to in the several counts of the said Joshua Shaw's declaration, was not originally discovered or invented by the said Joshua Shaw ;

Statement of the case.

also, that the said pretended new and useful improvement, or the material or essential parts or portions thereof, or some or one of them, had been known and used in this country, namely, in the city of New York and in the city of Philadelphia, and in sundry other places in the United States, and in England, and in France, and in other foreign countries, before the said Joshua Shaw's application for a patent, as set forth in his said declaration ; and also before the alleged invention or supposed discovery thereof by the said Joshua Shaw.

“ And further, that the said alleged new and useful improvement, or the material or essential parts or portions thereof, or some one of them, or the principle thereof, was the invention or discovery of a gunmaker, or of some other person, residing in England. And further, that the said patent was void, because in and by the specification or description therein referred to, no distinction or discrimination is made between the parts and portions previously known and used as aforesaid, and any parts or portions of which the said Joshua Shaw may be the inventor or discoverer ; the said Joseph Cooper, at the same time, protesting that he, the said Joshua Shaw, has not been the inventor or discoverer of any part or portion of the said alleged improvement.

“ And further, that the said patent is void, because the said specification or description does not describe the improvement of which the said Joshua Shaw claims to be the inventor or discoverer, in such full, clear, and exact terms as to distinguish the same from all other things before known, nor so as to enable a person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same. And further, that the said patent is void, because it was not granted, issued, or obtained according to law. And further, that the said patent is void, because it was surreptitiously obtained by said Joshua Shaw.”

The cause was tried in January, 1832, and a verdict and

Statement of the case.

judgment given for the defendant. The plaintiff prosecuted this writ of error.

The following bill of exceptions was tendered by the counsel for the plaintiff, and sealed by the court :

“ The plaintiff, to maintain the issue on his part, gave in evidence the letters patent of the United States of America, as set forth in the declaration of the said plaintiff, issued on the 7th day of May, 1829 ; and also that the improvement for which the said letters patent were granted was invented or discovered by the said plaintiff in the year 1813 or 1814, and that the defendant had sold instruments which were infringements of the said letters patent. And thereupon the said defendant, to maintain the said issue above joined on his part, then and there proved, by the testimony of one witness, that he had used the said improvement in England, and had purchased a gun of the kind there, and had seen others use the said improvement, and had seen guns of the kind in the Duke of York’s armory, in 1819 ; and also proved, by the testimony of five other witnesses, that, in 1820 and 1821, they worked in England at the business of making and repairing guns, and that the said improvement was generally used in England in those years, but that they never had seen guns of the kind prior to those years ; and also proved that, in 1820, it was known and used in France ; and also that the said improvement was generally known and used in the United States of America after the 19th day of June, 1822. Whereupon the said plaintiff, further to maintain the said issue on his part, then and there gave in evidence that the said plaintiff, not being a worker in iron in 1813 or 1814, employed his brother, in England, under strict injunctions of secrecy, to execute or fabricate the said improvement, for the purpose of the said plaintiff’s making experiments. And that the said plaintiff afterward, in 1817, left England and came to reside in the United States of America ; and that after the departure of the said plaintiff from England, namely, in 1817 or 1818, his said brother divulged the said secret for a certain reward

Statement of the case.

to an eminent gunmaker in London. That the said plaintiff, on his arrival in this country, in 1817, disclosed his said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same, and whom he wished to engage to join and assist him. That the plaintiff made said disclosures under injunctions of secrecy, claiming the improvement as his own, and declaring that he should patent it. That the said plaintiff treated his invention as a secret after his arrival in this country, often declaring that he should patent it; and that he assigned as a reason for delaying to patent it, that it was not so perfect as he wished to make it before he introduced it into public use; and that he did make alterations in his invention up to about the date of his patent, which some witnesses considered as improvements, and others did not. That in this country the said invention was never known or used prior to the said 19th day of June, 1822; that on that day letters patent were issued to the said plaintiff, being then an alien, for his said invention; and that the said plaintiff immediately brought the said invention into public use under the said letters patent. That afterward, and after suits had been brought for violation of the said letters patent, the said plaintiff was advised to surrender them, on account of the specification being defective; and that he did accordingly, on the 7th day of May, 1829, surrender the same into the Department of the Secretary of State of the United States of America; and that thereupon the letters patent first above mentioned were issued to the said plaintiff. And the said plaintiff also gave in evidence, that prior to the said 19th day of June, 1822, the principal importers of guns, from England, in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard anything of the said invention, or that the same was known or used in England, and that no guns of the kind were imported into this country until the years 1824 or 1825. And that letters patent were granted in England, on the 11th day of April, 1807, to one Alexander J. Forsyth, for a method of discharging or giving fire to artillery and all

.Statement of the case.

other fire-arms, which method he describes in his specification as consisting in 'the use or application as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding without any actual fire being applied thereto, and merely by a blow, or by any sudden or strong pressure or friction, given or applied thereto, without extraordinary violence—that is to say, some one of the compounds of combustible matter, such as sulphur or sulphur and charcoal, with oxmuriatic salt; for example, the salt formed of dephlogisticated marine acid and potash, (or potasse,) which salt is otherwise called oxmuriate of potash, or such of the fulminating metallic compounds as may be used with safety; for example, fulminating mercury, or of common gunpowder mixed in due quantity with any of the above-mentioned substances, or with any oxmuriatic salt, as aforesaid, or of suitable mixtures of any of the above-mentioned compounds;' and that the said letters patent continued in force for the period of fourteen years from and after granting of the same. (It is understood that the patent and specification of Forsyth may be at any time referred to on the argument for correction or explanation of the bill of exceptions.) And thereupon the defendant, further to maintain the said issue on his part, gave in evidence a certain letter from the plaintiff to the defendant, dated in December, 1824, from which the following is an extract: 'Some time since I stated that I had employed counsel respecting regular prosecutions for any trespasses against my rights to the patent. I have at length obtained the opinion of Mr. Sergeant of this city, together with others eminent in law, and that is, that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others to whom I made my invention known, and also of the person whom I employed to make the lock at the time of invention; for it appears very essential that I should also prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful. It is, therefore, my intention to visit England in May next for

Statement of the case.

this purpose. In the mean time, proceedings which have commenced here are suspended for the necessary time.'

"And the said judges of the said court did thereupon charge and direct the said jury that the patent of the 7th day of May, 1829, having been issued, as appeared by its recital, on the surrender and cancelment of the patent of the 19th day of June, 1822, and being intended to correct a mistake or remedy a defect in the latter, it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in 1822, when the patent was obtained.

"That the plaintiff's case, therefore, came under the act passed the 17th day of April, 1800, extending the right of obtaining patents to aliens, by the first section of which the applicant is required to make oath that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know, in 1822, that the invention for which he was taking out a patent had, before that time, been in use in a foreign country, but that his knowledge or ignorance on that subject was rendered immaterial by the concluding part of the section, which expressly declares that every patent obtained pursuant to that act for any invention which, it should afterward appear, had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States; and that, if the invention was previously known in England or France, it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case; but the court were of opinion that he had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent. That the use of the invention by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor; and if, as appeared from the evidence in this case, the public had

Argument of counsel.

become fairly possessed of the invention before the plaintiff applied for his patent, it was sufficient, in the opinion of the court, to invalidate his patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it."

The case was submitted to the court, on printed arguments, by *Mr. Paine*, for the plaintiff in error, and *Mr. Emmet*, for the defendant.

For the plaintiff in error, it was contended that the case fell within the principles which had been uniformly acknowledged and supported in the Circuit Court of the United States, and which were not intended to be disavowed, but sanctioned by this court, in *Pennock v. Dialogue*, 2 Peters, 1.

In this country, many strong cases of public use, prior to the application for a patent, have been brought before the courts, where the public had been long in possession; and the courts have allowed the inventor to show in different ways that he had not thereby abandoned his use to the public. How much more favorable to us are the circumstances of our case, as respects a prior use. Before we took out our first patent, the invention had never been seen or heard of in this country. It was not then known to ourselves, nor to any others in this country, that it had been used in England; and it had been so used only one or two years—a short period, compared with the many cases which have been sustained by the courts. Even if this use had been an American use, it would not have been an extraordinary one. But it was not an American, but a foreign use; and, therefore, not a use by the public who contest our exclusive right by saying that they had become the innocent possessors of our invention. Not one of that public had gotten possession of it.

The case does not seem to be fairly stated, when it is said that, although the invention was disclosed by piracy, yet

Argument of counsel.

the public have innocently got possession of it by that means. The only public who can set up the innocence of their possession as against us, did not get their possession by the piracy, but under the invalid patent. And if this be so, what difference does it make that afterward guns were brought from England? Does such a circumstance bear, can it be made to bear, at all upon the merits of the case?

The parts of the charge to the jury of the Circuit Court which are objected to, as understood by the counsel for the plaintiff, may be stated thus:

That the use of the invention abroad, acquired through a fraudulent or piratical disclosure of the secret, for a period of only one or two years before the application for the patent, and that use entirely unknown to the inventor here, avoids the patent, because it was obtained under the alien act.

That our patent of 1829, obtained under the citizen's act, is, in respect to the prior foreign use, to be construed as if obtained under the alien act, because it was obtained on the surrender of the patent of 1822, which was obtained under the alien act, the one being only a continuation of the other.

That the inventor (the court are understood to have been speaking, in this part of the charge, without reference to the question as to whether the patent was obtained under the alien or citizen's act, but to have designed their remarks to apply to patents generally) had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent; that the use of the invention by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's right, but that the law was made for the benefit of the public as well as of the inventor; and if, as appeared from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient to invalidate his patent, even though the invention may have originally got into public use through

Argument of counsel.

the fraud or misconduct of his brother, to whom he intrusted the knowledge of it.

The following points comprehend these objections to the charge of the court :

1. The second patent is original and independent, and not a continuation of the first patent.

When patents are surrendered and cancelled in England, they are entirely vacated and gone, and as if they had never existed ; and the king can grant out the right, *de novo*, either to the same or to any other person. 17 Vin. Abridg. 114, Prerogative of the King, R. b. paragraph 9 ; 17 Vin. Abridg. 151, Prerogative, &c., M. C. paragraphs 2, 3, 4, 6, 10, 14 ; Godson on Patents, 200 ; Com. Dig. Patent, G.

If this is the effect of a surrender there, it must be the same here.

Not a *dictum* can be found in the English books that a second patent is a continuation of the first. No such idea can be found in our own books, although cases of surrender have come before our courts.

The right of an inventor to surrender an invalid patent and take out a new one being admitted, it follows that, if between the two patents he has been naturalized, he must, of necessity, take out a patent under the citizen's act, because he is no longer an alien. If he rightfully takes a patent under the citizen's act, he is entitled to all the advantages that act confers, and, among them, to have his patent construed and adjudicated upon under the provisions of that act, and of no other.

2. A fraudulent or piratical use of the invention, either at home or abroad, before the application for a patent, cannot have any other or greater effect to invalidate a patent obtained under the alien act than one obtained under the citizen's act.

On general principles, it cannot ; for, as to all kinds of property, no one can acquire a right to it, except by the consent of the owner. Theft or fraud can never enable one who gets possession by those means to transfer the property. See authorities cited under next point.

Argument of counsel.

It is on this principle that the courts first began to construe the citizen's act, by arraying the sixth section against the first. They said the legislature meant to provide by the sixth section for the exception of cases of fraud, &c., out of the too rigid and literal operation of the first section. Afterward, the courts took a more liberal view of the act, and held that, even without the sixth section, the legislative intention to except such cases from the first section would be presumed ; and this is the doctrine finally settled in *Pennock v. Dialogue*.

The construction given by this court in the case of *Pennock v. Dialogue*, 2 Peters, 22, is entirely in favor of the plaintiff in error.

The court there say, in that case : " The act of 17th April, 1800, ch. 25, which extends the privileges of the act of 1793 to inventors who are aliens, contains a proviso declaring that ' every patent which shall be obtained pursuant to the act for any invention, art, or discovery which, it shall afterward appear, had been known or used previous to such application for a patent, shall be void.' This proviso certainly certifies the construction of the act of 1793, already asserted, for there is not any reason to suppose that the legislature intended to confer on aliens privileges essentially different from those belonging to citizens ; on the contrary, the enacting clause of the act of 1800 purports to put both on the same footing, and the proviso seems added as a gloss or explanation of the original act."

Now, the proviso is the only thing in the alien act which can make it at all different in this particular from the citizen's act ; and the courts say that it does not make any difference, but merely expresses more fully what was the meaning of the citizen's act.

3. If an invention has been pirated or fraudulently divulged, the inventor cannot thereby lose his right to his own invention and property ; and it makes no difference that the public have acquired the use of the invention without any participation in the fraud, unless the inventor has acquiesced in such use, the only principle to be found in

Argument of counsel.

the American decisions on this subject being, that a public use does not affect the inventor's right, unless it proves that he has dedicated or abandoned his invention to the public. And in this case there is no evidence of such delay or neglect as would amount to an abandonment, nor of any intention to dedicate the invention to the public.

It is a general principle, as to all kinds of personal property, that even a *bona fide* purchaser for a valuable consideration can never acquire property of which another has been deprived by fraud, theft, or violence, or even by a bailment. [Harvey v. Stokes] 1 Wils. Rep. 8; [Hartop v. Hoare] 2 Str. Rep. 1187; [Hartop v. Hoare] 3 Atk. Rep. 44; [Dominus Rex v. Whiting] Salk. Rep. 283.

In this respect, no difference has ever yet been made between a man's property in his inventions and his other property; and there seems to be no reason or principle making a distinction.

The statute of Massachusetts securing copyrights (before the Federal Union) begins with a preamble declaring that "no property is more peculiarly a man's own than that which is produced by the labor of his mind." Cited 1 Dane's Abridg. 527.

In *Miller v. Taylor*, 4 Burr. 2303, seven judges against four held that at common law the author of a literary composition did not lose his right by publishing it.

So far, then, as the natural rights of men to this species of property, (copyright,) independently of statutory provisions, are in question, they retain all their rights to such property, notwithstanding the public have innocently got possession of it, and even with the author's consent; and there surely can be no difference, when we go back to natural rights at common law, whether the property is the subject of a copyright or of a patent—whether it be a book or a machine; the public, having got the use or possession, must have as much right to make copies of the book as of the machine: both are the produce of the mind. This view is taken merely to show that this species of property has been treated as subject to the same rules of law as other

Argument of counsel.

kinds of property—that is, except so far as the statute makes a difference. Now, it is admitted that, under the statute, neither the pirate, nor any one participating in his piracy, can acquire any rights against the inventor. And why? Because the same rules of justice which apply to all other kinds of property are applied by the courts to this, as being the intention of the statute, although against its letter. But why stop at the pirate, and say that you will not extend the rule to the public, when they have innocently got the possession? Do you stop thus as to other kinds of property? No. You say, no one, however innocent of fraud, can become the lawful proprietor. Why, then, not carry the principle to its full extent? How can it be inferred that the statute intends to go a part of the way of a general principle, and there stop? The principle is a rule drawn by analogy from other kinds of property, on the ground that the analogy being general, the rule should be so, too. But the analogy is also complete between this and other kinds of property, and the rule ought therefore to be complete, and applied in its full extent.

But there is even a stronger reason why this principle of law should be applied to this species of property in its full extent, rather than to the case of a *bona fide* purchaser of any other kind. There he has paid a consideration, an equivalent. It is a hard case: one of two innocent persons must suffer. Not so here. What does the public lose? That which has cost it nothing, for which it has given no equivalent; and all we seek of them is the consideration, the equivalent, which they have never yet paid to any one.

But if we examine the American cases on this subject prior to *Pennock v. Dialogue*, we shall find that the principle has always been applied to inventions in its full extent.

The counsel then proceeded to examine the following cases, and argued that they fully sustained the principles claimed for the plaintiff in error: *Whittemore v. Cutter*, 1 Gall. 482; *Goodyear v. Mathews*, 1 Paine's Rep. 301; *Morris v. Huntington*, 1 Paine, 354; *Mellus v. Silsbee*,

Argument of counsel.

4 Mason's Rep. 108 ; Treadwell v. Bladen, 4 Wash. C. C. R. 703.

The bill of exceptions says " that the plaintiff assigned as a reason for delaying to patent it, (the invention,) that it was not so perfect as he wished to make it before he introduced it to public use ; and that he did make alterations in his invention up to about the date of his patent, which some witnesses considered as improvements, and others did not."

This was sufficient to account for the delay ; and it is unimportant whether the alterations were improvements or not, for he was trying to make them, and said that was his motive for the delay ; and the *motive* for the delay is the only question. [Morris v. Huntington] 1 Paine's Rep. 354.

The patent granted to Forsyth, in England, which gave him the exclusive right to use the percussion powders in any mode, down to April, 1821, accounts for not taking out a patent in England.

Finally, the counsel for the plaintiff in error contended :

1. That if the rights of the patentee were the same as under an ordinary citizen's patent, then he had never dedicated or abandoned his invention to the public, and that there has been no use of it which invalidates his patent.

2. That his rights are the same as those under an ordinary citizen's patent, the patent having been granted under the citizen's act, and not being affected by the previous vacated patent.

3. That even if he is to be considered as having a patent under the alien act, his rights, under the circumstances of this case, are the same as if it was a citizen's patent.

In conclusion, he remarked that the jury found their verdict entirely under the charge of the court, considering that the charge, as to the points of law, precluded them from finding a verdict for the plaintiff, however well they might be satisfied upon every matter of fact. It was believed the jury, as well as the court, were entirely satisfied that the plaintiff was the inventor, and that his invention had been used without his knowledge or suspicion ; and

Argument of counsel.

that he had never disclosed it, except in confidence, and under the strictest injunctions of secrecy.

The letter from plaintiff to defendant should not have been put in the bill of exceptions, because it only presented questions of fact purely, not affecting any of the points of law on which the court charged the jury. This court will not regard a mere isolated fact, when it is apparent that all the facts of the case are not given, but only such as are essential to show how the jury were charged as to the law. It is impossible for this court to say how the jury would have found upon the whole evidence. It is sufficient to add that the meaning of that letter was satisfactorily explained to the jury by the plaintiff's counsel. It was explained that the knowledge of his invention, which the plaintiff in that letter says he communicated to "Manton and others," was simply the knowledge of the fact that he had made *an* important invention, *without disclosing what it was*. On any other supposition, this letter was contradicted by all the rest of the evidence in the case and the uniform conduct of the plaintiff.

Mr. Emmet, for the defendant in error.

The bill of exceptions in this cause discloses, in substance, the following case :

In 1813 or 1814, the plaintiff, residing in England, invented what he claims to be secured to him by his patent. Between that time and his coming to the United States he made his invention known to his brother, also to Mr. Manton, a gunmaker in London, and others, as is shown by his letter to defendant.

In 1817, the plaintiff came to the United States, and shortly afterward disclosed his secret to a gunmaker in Philadelphia.

In 1817 or 1818, plaintiff's brother sold the secret to a gunmaker in London.

In 1819, the invention was sold and used in England.

In 1820 or 1821, it was in general use by the public there.

In 1821, it was in general use in France.

Argument of counsel.

In 1822, (19th June,) plaintiff took out his first patent as an alien, under the act of 1800.

In 1829, (7th May,) he surrendered that patent as defective and took out a new one, with an amended specification, as a citizen, under the act of 1793, upon which patent his suit is brought.

The case also sets forth that, in April, 1807, a patent had been granted in England to one Forsyth for an invention on the same subject, and that such patent continued in force for fourteen years, or until April, 1821. This was offered by the plaintiff and made a part of the case, for the purpose, doubtless, of accounting for his not having taken out a patent for his invention in England previous to 1817, the terms of Forsyth's patent being, as he supposed, sufficiently comprehensive to embrace his discovery and to tie up his hands during its continuance.

From these facts, it would at least appear that the public had *somewhere* become fully possessed of the use of the invention, and that they had enjoyed such use for not less than about two years before the plaintiff took any steps to obtain his first patent.

Without stopping now to inquire what should be considered as *the public* in respect to a case of this kind, let us examine how far the acts of the plaintiff himself have precluded him from ever controverting the right of that public to the use of the thing in question.

The principle upon which *previous public use* of an invention invalidates a patent, undoubtedly, is, that the inventor can no longer give any *consideration* or *equivalent* for the exclusive privilege claimed by him; and the law, to sustain a principle so necessary and just in itself, presumes an *abandonment* by the inventor. This abandonment may be either *actual*, as by *voluntary dedication*, or *constructive*, as by *negligence* or *unreasonable delay*. [Goodyear v. Mathews] Paine's Rep. 300.

In the present case, can it be pretended that there was neither *negligence* nor *unreasonable delay*? The plaintiff would have it appear that, up to 1822, he was *maturing* his

Argument of counsel.

invention, and yet what he then took out a patent for was the *very thing*, and no improvement upon that, which for two or three years previous had been generally known and used in England and France. But admitting this explanation to stand for what it is worth, how does it tally with his other ground of excuse. He says Forsyth's patent restrained him in England. Be it so—and what is the fair inference? Why, that if it had not been for Forsyth's patent *he* would have applied there for one before 1817; and if he would, his invention *was matured* before he came to the United States; and nothing but his alienism stood in the way of his applying for a patent immediately after his arrival. Being an alien, the law required him to delay two years. In 1819, therefore, he might and ought to have taken out his patent; and if he had done so, he would have anticipated the *public use* of the invention in England and France. But he delayed until 1822, a period of three years. His own story shows that such delay was without sufficient cause. It was, therefore, *unreasonable*; and the law, in protection of the right acquired in the mean time by the public, construes his acts into an *abandonment*.

It would appear that, even to the mind of the plaintiff's counsel, this view of the case is conclusive, unless the fact of the invention having got into *public use* before the first patent was taken out, can be shaken; for they say that the use, in this case, was not an *American*, but a foreign use, and therefore not a use by the public who contest their exclusive right. This distinction is directly opposed to the act of 1800, which uses the language "known or used, in this or *any foreign country*"; and it is equally opposed to the intent and meaning of the act of 1793. We are perfectly willing to admit that, in this respect, the construction of both acts should be the same; and that the proviso at the end of the first section of the act of 1800 applies to *every patent*, whether obtained under *that* act or the act of 1793. In the words of Mr. Justice STORY, the act of 1800 affords, in this respect, a gloss or explanation of the original act. *Pennock v. Dialogue*, 2 Peters's S. C. Rep. 22. This only

Argument of counsel.

tends to show, that if the plaintiff had been a citizen in 1822, and had taken out his first patent under the act of 1793, his case would have been just as objectionable as it is now. But where do the plaintiff's counsel find any law for such a distinction between American and foreign *public use*, or how could it be sustained on principle? If the doctrine be a sound one, it would go to this extent: I dedicate my invention to the public in Europe; the European public being thus legally possessed of it, the article is manufactured and exported in large quantities; I immediately come over here, take out a patent, and prevent the use of the article in the United States, thereby prohibiting the European public from engaging in a traffic or commerce which was an immediate incident to my own grant or dedication to them.

The impolicy of recognizing such a distinction would afford a sufficient argument against it, even if the terms of the statute were not explicit, and if nothing had ever fallen from the bench to give a construction to the expression "public use." But there is positive and high authority on this subject. Lord Chief Justice GIBBS says, "to entitle a man to a patent, the invention must be *new to the world*." [Wood v. Zimmer] 1 Holt's N. P. Rep. 58 [1 Am. & Eng. 202]. And such, we submit, is the settled law on this point.

It would seem to be of little importance in this cause to discuss the plaintiff's position "that the second patent is original and independent, and not a continuation of the first patent," because the only object of disconnecting the two patents in this case would be to rescue the second patent from the operation of the act of 1800, under which the first patent was taken (the judge having charged the jury that the act of 1800 was sufficient to control the case). Now, we not only admit that the act of 1793 should receive a similar construction with that of 1800, as to *previous knowledge or use* of an invention, but the plaintiff's counsel labor to establish this very ground. Their position, however, is not a correct one. The object of cancelling a first patent, and taking out a second, is not to take a fresh start

Argument of counsel.

for the term of years during which the law allows the exclusive right to be conferred. It is to enable the inventor to enjoy, for the *remainder of that term*, the privilege which was *originally intended* to be granted. And in this view, even if the construction of the two acts was different, we apprehend that the judge laid down the law correctly, namely, that the plaintiff's rights depended upon the state of things in 1822, and upon the act of 1800.

It is only necessary to follow the plaintiff's argument on his third point, to perceive the impediment which the first section of the act of 1800, taken either in reference to that act only or as explanatory of the act of 1793, offers to his case. To get rid of this difficulty, it is, in substance, contended by his counsel that the legislature did not mean what they have said in this section, when certain cases came to be considered; and that the positive and unequivocal language used by them is, in this respect, unimportant. Now, the very fact that this section was intended to be *declaratory* of the law in all cases, whether arising under that or the former act of 1793, shows that the explicit language used was considered to be all-important by the legislature; and it certainly was not contemplated that this explicit language should be frittered away to suit particular cases.

If the facts of this case, as we have endeavored to show, make out a *negligence* or *unreasonable delay* on the part of the plaintiff in taking out his patent, and that such negligence or unreasonable delay amounts *in law* to an *abandonment*, the case is disposed of. We contend also that the delay was not accounted for, the alleged reason for it being virtually contradicted by the testimony offered to make out his case; and further, that the finding of the jury is conclusive as to this point.

The intent of the delay of the patent, and whether the allowing the invention to be used without a patent, should not be considered an abandonment, or a present of it to the public, are questions for the jury. *Morris v. Huntington*, 1 Paine's Rep. [348.]

Opinion of the court.

The principles which we contend for, being recognized in many of the cases cited on the part of the plaintiff, (particularly the case of *Pennock v. Dialogue*,) it has been deemed unnecessary to refer to those cases more particularly. If the charge of the judge was not erroneous as to the law, there can be no ground for granting a new trial.

Mr. Justice M'LEAN delivered the opinion of the court.

This writ of error brings before this court, for its revision, a judgment of the Circuit Court of the United States for the Southern District of New York.

An action was brought in the Circuit Court by Shaw against the defendant Cooper, for the violation of a certain patent-right claimed by the plaintiff. The defendant pleaded the general issue, and gave notice that on the trial he would prove "that the pretended new and useful improvement in guns and fire-arms mentioned and referred to in the several counts in the declaration, also that the said pretended new and useful improvement, or the essential parts or portions thereof, or some or one of them, had been known and used in this country, namely, in the city of New York and in the city of Philadelphia, and in sundry other places in the United States, and in England, in France, and in other foreign countries, before the plaintiff's application for a patent, as set forth in his declaration," &c.

On the trial, the following bill of exceptions was taken :
"To maintain the issue joined, the plaintiff gave in evidence certain letters patent of the United States, as set forth in the declaration, issued on the 7th day of May, 1829 ; and also that the improvement for which the letters were granted was invented or discovered by the plaintiffs in 1813 or 1814, and that the defendant had sold instruments which were infringements of the said letters patent.

"And the defendant then proved, by the testimony of one witness, that he had used the said improvement in England, and had purchased a gun of the kind there, and had seen others use the said improvement, and had seen guns of the kind in the Duke of York's armory in 1819 ; and

Opinion of the court.

also proved, by the testimony of five other witnesses, that, in 1820 and 1821, they worked in England at the business of making and repairing guns, and that the said improvement was generally used in England in those years, but that they had never seen guns of the kind prior to those years ; and also proved that, in the year 1821, it was used and known in France ; and also that the said improvement was generally known and used in the United States after the 19th day of June, 1822.

“ And the plaintiff, further to maintain the issue on his part, then gave in evidence that he, not being a worker in iron, in 1813 or 1814, employed his brother, in England, under strict injunctions of secrecy, to execute or fabricate the said improvement, for the purpose of making experiments ; and that the plaintiff afterward, in 1817, left England and came to reside in the United States ; and that after his departure from England, in 1817 or 1818, his said brother divulged the secret for a certain reward to an eminent gunmaker in London. That on the arrival of the plaintiff in this country, in 1817, he disclosed his said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same, and whom he wished to engage to join and assist him. That the plaintiff made this disclosure under injunctions of secrecy, claiming the improvement as his own, declaring that he should patent it. That the plaintiff treated his invention as a secret after his arrival in this country, often declaring that he should patent it ; and that this step was only delayed that he might make it more perfect before it was introduced into public use ; and that he did make alterations, which some witnesses considered improvements in his invention, and others did not. That in this country the invention was never known or used prior to the said 19th day of June, 1822 ; that on that day letters patent were issued to the plaintiff, being then an alien, and that he immediately brought his invention into public use. That afterward, and after suits had been brought for a violation of the said letters patent, the plain-

Opinion of the court.

tiff was advised to surrender them, on account of the specification being defective ; and that he did accordingly, on the 7th day of May, in the year 1829, surrender the same into the Department of the Secretary of State, and received the letters patent first above named.

“ And the plaintiff also gave in evidence, that prior to the 19th day of June, 1822, the principal importers of guns, from England, in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard anything of the said invention, or that the same was used or known in England, and that no guns of the kind were imported into this country until the years 1824 or 1825. And that letters patent were granted in England on the 11th day of April, 1807, to one Alexander J. Forsyth, for a method of discharging or giving fire to artillery and all other firearms, which method he describes in his specification as consisting in the ‘ use or application as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding without any actual fire being applied thereto, and merely by a blow, or by any sudden or strong pressure or friction, given or applied thereto, without extraordinary violence—that is to say, some one of the compounds of combustible matter, such as sulphur or sulphur and charcoal, with an oxmuriatic salt ; for example, the salt formed of dephlogisticated marine acid and potash, (or potasse,) which salt is otherwise called oxmuriate of potash, or such of the fulminating metallic compounds as may be used with safety ; for example, fulminating mercury, or of common gunpowder mixed in due quantity with any of the above-mentioned substances, or with any oxmuriatic salt, as aforesaid, or of suitable mixtures of any of the before-mentioned compounds ;’ and that the said letters patent continued in force for the period of fourteen years from the time of granting the same.”

And the defendant, further to maintain the issue on his part, gave in evidence a certain letter from the plaintiff to

Opinion of the court.

the defendant, dated in December, in the year 1824, from which the following is an extract :

“Some time since I stated that I had employed counsel respecting regular prosecutions for any trespass against my rights to the patent. I have at length obtained the opinion of Mr. Sergeant of this city, together with others eminent in the law, and that is, that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others, to whom I made my invention known, and also of the person whom I employed to make the lock at the time of invention ; for it appears very essential that I should prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful. It is, therefore, my intention to visit England in May next for this purpose. In the mean time, proceedings which have commenced here are suspended for the necessary time.”

And the court, on these facts, charged the jury that the patent of the 7th of May, 1829, having been issued, as appears by its recital, on the surrender and cancelment of the patent of the 19th day of June, in the year 1822, and being intended to correct a mistake or remedy a defect in the latter, it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in the year 1822, when the patent was first obtained.

That the plaintiff's case, therefore, came under the act passed the 17th day of April, 1800, extending the right of obtaining patents to aliens, by the first section of which the applicant is required to make oath that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know, in the year 1822, that the invention for which he was taking out a patent had, before that time, been in use in a foreign country ; but that his knowledge or ignorance on that subject was rendered immaterial by the concluding part of the section, which expressly declares that every patent obtained pursuant to that act for any invention which, it should afterward appear,

Opinion of the court.

had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States, and that if the invention was previously known in England or France it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case, but the court were of opinion that he had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent. That the use of the invention by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor ; and if, as appears from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient, in the opinion of the court, to invalidate the patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it.

Under this charge, the jury found a verdict for the defendant, on which a judgment was entered.

There is a general assignment of errors, which brings to the consideration of the court the principles of law which arise out of the facts of the case, as stated in the bill of exceptions.

It may be proper, in the first place, to inquire whether the letters patent which were obtained in 1829, on a surrender of the first patent, have relation to the emanation of the patent in 1822, or shall be considered as having been issued on an original application.

On the part of the plaintiff, it is contended that "the second patent is original and independent, and not a continuation of the first patent" ; that in adopting the policy of giving, for a term of years, exclusive rights to inventors in this country, we adopted at the same time the rules of the common law as applied to patents in England ; and that, by the rules of the common law, a patent, when de-

Opinion of the court.

fective, may be surrendered to the granting power, which vacates the right under it, and the king may grant the right *de novo*, either to the same or to any other person.

This being the effect of the surrender of a patent in England, it is insisted that the same consequence should follow a surrender in this country. On this subject, it is said that the decisions of the English courts are uniform, and that not even a *dictum* can be found that a second patent is a continuation of the first.

The counsel seems to consider this point of great importance, as the plaintiff was an alien when the first patent was obtained, but had become naturalized before the date of the second, and, consequently, that his rights under the second patent cannot be governed by the law applicable to aliens. As the inquiry on this head is whether the second patent has relation to the first, it is not necessary to look into the laws to ascertain the respective rights of aliens and citizens on this subject. In regard to the right of the patentee to surrender a defective patent and take out a new one, there can be no difference between a citizen and an alien.

That the holder of a defective patent may surrender it to the Department of State and obtain a new one which shall have relation to the emanation of the first, was decided by this court, at the last term, in the case of *Grant et al. v. Raymond*, 6 Peters, 22. The Chief Justice, in giving the opinion of the court, says: "But the new patent and the proceedings on which it issues have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and, if the new application is valid, the law must be considered as satisfied, if the machine was not known or used before that application."

As this decision must be considered as settling the construction of the patent laws on this point, it is conclusive in the present case; and it is, therefore, unnecessary to examine the argument of the plaintiff's counsel, which was designed to lead to a different conclusion.

Opinion of the court.

The second patent being a continuation of the first one, the rights of the plaintiff must be ascertained by the law under which the original application was made.

This law was passed on the 17th of April, 1800, and provides “that all and singular the rights and privileges given to citizens of the United States respecting patents for new inventions, &c., shall be extended to aliens, who, at the time of petitioning, shall have resided for two years within the United States, &c. : *Provided*, That every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation, before some person duly authorized to administer oaths, before such patent shall be granted, that such invention, art, or discovery hath not, to the best of his or her knowledge or belief, been known or used, either in this or any foreign country ; and that every patent which shall be obtained pursuant to this act for any invention, art, or discovery which, it shall afterward appear, had been known or used previous to such application for a patent, shall be utterly void.”

By the act of the 21st of February, 1793, which limits patent-rights to citizens, it is provided “that every person or persons, in his or their application for a patent, shall state that the machine, &c., was *not known or used* before such application.”

The sixth section of this act provides that a defendant, when prosecuted for a violation of a patent-right, may give in evidence, under a notice, among other matters, “that the thing secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person—in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.”

It would seem, from the above provisions, that citizens and aliens, as to patent-rights, are placed substantially upon the same ground. In either case, if the invention

Opinion of the court.

was known or used by the public before it was patented, the patent is void. In both cases the right must be tested by the same rule.

From the facts in the case, it appears that the plaintiff, while residing in England, in 1813 or 1814, invented the instrument secured by his patent; that, before he came to the United States, he made known his invention to his brother, to Mr. Manton, a gunmaker in London, and to others; that, shortly after he came to the United States, in 1817, he disclosed his invention to a gunmaker in Philadelphia, and that, in 1817 or 1818, the plaintiff's brother sold the invention to a gunmaker in London; that in 1819 the invention was sold and used in England; and that, in the two following years, it was in public use there, and in the latter year also in France; that on the 19th of June, 1822, his first patent was obtained.

It also appears that in April, 1807, a patent was granted in England to one Forsyth, for fourteen years, for an invention on the same subject. This fact was shown by the plaintiff, it is presumed, as a reason why he did not take out a patent in England.

The question arises, from these facts and others which belong to the case, whether there was such a use in the public, of this invention, at the date of the plaintiff's first patent, as to render it void.

By the plaintiff's counsel, it is insisted that if an invention has been pirated, or fraudulently divulged, the inventor cannot thereby lose his right to his own invention and property; and it makes no difference that the public have acquired the use of the invention without any participation in the fraud, unless the inventor has acquiesced in such use.

The right of the plaintiff to his invention is compared to his right to other property, which cannot be divested by fraud or violence; and the case of *Miller v. Taylor*, 4 Burr. 2303,—where seven judges against four held that, at common law, an author by publishing a literary composition does not abandon his right,—is referred to as illustrative of the principle.

Opinion of the court.

Several decisions by the Circuit Courts of the United States are cited to sustain the right of the plaintiff. In the case of *Whittemore v. Cutter*, 1 Gall. 482, the court say: "It will not protect the plaintiff's patent, that he was the inventor of the improvements, if he suffered them to be used freely and fully by the public at large for so many years, combined with all the usual machinery; for, in such case, he must be deemed to have made a gift of them to the public, as much as a person who voluntarily opens his land as a highway and suffers it to remain for a length of time devoted to public use."

In the case of *Goodyear v. Mathews*, 1 Paine's Rep. 301, the court, in substance, say "that if the plaintiff be the inventor, it is immaterial that the invention has been known and used for years before the application." And in the case of *Morris v. Huntington*, 1 Paine, 354, the court say that "no man is to be permitted to lie by for years, and then take out a patent. If he has been practising his invention with a view of improving it, and thereby rendering it a greater benefit to the public, before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury, what was the intent of the delay of the patent, and whether the allowing the invention to be used without a patent should not be considered an abandonment or present of it to the public."

This was a case where a second patent had been obtained, the first being defective, and this, it would seem, was deemed sufficient to protect the right of the plaintiff, though the public had been in possession of the invention for six years before the emanation of the second patent.

Of the same import are the cases cited from [*Mellus v. Silsbee*] 4 Mason, 108, and [*Conn. v. Penn.*] 4 Washington, 438 [*Treadwell v. Bladen, ibid.*], 703.

The question, what use in the public, before the application is made for a patent, shall make void the right of the patentee, was brought before this court by the case of *Penock & Sellers v. Dialogue*, reported in 2 Peters, 1. In this case, the court say that "it has not been, and indeed can-

Opinion of the court.

not be, denied that an inventor may abandon his invention and surrender or dedicate it to the public. This inchoate right thus gone, cannot afterward be resumed at his pleasure ; for when gifts are once made to the public in this way, they become absolute." And again, "if an invention is used by the public, with the consent of the inventor, at the time of his application for a patent, how can the court say that his case is nevertheless such as the act was intended to protect ? If such a public use is not a use within the meaning of the statute, how can the court extract the case from its operation, and support a patent, when the suggestions of the patentee were not true, and the conditions on which alone the grant was authorized do not exist ?"

"The true construction of the Patent Law is," the court say, "that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent."

In this case, it appeared that the thing invented had been in use by the public, with the consent of the inventors, and through which they derived a profit, for seven years before the emanation of a patent. And this use was held by the court to be an abandonment of the right by the patentees.

The policy of granting exclusive privileges in certain cases was deemed of so much importance, in a national point of view, that power was given to Congress in the Federal Constitution "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries."

This power was exercised by Congress in the passage of the acts which have been referred to ; and, from an examination of their various provisions, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest the exclusive right in the inventor only ; and that, on condition that his invention was neither known nor used by the public before his applica-

Opinion of the court.

tion for a patent. If such use or knowledge shall be proved to have existed prior to the application for the patent, the act of 1793 declares the patent void ; and, as has been already stated, the right of an alien is vacated in the same manner, by proving a foreign use or knowledge of his invention. That knowledge or use which would be fatal to the patent-right of a citizen, would be equally so to the right of an alien.

The knowledge or use spoken of in the act of 1793 could have referred to the public only, for the provision would be nugatory if it were applied to the inventor himself. He must necessarily have a perfect knowledge of the thing invented, and its use, before he can describe it, as by law he is required to do preparatory to the emanation of a patent. But there may be cases in which a knowledge of the invention may be surreptitiously obtained and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right to the public by the inventor, though an acquiescence on his part will lay the foundation for such a presumption.

In England, it has been decided that if an inventor shall suffer the thing invented to be sold and go into public use for four months, and, in a later case, for any period of time, before the date of his patent, it is utterly void.

In that country, the right emanates from the royal prerogative ; in this, it is founded exclusively on statutory provisions. But the policy in both governments is the same in granting the right and in fixing its limits.

Vigilance is necessary to entitle an individual to the privileges secured under the Patent Law. It is not enough that he should show his right by invention, but he must secure it in the mode required by law. And if the invention, through fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it.

The Patent Law was designed for the public benefit as well as for the benefit of inventors. For a valuable inven-

Opinion of the court.

tion, the public, on the inventor's complying with certain conditions, give him, for a limited period, the profits arising from the sale of the thing invented. This holds out an inducement for the exercise of genius and skill in making discoveries which may be useful to society and profitable to the discoverer. But it was not the intention of this law to take from the public that of which they were fairly in possession.

In the progress of society, the range of discoveries in the mechanic arts, in science, and in all things which promote the public convenience, as a matter of course, will be enlarged. This results from the aggregation of mind and the diversity of talents and pursuits which exist in every intelligent community. And it would be extremely impolitic to retard or embarrass this advance, by withdrawing from the public any useful invention or art, and making it a subject of private monopoly. Against this consequence, the legislature have carefully guarded, in the laws they have passed on the subject.

It is undoubtedly just that every discoverer should realize the benefits resulting from his discovery, for the period contemplated by law. But these can only be secured by a substantial compliance with every legal requisite. His exclusive right does not rest alone upon his discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed.

No matter by what means an invention may be communicated to the public before a patent is obtained, any acquiescence in the public use, by the inventor, will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor.

The invention passes into the possession of innocent persons who have no knowledge of the fraud, and, at a considerable expense, perhaps, they appropriate it to their own use. The inventor, or his agent, has full knowledge of these facts, but fails to assert his right. Shall he after-

Opinion of the court.

ward be permitted to assert it with effect? Is not this such evidence of acquiescence in the public use, on his part, as justly forfeits his right?

If an individual witness a sale and transfer of real estate, under certain circumstances, in which he has an equitable lien or interest, and does not make known this interest, he shall not afterward be permitted to assert it. On this principle it is that a discoverer abandons his right if, before the obtainment of his patent, his discovery goes into public use. His right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. Does this impose anything more than reasonable diligence on the inventor? And would anything short of this be just to the public?

The acquiescence of an inventor in the public use of his invention can in no case be presumed where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will, in general, be a fact for the jury. And if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use as forever afterward to prevent him from asserting it. After his right shall be perfected by a patent, no presumption arises against it from a subsequent use by the public.

When an inventor applies to the Department of State for a patent, he should state the facts truly; and, indeed, he is required to do so, under the solemn obligations of an oath. If his invention has been carried into public use by fraud, but for a series of months or years he has taken no steps to assert his right, would not this afford such evidence of acquiescence as to defeat his application, as effectually as if he failed to state that he was the original inventor? And the same evidence which should defeat his application for a patent would, at any subsequent period, be fatal to his right. The evidence he exhibits to the Department of State is not only *ex parte*, but interested; and the questions of fact are left open, to be controverted by any one who shall think proper to contest the right under the patent.

Opinion of the court.

A strict construction of the act, as it regards the public use of an invention, before it is patented, is not only required by its letter and spirit, but also by sound policy. A term of fourteen years was deemed sufficient for the enjoyment of an exclusive right of an invention by the inventor; but if he may delay an application for his patent at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him. A pretence of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of presumed acquiescence, where the public use is known, or might be known, to the inventor, is the only safe rule which can be adopted on this subject.

In the case under consideration, it appears the plaintiff came to this country, from England, in the year 1817, and, being an alien, he could not apply for a patent until he had remained in the country two years. There was no legal obstruction to his obtaining a patent in the year 1819; but it seems that he failed to apply for one until three years after he might have done so. Had he used proper diligence in this respect, his right might have been secured, as his invention was not sold in England until the year 1819. But in the two following years it is proved to have been in public use there, and in the latter year also in France.

Under such circumstances, can the plaintiff's right be sustained?

His counsel assigns as a reason for not making an earlier application, that he was endeavoring to make his invention more perfect; but it seems by this delay he was not enabled, essentially, to vary or improve it. The plan is substantially the same as was carried into public use, through the brother of the plaintiff, in England. Such an excuse, therefore, cannot avail the plaintiff. For three years, before the emanation of his patent, his invention was in public use, and he appears to have taken no step to assert his right. Indeed, he sets up, as a part of his case, the patent to Forsyth, as a reason why he did not apply for a patent in England.

Notes and Citations.

The Forsyth patent was dated six years before. Some of the decisions of the Circuit Courts which are referred to were overruled in the case of *Pennock & Sellers v. Dialogue*. They made the question of abandonment to turn upon the intention of the inventor. But such is not considered to be the true ground. Whatever may be the intention of the inventor, if he suffers his invention to go into public use, through any means whatsoever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right.

The judgment of the Circuit Court must be affirmed with costs.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel; on consideration whereof, it is adjudged and ordered by this court that the judgment of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

Notes :

1. See *Grant v. Raymond* [p. 245 *ante*, note 6].

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2. *Read v. Bowman*, 2 Wall. 591.

See *Grant v. Raymond* [note 6, p. 245 *ante*].

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3. Alien patentee. Act 1800, § 1; Act 1836, §§ 6 and 15; Act 1863, § 1; Act 1870, § 34; R. S., § 4886.
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Notes and Citations.

4. Act 1793, § 1.

See *Pennock v. Dialogue* [p. 217 *ante*, notes 5 and 10].

Presumption of abandonment.

Pennock v. Dialogue, 2 Pet. 1 [p. 217 *ante*].

Agawam Co. v. Jordan, 7 Wall. 583.

5. Acquiescence in Abandonment.

Pennock v. Dialogue, 2 Pet. 1 [p. 217 *ante*].

Fruit Jar Co. v. Wright, 94 U. S. 92.

Planing Machine Co. v. Keith, 101 U. S. 479.

Hall v. Macneale, 107 U. S. 90.

Hartshorn v. Saginaw Barrel Co., 119 U. S. 664.

7. Conclusiveness of grant.

Grant v. Raymond, 6 Pet. 218 [p. 245 *ante*, and note 4 to same].

Patent in suit :

No. . Shaw, J. June 19, 1822. Percussion gun. Re-issue, May 7, 1829.

Citations :

IN SUPREME COURT OF UNITED STATES :

McClurg v. Kingsland, 1843. 1 How. 202 ; Bk. 11, L. ed. 102 [p. 382 *post*].

Battin v. Taggert, 1854. 17 How. 74 ; Bk. 15, L. ed. 37.

Kendall v. Windsor, 1858. 21 How. 322 ; Bk. 16, L. ed. 165.

Read v. Bowman, 1864. 2 Wall. 591 ; Bk. 17, L. ed. 812.

Notes and Citations.

Elizabeth v. Paving Co., 1877. 97 U. S. 126 ; Bk. 24, L. ed. 1000, 1059.

Machine Co. v. Keith, 1879. 101 U. S. 479 ; Bk. 25, L. ed. 939.

Egbert v. Lippman, 1881. 104 U. S. 333 ; Bk. 26, L. ed. 755.

IN CIRCUIT COURTS :

Pierson v. Eagle Screw Co., June, 1844. 3 Story, 402 ; 2 Robb. 268.

Root v. Ball & Davis, July, 1846. 4 McLean, 177.

Allen v. Blunt, October, 1846. 2 Wood. & Minot, 121 ; 2 Robb. 530.

French v. Rogers, November, 1851. 1 Fish. 133.

Hunt v. Howe, February, 1855. 1 MacA.'s Pat. Cases, 366.

Mowry v. Barber, January, 1858. 1 MacA.'s Pat. Cases, 563.

Blackington v. Douglass, April, 1859. 1 MacA.'s Pat. Cases, 622.

Wickersham v. Singer, July, 1859. 1 MacA.'s Pat. Cases, 645.

Savary v. Lauth, August, 1859. 1 MacA.'s Pat. Cases, 691.

Marcy v. Trotter, April, 1860. Ms. D. C.

In re Ball, June, 1860. Ms. D. C.

In re O'Hara, November, 1860. Ms. D. C.

Lovering v. Ducher, May, 1861. Ms. D. C.

Silverthorne v. Mitchell, August, 1862. Ms. D. C.

Hussey v. Bradley, March, 1863. 5 Blatch. 134 ; 2 Fish. 362.

Carew v. Boston Elastic Fabric Co., March, 1871. 1 Holmes, 45.

Jones v. Sewall, April, 1873. 3 Cliff. 563.

Henry v. Providence Tool Co., October, 1878. 3 Ban. & Ard. 501 ; 14 O. G. 855.

The Driven-Well Cases, May, 1883. 16 Fed. Rep. 387.

Davis v. Fredericks, January, 1884. 21 Blatch. 556 ; 19 Fed. Rep. 99 ; 17 Rep. 102.

Notes and Citations.

IN OPINIONS OF ATTORNEY-GENERAL.

Goulding's Case, August, 1833. 2 Opinions of A. G. U. S., p. 572 (Taney).

IN DECISIONS OF COMMISSIONER OF PATENTS :

Gray v. Hale, May, 1871. C. D., 1871, p. 129.

Carroll v. Morse, February, 1876. 9 O. G. 453.

Ex parte Baldwin, March, 1876. 9 O. G. 639.

Ex parte Derby, March, 1884. 26 O. G. 1208.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 62, 183, 204, 215, 340.

Curt. on Pats., 4th ed., §§ 381, 382, 383, 384, 385, 387, 391, 448.

Merwin on Pat. Invt., 1883, p. 700.

Walker on Pats., 1883, p. 69.

Syllabus.

THE PHILADELPHIA AND TRENTON RAILROAD
COMPANY, PLAINTIFFS IN ERROR, v. JAMES
STIMPSON, DEFENDANT IN ERROR. ALSO CALLED
RAILROAD CO. v. STIMPSON.

14 Pet. 448-468. Jan., 1840.

[Bk. 10, L. ed. 536 ; 2 Robb. 46 ; 1 Whit. 292.]

Grant of patent prima facie evidence. Recitals of prerequisites. Statutory notice of special matter. Inventor's declarations in patent. Evidence of date of invention. Practice as to order of introducing evidence.

1. The grant of a patent by a public officer upon evidence and proofs laid before him, and on which he is to decide and act, is *prima facie* evidence of the regularity and sufficiency of the proofs, the sufficiency of which is not re-examinable (p. 338).
2. A reissue granted in compliance with Act 1832, § 3, upon compliance with the conditions prescribed by Act 1793, § 3, requires no recitals that the prerequisites of the grant have been duly complied with (p. 339).
3. Based on patentee's oath, the patent is *prima facie* evidence that he is the inventor (p. 339).
4. The burden of proof is on defendant to show the service of the statutory notice of special matter, required by Act 1836, § 15, before introducing witness to prove the alleged prior use (p. 339).
5. Where evidence is offered for a certain purpose, it cannot be deserted for that purpose, to show its relevancy to another purpose, not at that time suggested to the court (p. 341).
6. A party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination (p. 342).
7. Parol evidence bearing upon written contracts or papers ought not to be admitted without the production of such written contracts or papers (p. 343).

Statement of the case.

8. The conversations and declarations of the inventor, stating that he had made an invention, describing its details and operation, are part of the *res gestæ* and legitimate evidence to prove the date of invention as early as at that period (p. 344).
9. Evidence of want of identity, a material difference between the original and reissued patents, offered by defendants after stating in open court that they had closed their evidence and plaintiffs had discharged their witnesses ; if a matter in the sound discretion of the court, *held* properly rejected (p. 345).
10. The mode of conducting trials, the order of introducing evidence, and the times when it is introduced, belong to the practice of the Circuit Courts, with which this Court ought not to interfere, unless it shall choose to prescribe general rules on the subject (p. 345).

IN error from the Circuit Court of the United States for the Eastern District of Pennsylvania.

At the April session of the Circuit Court, James Stimpson instituted an action against the plaintiffs in error, for the recovery of damages for the violation of a patent granted to him by the United States, on the 26th day of September, 1835, for "a new and useful improvement in the mode of turning short curves on railroads."

The case was tried on the 16th day of February, 1839, and a verdict was rendered for the plaintiff, for the sum of four thousand two hundred and fifty dollars. On the 6th of May, 1839, a remittitur was entered on the docket of the court, for the sum of one thousand dollars ; and a judgment was entered for the plaintiff for three thousand two hundred and fifty dollars.

On the trial of the cause, the defendants tendered a bill of exceptions to the decisions of the court, on their admitting the patent to the plaintiff in evidence, and to other rulings of the court in the course of the trial. The defendants prosecuted this writ of error.

The patent granted by the United States to James Stimpson was as follows :

"The United States of America to all to whom these letters patent shall come :

Statement of the case.

“Whereas, James Stimpson, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the mode of turning short curves on railroads, for which letters patent were granted the twenty-third day of August, 1831, which letters being hereby cancelled on account of a defective specification, which improvement, he states, has not been known or used before his application, hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement, hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are, therefore, to grant, according to law, to the said James Stimpson, his heirs, administrators, or assigns, for the term of fourteen years from the twenty-third day of August, 1831, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said James Stimpson himself, in the schedule hereto annexed.”

Tested at Washington, under the seal of the United States, on the 26th day of September, 1836, by the President of the United States, and certified in the usual form by the Attorney-General of the United States.

“The schedule referred to in these letters patent, and making a part of the same,” contained “a description, in the words of the said James Stimpson himself, of his improvement in the mode of turning short curves on railroads, for which letters patent were granted, dated the twenty-third day of August, 1831, which letters patent being hereby cancelled on account of a defective specification.”

The specification describes the invention with minute particularity, and concludes: “What I claim as my invention or improvement, is the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon

Statement of the case.

railways, particularly such as turning the corners of streets, wharves, &c., in cities and elsewhere, operating upon the principle herein set forth."

The bill of exceptions stated that the counsel for the plaintiff offered in evidence the patent and specification, to the admission of which in evidence the counsel for the defendant objected; but the objection was overruled by the court, and the evidence was admitted.

2. The defendants offered to give in evidence, by Josiah White, the description of a flange upon one side of the railroad cars, and the running upon the tread of the wheel upon the other side, with the flange in a groove, for the turning of curves, which he had seen in use before the date of plaintiff's patent—which was objected to by the counsel for the plaintiff, and the objection sustained by the court. The objection of the counsel for the plaintiff to the introduction of the testimony of Josiah White, was founded on the absence of the notice required by the act of Congress, of the use of the machine at Mauch Chunk, at which place, it was said, his testimony would show it had been used.

3. The third exception was to the refusal of the court to allow the defendants to introduce proof of the conversation between the patentee and the counsel of the Baltimore and Ohio Railroad Company, while an arrangement of a suit against a company was made, as to the character and effects of the arrangements.

4. The counsel for the plaintiff, by rebutting evidence, to extend his claim to the invention prior to the time at which the defendants had proved the reduction of the same into use and practice by others, offered to give evidence by witnesses of the conversations of the patentee on the subject of his invention at an anterior period—which conversations were intended to show the making of the invention by the patentee before and at the period when the same took place. The counsel for the defendants objected to the admission of this testimony; but the court overruled the objection.

5. The fifth exception was to the refusal of the court to

Argument of counsel.

admit the examination of Dr. Thos. P. Jones. The plaintiff had discharged his witnesses, on the declaration of the defendants' counsel that they had closed their evidence. The testimony asked from Dr. Jones was to new facts. The court refused to admit the testimony, on the ground that the testimony was improper, and that it was offered too late.

The case was argued by *Mr. Cox* and *Mr. Southard*, for the plaintiffs in error ; and by *Mr. J. R. Ingersoll*, for the defendant.

Mr. Cox and *Mr. Southard*, on the first exception.

The patent should not have been admitted in evidence. On its face, it is inoperative and invalid. It is not a patent under the act of Congress of 1793 ; but it purports to be a substituted patent for one which had been surrendered. It gives to the patentee the same privileges as those which were given by the first patent. It, therefore, should be in strict and exact conformity with the law of 1793 as well as with the subsequent act of Congress, authorizing the surrender of a patent for an imperfect specification, and the issue of another.

The act of 21st February, 1793, requires, by its third section, that the applicant shall be the true inventor of the machine, &c. This is made a *sine qua non* to the granting the patent, and the oath of the claimant is required to this fact. This provision makes the oath necessary, before the Secretary of State has authority to grant the patent. There is no remedy, if this has been omitted.

There was no decision before the case of *Morris v. Huntington*, Paine's Reps. 348, which affirmed the right of a patentee to surrender his patent for an erroneous or imperfect specification. After this case, Congress authorized such a surrender. Act of Congress of July 3, 1832. By this act, the cause of the surrender must be made out to the satisfaction of the Secretary of State, when a second patent is asked for. It has been decided, that a patent is

Argument of counsel.

prima facie evidence of the statements on the face of the patent. This does not give any other validity to those statements ; and it is not sufficient that some of the requirements of the act of Congress are stated. All must be set forth, and an averment must be made that everything has been done. There is no halting point. Those requirements exist as to any patent granted after the surrender of a patent. The errors or imperfections in the specification, on which the surrender has been made, should be stated. *Grant v. Raymond*, 6 Peters, 218. In the case cited, there was a recital of the surrender of the patent, and the cause of its surrender.

There is in the patent which was before the Circuit Court no recital of the imperfections of the first specification,—no allegation that there was no fraud in the transaction. There is nothing shown but the gratuitous act of the officer in granting the second patent. And yet all the prerequisites to the granting of a second patent should appear in it as well as be of record in the Patent Office.

Without these essential features in a patent given on the surrender of a previous one for the same invention, it cannot be read in evidence to a jury. The requirements in both the acts of Congress of 1792 and 1832, must appear in it. If all those matters are not shown, the second patent stands as a new patent ; and by allowing it to be given in evidence, the court altogether disregard the law. If the patent, in this imperfect form, is admitted as *prima facie* proof, all the burden of contradicting it is thrown on the opposite party. Cited on these points *Shaw v. Cooper*, 7 Peters, 245 [p. 286, *ante*].

In support of the second exception, the counsel contended that the notice given was sufficient to authorize the introduction of the testimony of Josiah White. Cited on this point *Evans v. Eaton*, Peters' C. C. R. 322 ; *Wheat. Rep. S. C.* The notice would have been sufficient under the act of Congress of 1793 ; and why not under the act of July 3, 1836 ?

The objection to the introduction of the evidence by the

Argument of counsel.

counsel for the defendants, which was sustained by the court, and which is the subject of the defendant's third exception, was well taken. It was in the power of the plaintiff to have produced his contract with the Baltimore and Ohio Railroad Company, and have rendered this evidence unnecessary. He did not do so.

As to the fourth exception. It is admitted that it was the right of the plaintiff to prove, by legal rebutting evidence, that the invention made by him, and for which he held the patent, was in use before the period in which the defendant had proved the invention by him. But this evidence could not be given by showing the conversations of the plaintiff on the subject of the invention before the date of the first patent.

Conversations on the subject of an invention are not the invention; nor are the ideas of the invention its actual development. There must be an application of the thought in the construction of the machine.

This is an attempt to give the declarations of a party in evidence after the actual occurrence of the transaction. No declaration of a person, that he intended to take out a patent, could be given in evidence. Cited on this point [Martin v. Hunter's Lessee] 1 Wheat. Rep. 313; [Reigart v. Ellmaker] 10 Serg. & Rawle, 27; [McPeake v. Hutchinson] 5 Serg. & Rawle, 295; Roscoe on Evidence, 21; [Wilson v. Graham] 4 Wash. C. C. R. 58; [Sherwood v. Sutton] 5 Mason, 6; [Woodcock v. Parker] 1 Gallis. C. C. R. 438.

As to the fifth exception, the counsel contended that the evidence of Dr. Jones was rebutting evidence, and was regular, as it was offered to meet and disprove the plaintiff's declarations, which the court had admitted as testimony.

Mr. Ingersoll, for the defendant in error.

1. The objection to the certificate of the Secretary of State should apply rather to the effect than the admissibility of the document. That officer is authorized by law to issue patents, and the presumption is that he has done

Argument of counsel.

so rightfully. Possession of the document does not affect the intrinsic rights of any one. Every question of merit is still open. It enables the patentee to sue, but it neither secures him in the enjoyment of the alleged invention, nor precludes others from contesting the validity of his claims. In the different cases cited, the patent appears to have been received in evidence exactly in the form now exhibited, although it may have availed nothing to the plaintiff afterward.

Sullivan v. Redfield, 1 Paine, 447 : "The patent is *prima facie* evidence of the right." The Margareta, 2 Gall. 519 ; Remission, though not valid, was given in evidence. See also Bingham v. Cabot, 3 Dall. 19 ; Bell v. Morrison, 1 Peters, 355 ; Keene v. Meade, 3 Peters, 6 ; The United States v. Liddle, 2 Wash. C. C. Rep. 205.

2. The testimony of Josiah White would have been admitted under the sixth section of the law of 1793. But the fifteenth, or corresponding section of the law of 1836, requires notice of place, person, and residence. As the law previously stood, great injustice might have been done, unless the court had construed it so as to invest the judge with power to prevent the plaintiff from being taken by surprise. Evans v. Eaton, 3 Wheat. 505. The law now wisely anticipates the necessity for an exercise of judicial discretion and possible delay ; and requires notice of the place where the improvement is supposed by a defendant to have been previously used. This was not given, and the testimony was necessarily rejected.

3. Although, in truth, the offer to examine Mr. Latrobe upon certain points was not rejected by the court, but withdrawn by the counsel, yet, as it appears by the record to have been a point decided, I will submit to treat it accordingly. The testimony would no doubt have been rejected if the offer had been persisted in, and the delay that would be requisite to put the record right would be deeply injurious to my client.

(1.) The inquiries suggested for the witness are impracticable, and they lead to impracticable results. The inquiry

Argument of counsel.

refers to a "negotiation," "arrangement," and "settlement." It asserts the fact that a "grant" or "contract" was made. Negotiation is the necessary preliminary to a contract, is absorbed in it, and forms a part of it. How can you separate them? Out of one identified existence, two things are to be made, essentially distinct from each other. That is impossible.

(2.) The inquiries are irrelative. The arrangement contemplated was *res inter alios acta*. The plaintiffs in error were altogether strangers to it. Many inducements may lead to a settlement with one person which would not render it desirable with another. If it were not that Ross Winans had previously been cross-examined by the counsel for the plaintiffs in the Circuit Court, to the point of settlement with the Baltimore and Ohio Company, no pretence for the inquiry would exist. If that was wrong, this will not make it right. It was not objected to. If not strictly cross-examination, we had no right to resort to it. *Ellmaker v. Buckley*, 16 Serg. & Rawle. If it was regular cross-examination, it cannot justify the proposed irregularity. But we were bound to put the witness on his guard as to a collateral fact which might impeach his testimony. Rule in the Queen's case.

(3.) The object attempted to be proved was a mere entity; an abstraction; nothing actually done, but at best something omitted or avoided; a conclusion or construction; a contingency without a substantial thing to support it.

(4.) It was an attempt to prove by parol some known written arrangement which was susceptible of being produced.

4. Explanations of the patentee himself were good evidence to prove the genuineness of his claims to originality. It is necessary to understand the manner in which this testimony was produced. Plaintiff at first simply produced his patent, and called a witness who proved its utility and infringement by the defendants. Then the defendants went at large into proof of alleged priority of the invention by other persons. All of this went to show a use before

Argument of counsel.

the date of the plaintiff's patent. A necessity was therefore thrown upon him of proving that his invention existed, and was communicated by him to different persons at a still earlier period. No doubt of the importance of such proof. It consisted of evidence of plaintiff's invention prior to the defendants' knowledge, or the knowledge of those persons on whom they relied. To meet this particular exigency, that is, to show invention, it is difficult to conceive what can be authentic, except what comes from the inventor himself. He therefore produced several individuals, who stated that he described the improvement to them at a period considerably earlier than defendants had fixed for its earliest use. If he described it, he must have known it. If he knew it before any other person, he must have invented it. That prior knowledge was invention; and that was the very thing to be proved.

Two objections were taken to the character of the proof: 1. That it was derived from the plaintiff himself. 2. That the alleged improvement was not then brought into practical use by him.

Answer 1st. It was an invention, else not patentable; in other words, it must spring from himself. An exhibition of it must necessarily, in some shape or other, be his act. Whatever might be said or done by others, could not be available to him. The exhibition might be effected by deed, signs, or words. It matters not in what particular manner the effect is produced, but the discovery must make manifest its paternity; and it can do so only through the medium of its proper parent.

This may be done by his works—a machine constructed. Let it be produced; original, practical, perfect in all its parts. Nothing is gained by the author, unless something more than all this appears, namely, authorship. However eloquent the machine may be as to its uses, it cannot speak for itself as to its author. The nearest it can come to speech would be an inscription or label on its front: "J. S., fecit," for example.

That would at best be a written declaration. What

Argument of counsel.

difference would it make that the writing, or stamping, or printing should be in a book? That description of evidence, in a sister department of the law, is conclusive of important rights. It maintaining copyrights, the writing of the party is the essence of the discovery, and the sole proof of invention or originality. If, instead of writing with his own hand, the same author dictates to another person, cannot the amanuensis prove the dictation, and hence the authorship? A blind author has often given to the world the result of his genius, through the pen of another. On a question of authorship, surely the testimony of the scribe would be received as competent.

Another species of proof of invention remains, namely, oral explanation alone. Why may it not be received? It is the very thing itself. To speak it, was to create it, if it did not already exist in thought; and if it did, it must prove it. The proof was given to counteract the allegation of earlier discovery. It produces the effect by showing that the earlier discoverers, as they are regarded, received from the plaintiff the information which enabled them to put the invention in use, and then attempt to deny the right of showing how the information was communicated and obtained. One of the very pieces of testimony objected to, consisted of a conversation with the person who claimed to be an inventor in preference to the plaintiff.

The declarations did not stand alone; they were accompanied by two drawings and a model. The date of the existence of these monuments is clearly proved. The conversations became but a part of the *res gestæ*.

There are many occasions on which one's own sayings and doings are good evidence; in some instances the best, and in others the only evidence. The present is an anomaly, unless it concurs. It does not follow that the expressions of an individual are the illegal creation of testimony for himself. Such are—1. Various kinds of declarations *ante litem motam*. 2. When the sayings are the doings, as in cases of notice. 3. Where the expressions of an individual are the test of a given state of things, as intellect. 4. Proof

Argument of counsel.

of a contract, as marriage, by words *de presenti*. 5. Almost any other discovery or invention, not connected with the useful arts. A reward is offered for lost property ; the finder informs of the finding of it ; the declarations can be proved.

Answer 2d. As to the objection that the explanations were not reduced to practice. Here, too, the objection loses sight of the fact that our evidence was not original, but merely designed to meet a collateral issued as to the period of invention, and not exactly as to invention itself. On any ground, however, the question of invention does not depend upon whether the thing has been reduced to practice, but whether it can be,—not whether it is actually practised, but practicable. Drawings, descriptions, and models are sent to the Patent Office. These are miniature likenesses,—not the thing itself. Any other course would, in many instances, be quite impracticable. A ship, a house, a town are often the recipients of an improvement which cannot be practically exhibited, except in connection with the vast object to which it is applied. Sometimes the reducing to practice might be destructive of life or property. A guillotine need not be rehearsed in order to prove its power.

Besides, it might destroy the very intention, to insist on practical exercise. It might be regarded as giving the invention to the public, and then the patent-right is gone forever.

5. Thomas P. Jones was called by the defendants, after all the testimony in chief, on both sides, and the plaintiff's rebutting testimony also had been given, and his witnesses dismissed ; and much time had been occupied in giving rebutting testimony for the defendants. The declared object was to prove that the invention described in the plaintiff's patent of 1835 was different from the invention described by him in his patent of 1831—in other words, that the patent which purported to be a mere correction of form was, in substance, a totally different thing. We are struck at once with an inconsistency between this point

Argument of counsel.

and the whole tenor of the defendants' case. The notice which they gave, the aim of their evidence, their great design, is to show that the thing relied on by the plaintiff, which was patented by him in 1835, was well known and used in 1831—known to everybody, publicly, notoriously. Yet we are now told that it was not known even to the plaintiff himself, but that he found it necessary, four years afterward, to desert the alleged invention of 1831, and surreptitiously to foist in a different thing, which then became known to him for the first time. Unless this is the true meaning of the point, it has none.

The evidence offered was original and direct. It contradicted nothing already asserted in evidence. It was directed to a point in no way collateral. It went immediately to the essential merits of the case. It was of great importance, undoubtedly. Nothing could be more conclusive against the plaintiff. Not only would it be destructive of his claim to originality, but it would prove a most audacious fraud, abortively attempted, and calculated, when detected, to deprive him of all standing in or out of court, and to render his defeat as disgraceful as it was inevitable.

Notice of all this ought to have been given, perhaps. It is not urged, however, as an argument, that none was received, although it might have been calculated to take the plaintiff by surprise. But it was a fact above all others requiring, and in its nature admitting of, countervailing proof. Not a clerk in the office, probably, could have failed to give material testimony in reply. These persons were at a distance; and we should have been left to the question of probability whether a man, in any extremity of impudent fraud, would have ventured to place two totally different patents side by side in the office, asserting that they were in substance identical.

The evidence offered was not the best the nature of the case admitted of. Contradiction was to be proved between two written instruments, with, perhaps, a model accompanying each of them. Copies would be the proper sources

Opinion of the court.

of illustration. Were copies not accessible? We do not know. No inquiry was made. A thousand copies may have been made before the Patent Office was destroyed. Plaintiff himself, no doubt, had such copies in his possession. No notice was given to him to produce them, before this violent attempt was made to introduce the secondary evidence.

To get rid of all this, the argument was, that the difference was only to be inferred between the patents from a difference between the conversation and one of them. But that would rebut nothing. No person denied that plaintiff's conversations with the witnesses he produced were as they were sworn to be. Other conversations with other persons might show descriptions of other inventions; but they could not possibly show that the first conversations did not take place. The judge gave two reasons for rejecting the testimony. One was, that it was offered at too late a stage of the cause. That was ruled in his sound discretion. From the exercise of that discretion there is no appeal. No attempt was made to take one. On both of his grounds he was right. But one was sufficient to cover the whole question, and it is inaccessible to review here.

Mr. Justice STORY delivered the opinion of the court.

This is a writ of error to the judgment of the Circuit Court for the Eastern District of Pennsylvania, rendered in an action brought by Stimpson, the defendant in error, against the plaintiffs in error, for a violation of a patent-right granted to him for a new and useful improvement in the mode of turning short curves on railroads.

A patent was originally granted to Stimpson, for the same invention, on the 23d day of August, 1831, and the renewed patent, upon which the present suit is brought, was granted on the 26th of September, 1835, upon the former letters patent "being cancelled on account of a defective specification;" and the renewed patent was for the term of fourteen years from the date of the original patent. With the exception of the recital of the fact that

Opinion of the court.

the former letters patent were cancelled "on account of a defective specification," and the statement of the prior date from which the renewed patent was to begin to run, the renewed patent is in the precise form in which the original patents are granted.

At the trial upon the general issue, a bill of exceptions was taken to certain rulings of the court upon points of evidence, to the consideration of which we shall at once proceed, without any further preface.

The first exception taken is to the admission of the renewed patent as evidence in the cause to the jury. The Patent Act of 1832, ch. 162, sec. 3, under which this patent was obtained, provides, that whenever any patent shall be inoperative or invalid, by reason that any of the terms or conditions prescribed by the prior acts of Congress have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, upon his compliance with the terms and conditions prescribed by the third section of the act of the 21st of February, 1792, ch. 55.

Now, the objection is, that the present patent does not contain any recitals that the prerequisites thus stated in the act have been complied with, namely, that the error in the former patent has arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention; and that without such recitals, as it is the case of a special authority, the patent is a mere nullity, and inoperative. We are of opinion that the objection cannot, in point of law, be maintained. The patent was issued under the great seal of the United States, and is signed by the President, and countersigned by the Secretary of State. It is a presumption of law, that all public officers, and especially such high functionaries, perform their proper official duties, until the contrary is proved. And where, as in the present

Opinion of the court.

case, an act is to be done or patent granted upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act or granted the patent is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to re-examine or controvert the sufficiency of such proofs, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency. It is not, then, necessary for the patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption; and if, indeed, it were otherwise, the recitals would not help the case, without the auxiliary proof that these prerequisites had been *de facto* complied with. This has been the uniform construction, as far as we know, in all our courts of justice, upon matters of this sort. Patents for lands, equally with patents for inventions, have been deemed *prima facie* evidence that they were regularly granted, whenever they have been produced under the great seal of the government, without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly observed. In cases of patents, the courts of the United States have gone one step further, and as the patentee is required to make oath that he is the true inventor before he can obtain a patent, the patent has been deemed *prima facie* evidence that he has made the invention. This objection, then, is overruled; and there was no error in the Circuit Court in the admission of the patent.

The next exception is to the refusal of the court to allow a witness, Josiah White, to give a description of an invention which he had seen on the Mauch Chunk Railroad, in 1827, which had a groove on one side, and run on the other on a flange for crossing, for the purpose of showing that the supposed invention of the plaintiff was known and in use by others before the date of his patent. By the Patent Act of 1836, (which was applicable to the present point,) it is provided, in the fifteenth section, that whenever the

Opinion of the court.

defendant relies, in his defence, on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter to be used in his defence, the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used. The object of this most salutary provision, is to prevent patentees being surprised, at the trial of the cause, by evidence of a nature which they could not be presumed to know or be prepared to meet, and thereby to subject them either to most extensive delays or to a loss of their cause. It is incumbent on those who seek to show that the examination of a witness has been improperly rejected, to establish their right to have the evidence admitted ; for the court will be presumed to have acted correctly, until the contrary is established.

In the present case, there is no proof on the record that notice had been given, according to the requirements of the statute, that White was to be a witness for the purpose above stated. Unless such notice was given, it is plain that the examination could not be rightfully had. The *onus probandi* is on the defendants to show it, and unless they produce the notice, the objection must fail. In point of fact, it was admitted by counsel, at the argument, that no such notice was given. In either view, then, from the admission, or from the defect of the preliminary proof of notice in the record, the exception is not maintainable.

The next exception is to the refusal of the court to allow certain questions to be put by the defendants to John H. B. Latrobe, a witness introduced by the defendants to maintain the issue on their part. Latrobe, on his examination, stated : “ I know Mr. Stimpson by sight and character. He granted to the Baltimore and Ohio Railroad Company the privilege of using the curved ways on their railroad, and all lateral roads connected therewith. I fix the date of the contract in the early part of October, 1834, because I have then a receipt of Mr. Stimpson’s counsel for two thousand five hundred dollars. Mr. Stimpson laid his claim against the Baltimore Company for an infringement

Opinion of the court.

of his patent in 1832. It was referred to me by the company, and I advised them." The counsel for the defendants then offered to prove, by the same witness, the declarations of the plaintiff and his agent to the witness, that the settlement made with the Baltimore and Ohio Railroad Company with the plaintiff was not an admission by the said company of the plaintiff's right in the alleged invention, but a mere compromise of a pending suit, disconnected with a grant, in writing, made by the plaintiff to the said company; and to that end proposed to put the following questions, respectively, and in order, to the witness: "1. Do you know who was the agent or attorney of James Stimpson, in negotiating the arrangement and settlement between him and the company referred to? Who was he? 2. State if any conversations occurred between James Stimpson, or his agent or counsel, at any time during the negotiations, regarding the rights claimed by him in the patent for curved ways, without reference to the existence of a written contract or its contents. 3. What were they?" The court refused to allow these questions to be put, for the purpose aforesaid.

Now, (as has been already intimated,) it is incumbent upon those who insist upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them; and they are not afterward at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose not then suggested to the court. It was not pretended, at the argument, that the evidence so offered was good evidence in chief, in behalf of the defendants, upon the issue in the cause. It was *res inter alios acta*, and had no tendency to disprove the defendant's title to the invention, or to support any title set up by the defendants; for no privity was shown between the defendants and the Baltimore Company. As evidence in chief, therefore, it was irrelevant and inadmissible. The sole purpose for which it was offered, so far as it was then declared to the court, was to show that the

Opinion of the court.

compromise with the Baltimore Company was not founded on any admission of the plaintiff's right in the invention. Be it so ; it was then inconsequential, for it certainly had no just tendency to disprove his right. If the compromise had been offered on the part of the plaintiff, for the purpose of establishing his right to the invention, there is no pretence to say that it would have been admissible against the defendants. In the converse case, it is equally inadmissible for the defendants.

But it is now said that the evidence was, in fact, offered for the purpose of rebutting or explaining certain statements made by one Ross Winans, a witness called by the defendants, in his answers upon his cross-examination by the plaintiff's counsel. Now, this purpose is not necessarily, or even naturally, suggested by the purpose avowed in the record. Upon his cross-examination, Winans stated : "I understood there were arrangements made with the Baltimore Company. I heard the company paid five thousand dollars." Now, certainly these statements, if objected to by the defendants, would have been inadmissible upon two distinct grounds : 1. First, as mere hearsay ; 2. And, secondly, upon the broader principle, now well established, although sometimes lost sight of in our loose practice at trials, that a party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him to other matters, he must do so by making the witness his own, and calling him, as such, in the subsequent progress of the cause. The question then is presented, whether a party can, by his own omission to take an objection to the admission of improper evidence brought out on a cross-examination, found a right to introduce testimony in chief to rebut it or explain it. If, upon the cross-examination, Winans' answer had been such as was unfavorable to the plaintiff, upon the collateral matters thus asked, which were not founded in the issue, he would have been bound by it, and not permitted to introduce evidence to contradict it. There is great difficulty in say-

Opinion of the court.

ing that the defendants ought to be in a more favored predicament, and to acquire rights founded upon the like evidence to which they did not choose to make any objection, although otherwise it could not have been in the cause. But waiving this consideration, the grounds on which we think the refusal of the court was right, are, first, that it was not distinctly propounded to the court, that the evidence was offered to rebut or explain Winans' testimony; and, secondly, that in the form in which it was put, it proposed to separate the written contract of compromise from the conversations and the negotiations which led to it, and to introduce the latter without the former, although it might turn out that the written paper might most materially affect or control the presumptions deducible from those conversations and negotiations. We think that, upon the settled principles of law, parol evidence bearing upon written contracts and papers ought not to be admitted without the production of such written contracts or papers, so as to enable both the court and the jury to see whether or not the admission of the parol evidence in any manner will trench upon the rule, that parol evidence is not admissible to vary or contradict written contracts or papers.

The next exception is to the admission of the evidence of William A. Stimpson, Richard Caton, and George Neilson, as to certain declarations, and statements, and conversations of the plaintiff, as to his invention prior to the date of his original patent, in order to rebut the evidence of the defendants, as to the invention or use by other persons of the same contrivance before that date. The objection is, that, upon general principles, the declarations and conversations of a plaintiff are not admissible evidence in favor of his own rights. As a general rule, this is undoubtedly true. It is, however, but a general rule, and admits and requires various exceptions. There are many cases in which a party may show his declarations conflict with acts in his own favor, as a part of the *res gestæ*. There are other cases, again, in which his material declarations have been admitted. Thus, for example, in the case of an action

Opinion of the court.

for an assault and battery, and wounding, it has been held that the declarations of the plaintiff, as to his internal pains, aches, injuries, and symptoms, to the physician called to prescribe for him, are admissible for the purpose of showing the nature and extent of the injuries done to him. See 1 Phillips on Evidence, ch. 12, sec. 1, pp. 200-202, 8th ed., 1838. In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the particular invention. The invention itself is an intellectual process, or operation, and, like all other expressions of thought, can in many cases scarcely be made known except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month, or even a year, before it can be embodied in any visible form, machine, or composition of matter. It might take a year to construct a steamboat, after the inventor had completely mastered all the details of his invention, and had fully explained them to all the various artisans whom he might employ to construct the different parts of the machinery. And yet, from those very details and explanations, another ingenious mechanic might be able to construct the whole apparatus, and assume to himself the priority of the invention. The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor, to the extent of the facts and details which he then makes known, although not of their existence at an antecedent time. In short, such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him; and thus its origin may be fixed at least as early as that period. This view of the subject covers all the parts of the testimony of the wit-

Opinion of the court.

nesses objected to in the Circuit Court, and we are of opinion that the court were right in admitting the evidence.

The next and the last exception, is to the rejection of the evidence of Dr. Jones, who was offered to prove that there were material differences between the patent of 1831 and the renewed patent of 1835, and to explain these differences. No doubt can be entertained that the testimony thus offered was, or might be, most material to the merits of the defence. And the question is not as to the competency or relevancy of the evidence, but as to the propriety of its being admitted at the time when it was offered. It appears that the testimony was not offered by the defendants, or stated by them, as a matter of defence, in the stage of the cause when it is usually introduced according to the practice of the court. It was offered, after the defendants' counsel had stated, in open court, that they had closed their evidence, and after the plaintiff, in consequence of that declaration, had discharged his own witnesses: The question, then, is, whether it was at that time admissible on the part of the defendants, as a matter of right, or whether its admission was a matter resting in the sound discretion of the court. If the latter, then it is manifest that the rejection of it cannot be assigned as error.

The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are, properly, matters belonging to the practice of the Circuit Courts, with which this court ought not to interfere, unless it shall choose to prescribe some fixed general rules on the subject, under the authority of the act of Congress. Probably, the practice in no two States in the Union is exactly the same; and, therefore, in each State the Circuit Courts must necessarily be vested with a large discretion, in the regulation of their practice. If every party had a right to introduce evidence, at any time, at his own election, without reference to the stage of the trial on which it is offered, it is obvious that the proceedings of the court would often be greatly embarrassed, the purposes of justice be obstructed, and the parties themselves be surprised by evi-

Notes and Citations.

dence destructive of their rights, which they could not have foreseen, or in any manner have guarded against. It seems to us, therefore, that all courts ought to be, as indeed they generally are, invested with a large discretion on this subject, to prevent the most mischievous consequences in the administration of justice to suitors ; and we think that the Circuit Courts possess this discretion in as ample a manner as other judicial tribunals. We do not feel at liberty, therefore, to interfere with the exercise of this discretion ; and, indeed, if we were called upon to say, upon the present record, whether this discretion was, in fact, misapplied or not, we should be prepared to say that we see no reason to doubt that it was, under all the circumstances, wisely and properly exercised. It is sufficient for us, however, that it was a matter of discretion and practice, in respect to which we possess no authority to revise the decision of the Circuit Court.

Upon the whole, we are of opinion that the judgment of the Circuit Court ought to be

AFFIRMED WITH COSTS.

Notes :1. Patent is *prima facie* evidence of inventorship.

Blanchard v. Putnam, 8 Wall. 420.

Seymour v. Osborne, 11 Wall. 516.

Mitchell v. Tilghman, 19 Wall. 287.

Smith v. Goodyear D. V. Co., 93 U. S. 486.

Roemer v. Simon, 95 U. S. 214.

Bates v. Coe, 98 U. S. 31.

Date of invention :

Bates v. Coe, 98 U. S. 31.

Of novelty :

Corning v. Burden, 15 How. 252.

Mitchell v. Tilghman, 19 Wall. 287.

Cantrell v. Wallick, 117 U. S. 689.

Of utility :

Corning v. Burden, 15 How. 252.

Preliminaries re-examinable :

Grant v. Raymond, 6 Pet. 218 [p. 245 ante].

Notes and Citations.

Shaw v. Cooper, 7 Pet. 292 [p. 286 *ante*].

And see note 4 under Grant v. Raymond [p. 245 *ante*].

2. Recitals in patent.

Hogg v. Emerson, 6 How. 437.

3. See note 1 *ante*.

4. Burden of proving statutory notice.

Blanchard v. Putnam, 8 Wall. 420.

Act 1790, § 6 ; Act 1793, § 6 ; Act 1836, § 15 ; Act
1870, § 61 ; R. S., § 4920.

And see note 7, Evans v. Eaton [p. 84 *ante*].

Patent in suit:

No. . Stimpson, J. September 26, 1835. Curves for
Railways.

OTHER SUITS ON SAME PATENT :

Stimpson v. The Railroads, 1847. 1 Wall., Jr. 164 ; 2 Robb. 595.

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- Cocke v. Halsey*, 1842. 16 Pet. 71 ; Bk. 10, L. ed. 891.
Grignon v. Astor, 1844. 2 How. 319 ; Bk. 11, L. ed. 283.
Johnston v. Jones, 1861. 1 Black. 209 ; Bk. 17, L. ed. 117.
Houghton v. Jones, 1863. 1 Wall. 702 ; Bk. 17, L. ed. 503.
United States v. Speed, 1868. 8 Wall. 77 ; Bk. 19, L. ed. 449.
Blanchard v. Putnam, 1869. 8 Wall. 420 ; Bk. 19, L. ed. 433.
Miller v. United States, 1870. 11 Wall. 268 ; Bk. 20, L. ed. 135.
Seymour v. Osborne, 1870. 11 Wall. 516 ; Bk. 20, L. ed. 33.
Mitchell v. Tilghman, 1873. 19 Wall. 287 ; Bk. 22, L. ed. 125.
First Unitarian Soc. v. Faulkner, 1875. 91 U. S. 415 ; Bk. 23,
 L. ed. 283.
Wills v. Russell, 1879. 100 U. S. 621 ; Bk. 25, L. ed. 607.
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- United States v. Dickinson*, December, 1840. 2 McLean, 325.
Allen v. Blunt, October, 1846. 2 Wood. & Minot, 121 ; 2 Robb.
 530.
Wilder v. McCormick, November, 1846. 2 Blatch. 31 ; Fish. Pat.
 Rep. 128.
Carr v. Gale, 1847. 2 Ware, 330.
United States v. Morris, October, 1851. 1 Curtis, 23.
Young v. Colt, May, 1852. 2 Blatch. 373.
Yearsley v. Brookfield, March, 1853. 1 MacA.'s Pat. Cases, 193.
Richardson v. Hicks, September, 1854. 1 MacA.'s Pat. Cases, 335.
Stephens v. Salisbury, May, 1855. 1 MacA.'s Pat. Cases, 379.
Davidson v. Lewis, October, 1858. 1 MacA.'s Pat. Cases, 599.
Cahoon v. Ring, May, 1861. 1 Cliff. 592.
Hussey v. Bradley, March, 1863. 5 Blatch. 134 ; 2 Fish. 362.
Goodyear v. Providence Rubber Co., November, 1864. 2 Cliff.
 351 ; 2 Fish. 499.
Hoffheins v. Brandt, July, 1867. 3 Fish. 218.
Blake v. Stafford, September, 1867. 6 Blatch. 195 ; 3 Fish. 294.
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 1867. 2 Ben. 63.

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 Crompton v. Belknap Mills, May, 1869. 3 Fish. 536.
 Salisbury v. Sands, 1871. 2 Dill. 270.
 Parham v. Am. Buttonhole Overseaming and Sewing Machine Co.,
 April, 1871. 4 Fish. 468 ; 1 Leg. Gaz. Rep. 145.
 Roberts v. Dickey, May, 1871. 4 Brewster, 260 ; 1 O. G. 4 ;
 4 Fish. 532 ; 3 Pittsb. Rep. 252.
 Tilghman v. Mitchell, August, 1871. 9 Blatch. 18 ; 4 Fish. 615.
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 Gear v. Grosvenor, March, 1873. 1 Holmes, 215 ; 6 Fish. 314 ;
 3 O. G. 380.
 The Dorsey Harvester Revol.-Rake Co. v. Marsh & Co., April, 1873.
 9 Phila. R. 395 ; 6 Fish. 387.
 Starr v. Stark, May, 1874. 2 Sawyer, 603.
 Conklin and Stafford, March, 1874. 1 MacArthur, 375 ; 5 O. G.
 235.
 Thomas v. Shoe Machinery M'f'g Co., October, 1878. 3 Ban. &
 Ard. 557.
 Dederick v. Cassell, October, 1881. 9 Fed. Rep. 306 ; 20 O. G.
 1233 ; 14 Phila. R. 503 ; Leg. Int., Vol. 38, p. 414.
 Allis v. Buckstaff, October, 1882. 13 Fed. Rep. 879 ; 22 O. G.
 1705.
 Spaeth v. Barney, January, 1885. 22 Fed. Rep. 828 ; 30 O. G.
 997 ; 19 Rep. 324.

IN DECISIONS OF COMMISSIONER OF PATENTS :

Little v. Lillie, Pillard & Sargent, September, 1876. 10 O. G. 543.
 Huntley v. Smith, September, 1880. 18 O. G. 795.

Notes and Citations.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 26, 201, 449, 455, 467.

Curt. on Pats., 4th ed., §§ 282, 285, 351, note, 362, 364, 369, 370, note, 471*a*, 472, 475, note.

Merwin on Pat. Invt., 1883, p. 27.

Walker on Pats., 1883, pp. 156, 383.

Statement of the case.

DAVID PROUTY AND JOHN MEARS, PLAINTIFFS
IN ERROR, *v.* DRAPER RUGGLES *et al.*, DE-
FENDANTS IN ERROR.

16 Pet. 336-341. Jan., 1842.

[Bk. 10, L. ed. 985 ; 2 Robb. 93 ; 1 Whit. 811.]

Affirming *ibid.*, 1 Story, 568.

Combination. Infringement. Particular patent construed.

1. Patent granted Prouty & Mears, March 4, 1836, for a plough, construed to be for a combination of three old elements, and held not infringed by the omission of one of the elements (p. 358).
2. A combination of several elements is not infringed by the use of less than all of the elements, or by a substitution for an omitted element, of one substantially different in form or manner of arrangement and connection (p. 358).

IN error to the Circuit Court of the United States for the District of Massachusetts.

The plaintiffs in error instituted a suit in the Circuit Court of Massachusetts, for the recovery of damages for the violation of a patent, granted to them by the United States, for a new and useful improvement in the construction of a plough.

The cause was tried before a jury, at October sessions of the Circuit Court, in 1841, and a verdict and judgment were rendered for the defendant. The plaintiffs took exceptions to the charge of the court, and prosecuted this writ of error.

The case was submitted to the court, on printed arguments, by *Mr. Choate*, for the plaintiffs in error, and by *Mr. Dexter*, for the defendants. The case was fully stated in the opinion of the court.

Opinion of the court.

Mr. Chief Justice TANEY delivered the opinion of the court.

This case is brought here by a writ of error to the Circuit Court of the United States for the District of Massachusetts.

The action was instituted for the purpose of recovering damages for an infringement of a patent which the plaintiffs had obtained for an improvement in the construction of the plough.

The invention is described in the specification as follows :

“ Be it known, that we, the said Prouty and Mears, have jointly invented, made, and applied to use a new and useful improvement in the construction of the plough, which invention and improvement we describe and specify as follows, namely :

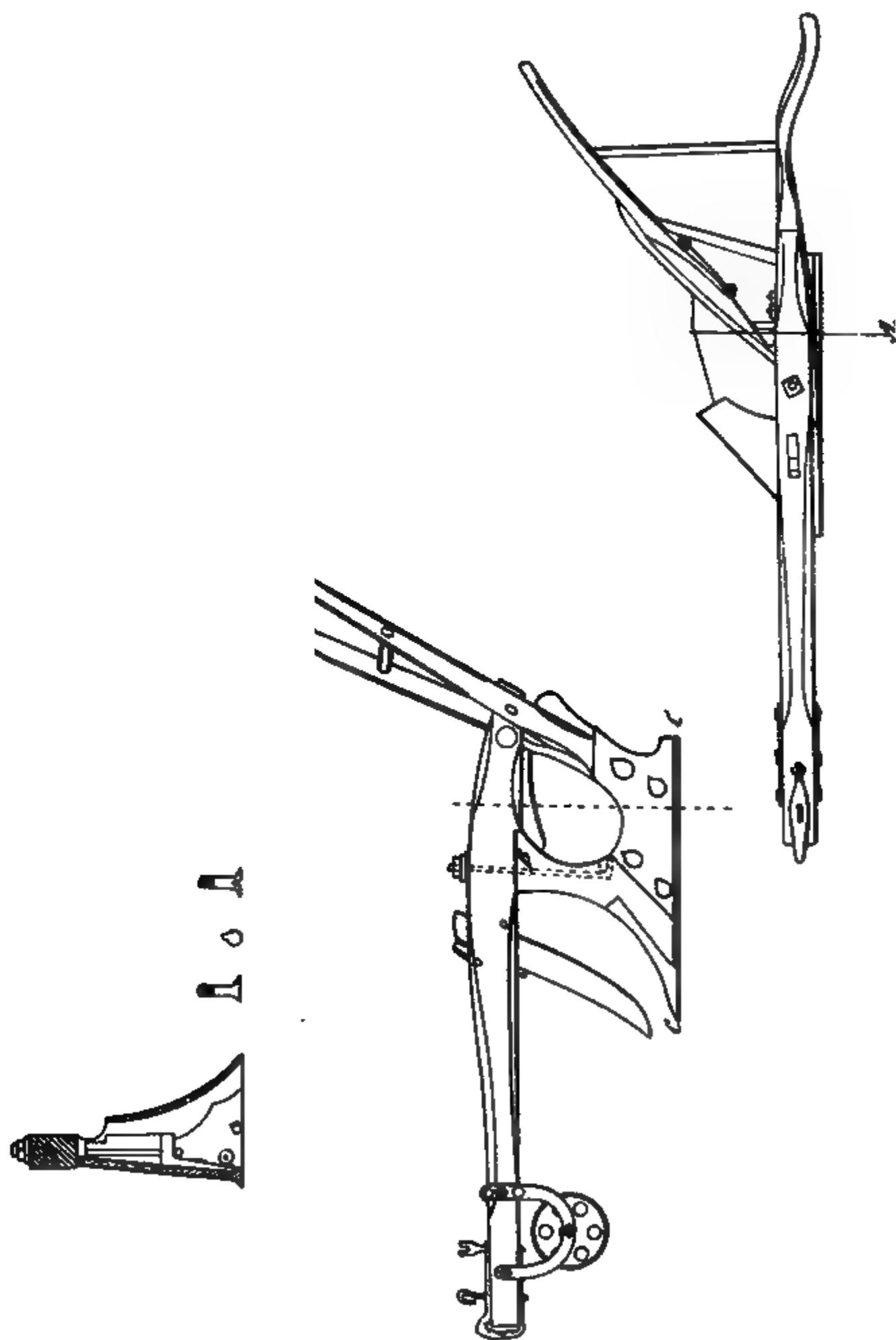
“ Heretofore, the standard and landside of the plough has been placed perpendicular to and at right angles with the plane of the share ; on this standard, the beam has been placed in such manner as to form an acute angle with the landside, of such extent as to place that part of the beam to which the moving power is applied at a distance of three or more inches from an extended line of the landside to the right, while the after-part of the beam extends one or more inches to the left of the perpendicular of the landside, near the handle ; the object has been to cause the plough ‘ to run to land,’ or hold its width of furrow. The effect produced has been an uneasy, struggling motion, as it meets resistance at the point, wing, or heel.

“ We make our plough with the standard and landside forming an acute angle with the plane of the share, the standard inclining to the right or furrow side in such manner as to enable us to place the centre of the beam on a line parallel with the landside, the fore-part thereof at such a distance from the extended line aforesaid as to cause the plough to hold its width of furrow, and the after-part falling within the perpendicular of the landside of the plough, the centre of it being nearly perpendicular to the centre of resistance, on the mould-board, which we conceive to be at

Prosser & Mears.

Plow.

Patented Mar. 4, 1836.



Opinion of the court.

about one-fourth part of the lateral distance from the land-side to the wing of the share, and at about one-third part of the perpendicular height from the plane of the share to the upper edge of the mould-board.

“ This location of the centre of resistance, we base on the fact that many ploughs, which have been used in sharp, sandy soils, have been worn quite through at that point. The result of this formation of the plough is a steady, well-balanced motion, requiring less power of draft and less effort in directing the plough in its course.

“ The inclination of the standard and landside causes the plough to cut under and take up the furrow in the form of an oblique-angled parallelogram, or like a board feather-edged, which, being turned over, falls on a level with the last furrow more readily than right-angled or square-edged work.

“ The coulter, or knife, having a similar inclination, cuts the roots of the grass, &c., and leaves all vegetable matter on the surface, at a greater distance from the under edge of the furrow, which, being turned over, more readily falls in, and is far better covered than with the square-edged work.

“ The top of the standard, through which the bolt passes to secure the beam, is transversely parallel to the plane of the share, and extends back from the bolt to such a distance as to form a brace to the beam, when the after-part is passed down by lifting at the fore-part; the share being fast under a rock, or other obstruction, the after-part of this extension is squared in such manner, that, being jogged into the beam, it relieves the bolt in heavy draft.

“ The bolts which we use to fasten the pieces of cast-iron, of which our ploughs are made, together, and the wood-work, are round, with inverted convex heads, like the wood-screw, with a projection on the under side of the head of semicircular form, which fits into a groove in the countersink part of the bolt-hole, as it is cast to receive it, which not only prevents its turning, but also diminishes the liability of breakage at the corners of square holes—all

Opinion of the court.

which will more fully appear by reference to the drawing annexed to and forming part of this specification.

“ We hereby declare that what we claim as new, and of our invention, is the construction of such ploughs as aforesaid, and the several parts thereof, not separately, but in combination, for the purposes aforesaid, namely :

“ 1. The inclining the standard and landside so as to form an acute angle with the plane of the share.

“ 2. The placing the beam on a line parallel to the landside, within the body of the plough and its centre, nearly in the perpendicular of the centre of resistance.

“ 3. The forming the top of the standard for brace and draft. We do not intend to confine our claim to any particular form or construction, excepting such form as may be necessary to place the beam in the perpendicular of the centre of resistance, and parallel to the landside, and also to such form of the top of the standard as shall serve for brace and draft, but have given such form as we deem to be most convenient, which may be varied, as is obvious.”

The plaintiffs offered to prove the utility of the alleged improvement, which proof was dispensed with by the defendants. Certain ploughs, alleged by the plaintiffs to be made in conformity with their letters patent, and certain ploughs made by the defendants, which were the alleged infringement of the plaintiffs' patent, were produced in court; and no substantial difference between them was shown by the defendants to exist, unless the fact that the top of the standard in the defendants' plough was not jogged into the beam, and did not extend so far back upon the beam, was to be so considered.

And the plaintiffs offered evidence to show that the top of the standard formed, as stated in the specification, would serve for both purposes of brace and draft, although not jogged into the beam.

The defendants introduced no evidence. The counsel for the plaintiffs requested the court to instruct the jury as follows, to wit :

The counsel of plaintiffs respectfully move the court to

Opinion of the court.

instruct the jury, that if the defendants have used, in combination with the other two parts, a standard of the description set forth in the specification, and it is proved to serve both for brace and draft, such use was an infringement of the plaintiffs' claim in that particular, although the defendants may not have inserted it into a jog in the beam.

Also, that if any two of the three parts described as composing the construction claimed in the specification, had been used in combination by the defendants, it was an infringement of the patent, although the third had not been used with them.

The court refused to give the instructions so prayed, or either of them, in manner and form as prayed by the plaintiffs; but did instruct the jury as follows, to wit:

That upon the true construction of the patent, it is for a combination, and for a combination only. That the combination, as stated in the summing up, consists of three things, namely:

1. The inclining the standard and landside so as to form an acute angle with the plane of the share.

2. The placing the beam on a line parallel to the landside, within the body of the plough and its centre, nearly in the perpendicular of the centre of resistance.

3. The forming the top of the standard for brace and draft.

That unless it is proved that the whole combination is substantially used in the defendants' ploughs, it is not a violation of the plaintiffs' patent, although one or more of the parts specified as aforesaid may be used in combination by the defendants. And that the plaintiffs, by their specification and summing up, have treated the jogging of the standard behind, as well as the extension, to be essential parts of their combination for the purpose of brace and draft; and that the use of either alone by the defendants would not be an infringement of the combination patented.

And thereupon the jury rendered their verdict for the defendants.

Opinion of the court.

The first question presented by the exception is, whether the extension of the standard, and the jogging of it into the beam, are claimed as material parts of the plaintiffs' improvement. We think they are. In the paragraph in which it is described, he states that it "extends back from the bolt to such a distance as to form a brace to the beam ;" and also "that, being jogged into the beam, it relieves the bolt in a heavy draft." And in their summing up, they declare that they claim as new, and of their invention, the construction of such ploughs as aforesaid, and the several parts thereof, not separately, but in combination ; and proceeding then to specify the parts so claimed, they mentioned "the forming of the top of the standard for brace and draft." They, indeed, say that they do not mean to confine their claim to any particular form of construction, except "to such form of the top as shall serve for brace and draft." That is to say, the top is to be so formed and so connected with the beam as to answer both purposes. And as those purposes, according to the preceding part of the specification, are to be accomplished by its extension back from the bolt, and by jogging it into the beam, these two things are essential to it, whatever variation may be made in its shape or size. They are, therefore, material parts of the improvement they claim.

The remaining question may be disposed of in a few words. The patent is for a combination, and the improvement consists in arranging different portions of the plough, and combining them together in the manner stated in the specification, for the purpose of producing a certain effect. None of the parts referred to are new, and none are claimed as new ; nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. And this combination, composed of all the parts mentioned in the specification, and arranged with reference to each other and to other parts of the plough in the manner therein described, is stated to be the improve-

Notes and Citations.

ment, and is the thing patented. The use of any two of these parts only, or of two combined with a third which is substantially different in form or manner of its arrangement and connection with the others, is therefore not the thing patented. It is not the same combination if it substantially differs from it in any of its parts. The jogging of the standard into the beam, and its extension backward from the bolt, are both treated by the plaintiffs as essential parts of their combination for the purpose of brace and draft. Consequently, the use of either alone, by the defendants, would not be the same improvement, nor infringe the patent of the plaintiffs.

The judgment of the Circuit Court must therefore be

AFFIRMED.

Notes :

1. A combination not infringed by use of less than all its parts—by omission of an element.

Stimpson *v.* Railroad Co., 10 How. 329 [p. 398 *post*].

Silsby *v.* Foote, 20 How. 378.

McCormick *v.* Talcott, 20 How. 402.

Eames *v.* Godfrey, 1 Wall. 78.

Gould *v.* Rees, 15 Wall. 187.

Dunbar *v.* Myers, 94 U. S. 187.

Schumacher *v.* Cornell, 96 U. S. 549.

Water Meter Co. *v.* Desper, 101 U. S. 332.

Wicke *v.* Ostrum, 103 U. S. 461.

Gage *v.* Herring, 107 U. S. 640.

Rowell *v.* Lindsay, 113 U. S. 97.

Blake *v.* City of San Francisco, 113 U. S. 679.

Not infringed by substitution of new element :

Brooks *v.* Fiske, 15 How. 212.

Gould *v.* Rees, 15 Wall. 187.

Notes and Citations.

Fuller *v.* Yentzer, 94 U. S. 299.

McMurray *v.* Mallory, 111 U. S. 97.

Signal Co. *v.* Hall R. R., 114 U. S. 87.

Sharp *v.* Reissner, 119 U. S. 631.

Not infringed by different device :

Wollensak *v.* Reiher, 115 U. S. 87.

Field *v.* De Comeau, 116 U. S. 187.

Shepard *v.* Carrigan, 116 U. S. 593.

Yale Lock Co. *v.* Sargent, 117 U. S. 373.

Infringed by substitution of known equivalent :

Imhauser *v.* Buerk, 101 U. S. 647.

Rowell *v.* Lindsay, 113 U. S. 97.

Infringed by sale of part with intent to procure infringement
(license to use once only) :

Cotton Tie Co. *v.* Simmons, 106 U. S. 89.

Notes and Citations.

Patent in suit:

No. . Prouty & Mears. March 4, 1836. Plough.

OTHER SUITS ON SAME PATENT :

Prouty *v.* Ruggles, 1842. 1 Story, 568 ; 2 Robb. 75.

Citations :

IN SUPREME COURT OF UNITED STATES :

Stimpson *v.* Railroad Co., 1850. 10 How. 329 ; Bk. 13, L. ed. 441.

Eames *v.* Godfrey, 1863. 1 Wall. 78 ; Bk. 17, L. ed. 547.

Stimpson *v.* Woodman, Diss. opin., 1869. 10 Wall. 117 ; Bk. 19, L. ed. 866.

Seymour *v.* Osborne, 1870. 11 Wall. 516 ; Bk. 20, L. ed. 33.

Gould *v.* Rees, 1871. 15 Wall. 187 ; Bk. 21, L. ed. 39.

Gill *v.* Wells, 1874. 22 Wall. 1 ; Bk. 22, L. ed. 699.

Corn-Planter Patent, 1874. 23 Wall. 181 ; Bk. 23, L. ed. 161.

Reedy *v.* Scott, 1874. 23 Wall. 352 ; Bk. 23, L. ed. 109.

Dunbar *v.* Myers, 1876. 94 U. S. 187 ; Bk. 24, L. ed. 34.

Fuller *v.* Yentzer, 1876. 94 U. S. 288 ; Bk. 24, L. ed. 103, 107.

Cochrane *v.* Deener, Diss. opin., 1877. 94 U. S. 780 ; Bk. 24, L. ed. 139.

Bantz *v.* Frantz, 1882. 105 U. S. 160 ; Bk. 26, L. ed. 1013.

Gage *v.* Herring, 1883. 107 U. S. 640 ; Bk. 27, L. ed. 601.

Rowell *v.* Lindsay, 1885. 113 U. S. 97 ; Bk. 28, L. ed. 906.

Voss *v.* Fisher, 1885. 113 U. S. 213 ; Bk. 28, L. ed. 975.

Blake *v.* San Francisco, 1885. 113 U. S. 679 ; Bk. 28, L. ed. 1070.

Electric Signal Co. *v.* Hall Signal Co., 1885. 114 U. S. 87 ; Bk. 29, L. ed. 96.

Notes and Citations.

IN CIRCUIT COURTS :

Hovey *v.* Stevens, October, 1846. 3 Wood. & Minot, 17 ; 2 Robb. 567.

Aiken *v.* Bemis, October, 1847. 3 Wood. & Minot, 348 ; 2 Robb. 644.

Olcott *v.* Hawkins, 1849. 2 Am. L. J. (9 Penn. L. J.) 317.

Many *v.* Sizer, June, 1849. 1 Fish. 31.

Smith *v.* Downing, June, 1850. 1 Fish. 64.

In re Boughton, January, 1854. 1 MacA.'s Pat. Cases, 278.

Singer *v.* Walmsley, February, 1860. 1 Fish. 558.

In re Smith, December, 1860. Ms. D. C.

In re Larrowe, Ms. D. C.

Hale *v.* Stimpson, October, 1865. 2 Fish. 565.

Mabie *v.* Haskell, October, 1865. 2 Cliff. 507.

Nicholson Pavement Co. *v.* Hatch, October, 1868. 4 Sawyer, 692 ; 3 Fish. 432.

Crompton *v.* Belknap Mills, May, 1869. 3 Fish. 536.

Am. Nicolson Pavement Co. *v.* City of Elizabeth, June, 1870. 4 Fish. 189.

Wallace & Sons *v.* Holmes, Booth & Haydens, September, 1871. 9 Blatch. 65 ; 1 O. G. 117 ; 5 Fish. 37.

Waterbury Brass Co. *v.* Miller, September, 1871. 9 Blatch. 77 ; 5 Fish. 48.

Wells *v.* Jacques, February, 1874. 1 Ban. & Ard. 60 ; 5 O. G. 364.

Craig *v.* Smith, October, 1874. 4 Dill. 349 ; 1 Ban. & Ard. 556 ; 2 Cent. L. J. 256.

Saxe *v.* Hammond, January, 1875. 1 Holmes, 456 ; 1 Ban. & Ard. 629 ; 7 O. G. 781.

Storrs *v.* Howe *et al.*, September, 1876. 4 Cliff. 388 ; 2 Ban. & Ard. 420 ; 10 O. G. 421.

Sanford *v.* Merrimack Hat Co., September, 1876. 4 Cliff. 404 ; 2 Ban. & Ard. 408 ; 10 O. G. 466.

Herring *v.* Nelson, September, 1877. 14 Blatch. 293 ; 3 Ban. & Ard. 55 ; 12 O. G. 753.

Burdett *v.* Estey, March, 1879. 16 Blatch. 105 ; 4 Ban & Ard. 141.

Sharp *v.* Tifft, May, 1880. 18 Blatch. 132 ; 5 Ban. & Ard. 399 ; 2 Fed. Rep. 697 ; 17 O. G. 1282.

Am. Diam. Rock Boring Co. *v.* Sutherland Falls Marble Co., May,

Notes and Citations.

1880. '18 Blatch. 148 ; 5 Ban. & Ard. 347 ; 2 Fed. Rep. 353 ;
10 Rep. 9.
- Holly *v.* Vergennes Machine Co., October, 1880. 18 Blatch. 327 ;
4 Fed. Rep. 74 ; 18 O. G. 1177 ; 11 Rep. 364.
- Rowell *v.* Lindsay, 1881. 10 Biss. 217 ; 6 Fed. Rep. 290 ; 19
O. G. 1565.
- Millner *v.* Schofield & Co., June, 1881. 4 Hughes, 258.
- Cross *v.* Livermore, November, 1881. 9 Fed. Rep. 607 ; 21 O. G.
139.
- Washburn & Moen M'f'g Co. *v.* Griesche, June, 1883. 16 Fed.
Rep. 669.
- Travers *v.* Palmer, April, 1885. 23 Fed. Rep. 511 ; 31 O. G. 382.

IN TEXT-BOOKS :

- 2 Abb. Pat. Law, 1886, p. 251.
- Curt. on Pats., 4th ed., §§ 249, 332.
- Walker on Pats., 1883, pp. 77, 252, 257, 258, 264, 369.
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Statement of the case.

ELEAZER CARVER v. JOSEPH A. HYDE *et al.*

16 Pet. 513-520. Jan., 1842.

[Bk. 10, L. ed. 1051 ; 1 Whit. 316 ; Fish. Pat. Rep. 20.]

Particular patent construed. Infringement. Result. Patent-ability.

1. A patentee cannot reject as unessential and as not of the essence of his invention part of matter expressly so claimed (p. 377).
2. Patent No. 777 granted Carver, E., June 12, 1838, reissued as No. 17, November 16, 1839, for Ribs of Cotton Gin, construed to have claimed form and manner of attaching as an essential part of the invention, and not infringed by a substantially different form (p. 378).
3. A result is not patentable (p. 378).

ERROR to the Circuit Court for the District of Massachusetts. The action below was for the infringement of letters patent for improving "saw ribs for cotton-gin," granted to the plaintiff June 12, 1838, and reissued November 16, 1839.

(The specification of the original patent was as follows ; that of the reissued patent is given in the opinion of the court.)

UNITED STATES PATENT OFFICE. ELEAZER CARVER, OF BRIDGEWATER, MASSACHUSETTS. . IMPROVEMENT IN THE MANNER OF FORMING THE RIBS OF SAW-GINS FOR GINNING COTTON. SPECIFICATION FORMING PART OF LETTERS PATENT NO. 777, DATED JUNE 12, 1838.

To all whom it may concern :

Be it known that I, ELEAZER CARVER, of Bridgewater, in the county of Plymouth and Commonwealth of Massa-

Statement of the case.

achusetts, have invented certain Improvements in the Manner of Forming the Ribs of Saw-Gins for the Ginning of Cotton ; and I do hereby declare that the following is a full and exact description thereof.

The cylinder of saws and the other parts of the saw-gin may be constructed in the usual manner ; but I construct the ribs which form the grating through which the saws work in a form different in several respects from those which have heretofore been employed.

In the accompanying drawings, Figure 1 is a representation in perspective of one of the ribs of the form generally given to it by me. Fig. 2 shows four ribs in their cross-section ; and Fig. 3, four ribs standing in front of the saw-cylinder, and having the saws between them.

The saws are shown in Fig. 1 by the dotted lines A, and by the lines A A A in Fig. 3. The dotted lines *a b c* in Fig. 2 also show the places of the saws. I denominate the curvature given by me to the ribs, as shown at C', Fig. 1, the "lower" curve, and that commencing at D the "upper" curve.

Instead of making the upper sides of the ribs with a flat surface, as is usually done, I form them ridge-shaped, as shown in Fig. 1, and more distinctly in the cross-sections, Fig. 2.

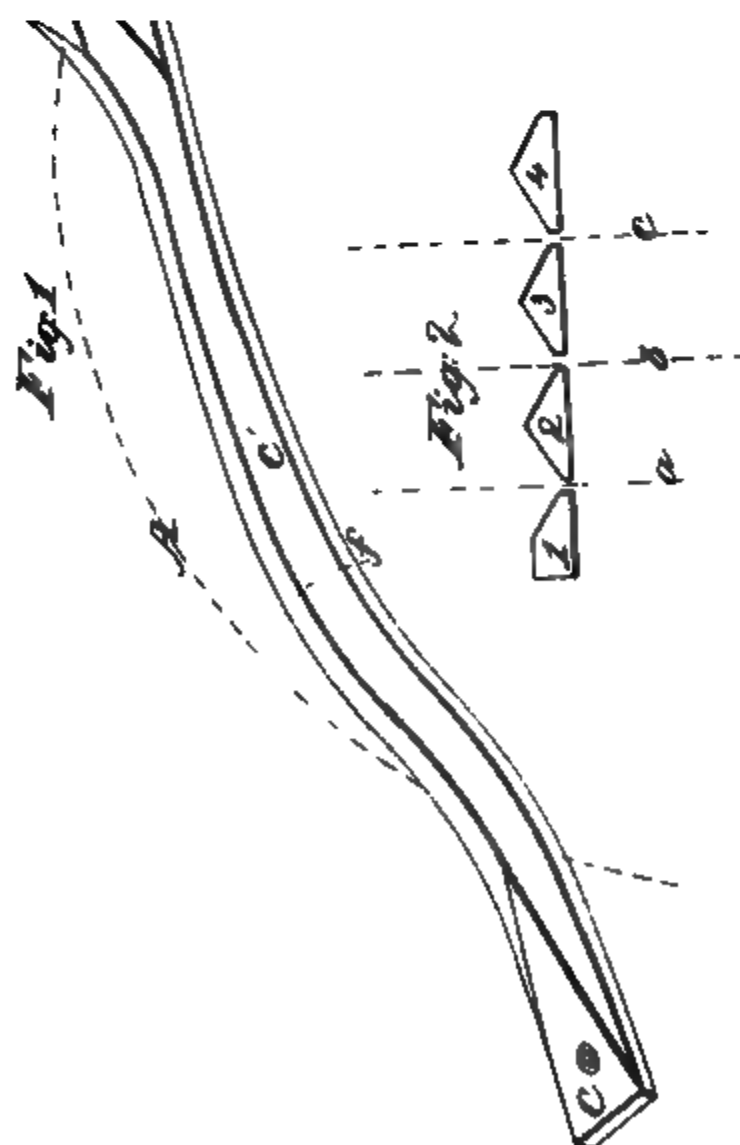
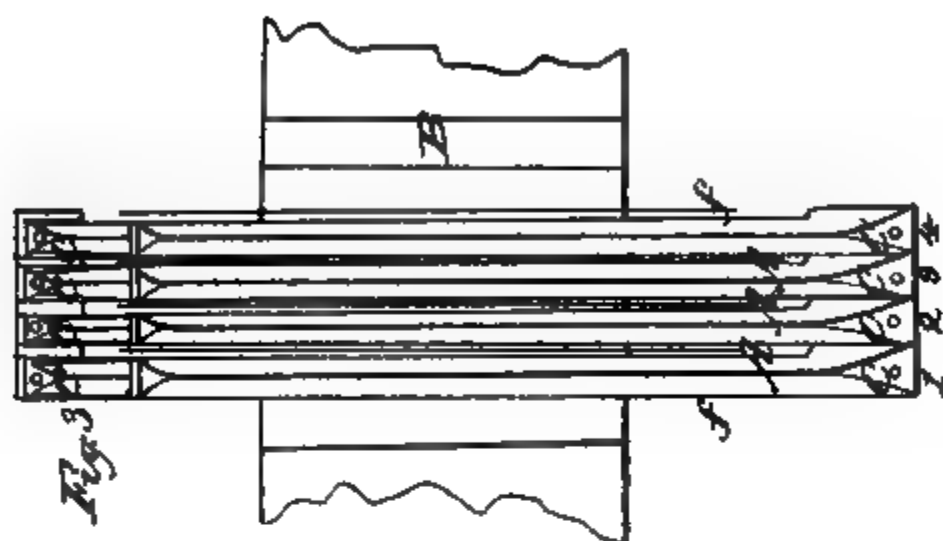
The advantage derived from the ridge-formed grate bars or ribs is, that from their lateral inclination they give the seeds a direction toward the saws, so that they may with the greater certainty be caught and drawn up by the teeth so long as any fibre remains upon them. The upper curve, D, is the part through which the cotton is drawn as it is separated from the seeds ; and in this part, along which the ridge is continued, it has a still further advantage. The obtuse angle which the inclined ridge forms with the side of the rib prevents the cutting or breaking of the fibre as the cotton is drawn through, while it also forms a channel that prevents the seed-cotton from escaping in a lateral direction.

I sometimes form upon the rib a projection, F, which I

E. CARVER.
Cotton-Gin Rib.

No. 777.

Patented June 12, 1838.



Statement of the case.

call the "lateral" projection, which is adapted to the ginning of long-staple cotton as well as other cotton. The point E is that at which the saw leaves the rib, and it is important in all cases, and is one of the improvements made by me, to form the rib in such a manner as that the portion of the circumference of the saw which is between the ribs—that is to say, from the point at which the cotton is first drawn in to that at which it escapes from between them—shall be equal to the full length of the fibre of the cotton to be ginned. The projection F extends nearly across the ribs, and its rise is such as to admit the seed-cotton to slide over it at the same time that the teeth are drawing the fibres through the spaces between them, which spaces are sufficiently wide to admit of the passing of the smaller seeds of cotton, which seeds are arrested, drawn up, and carried off at C. Above the point E, where the saw escapes, the rib slopes or narrows toward C', which allows the smaller seeds which may be arrested at D to pass out freely at C'.

Having thus fully described the construction of the grate bars or ribs of my cotton-gin, I claim as constituting my improvements—

The ridge form given to their upper surfaces, in the manner and for the purposes set forth—that is to say, to give an inclination of the seeds toward the saws, and to prevent the breaking or cutting of the fibre in consequence of the obtuseness of the angle against which it is drawn off; also, the oblique projection F, to give a larger space for the filling of the saw-teeth with cotton; likewise the slope given to the ribs at C', where the cotton is drawn in, thereby increasing it in width, and allowing the seeds to escape to prevent the grates from being choked, the whole combined and arranged as herein set forth.

ELEAZER CARVER.

Witnesses :

B. K. MORSELL,
LINTON THORN.

Opinion of the court.

Franklin Dexter, for plaintiff ; *Richard Fletcher*, *Willard Phillips*, and *Leverett Saltonstall*, for defendants.

Chief Justice TANEY delivered the opinion of the court.

This case is brought here by writ of error, directed to the Circuit Court of the United States for the District of Massachusetts. It is an action by the plaintiff in error against the defendants, to recover damages for the infringement of a patent-right, obtained by the plaintiff on November 16, 1839. The patent is in the usual form, and the questions before us depend upon the construction of the specification, which is in the following words :

“ Be it known, that I, Eleazer Carver, of Bridgewater, in the county of Plymouth, and State of Massachusetts, have invented a certain improvement in the manner of forming the ribs of saw-gins, for the ginning of cotton ; and I do hereby declare that the following is a full and exact description thereof :

“ In the cotton-gin, as heretofore known and used, the fibres of the cotton are drawn, by the teeth of circular saws, through a grating formed of a number of parallel bars or ribs, having spaces between them sufficient to allow the saws to pass, carrying the fibres of the cotton with them, (which are then brushed off by a revolving brush,) but not wide enough to let the seeds and other foreign substances pass through. Above the saws the ribs come in close contact, thus forming a shoulder at the top of the space between them. Various forms have been given to the bars or ribs, with a view to procure a free passage of the cotton ; but the cotton-gin, as heretofore made, has been always subject to the inconvenience of the grate becoming choked by hard masses of cotton and motes, or false seeds, collecting in the upper part of the spaces between the ribs, and impeding the action of the saws, and also preventing the mass of cotton which is drawn by the saws up to the top of the spaces, but not drawn through them, from rolling back freely, so as to pass again over the saws, as it should do.

“ My improvement, which I am about to describe, is in-

Opinion of the court.

tended to obviate these difficulties ; and it consists in giving a new form to the ribs composing the grate. Instead of making the ribs of a bar of iron of equal thickness throughout, so that the upper and under surfaces shall be parallel, I so form the rib, that at the part where the saws pass through, carrying the cotton with them, the space or depth between the upper and outer surface, and the lower or inner surface, shall be greater than the thickness of the rib in other parts has heretofore been, or needs to be, and so great as to be equal to the length of the fibre of the cotton to be ginned, so that the fibre shall be kept extended between the ribs for about its full length, while it is drawn through them by the saws. This mill, of course, requires, either that the rib should be as thick at that part as the length of the fibre, or that the rib should be forked, or divided, about that part, so that the upper or outer surface, and the under or inner surface, shall diverge to that distance of each other, instead of being parallel as formerly, when the rib was made of one bar of uniform thickness. This under or inner surface then takes a new direction upward, and slopes toward the upper or outer surface, until the two surfaces meet above the periphery of the saw. This last described part of the under surface is fastened against the framework of the gin. The operation of this improvement is, that those fibres of the cotton which are so firmly caught by the teeth of the saws as to be disengaged from the mass of the cotton to be ginned, are drawn out to their full length, and pass clear through the grate, and are then brushed off by the revolving brush, while the fibres that are drawn into the grate, but not caught by the teeth of the saws firmly enough to be carried quite through, are disengaged, and pass up to where the under surface meets the upper surface, above the saws, and, finding no obstruction there, pass back out of the grate without choking it, and roll down again with the mass of unginned cotton, and are caught below by the saws, and carried up again, and so on until all the fibres are drawn through."

The specification then proceeds to describe the invention

Opinion of the court.

more particularly, by referring to and explaining the drawings annexed to it, showing the advantages of his improvement, the manner of arranging the ribs in the gin, and the mode of inserting and fastening them in the framework. This description could not be comprehended without an exact drawing ; nor is it necessary, in order to understand the questions of law in dispute between the parties. It is therefore omitted. After giving this description, the specification states the improvement, of which the patentee claims to be the inventor, as follows :

“ Having thus described my improved rib and its advantages, I now claim as my invention, and desire to secure, by letters patent, the increasing the depth or space between the upper or outer surface of the rib, and the lower or inner surface of it, at the part where the cotton is drawn through the grate, so that it shall be equal to the length of the fibre of the cotton to be ginned ; (whether this be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the particular form ;) and I also claim, as part of the said improvement, the sloping up of the lower or inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted into the frame, no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between the ribs, as above described.”

At the trial in the Circuit Court, the plaintiff in error, after having produced his patent, with the schedule annexed to it, offered in evidence, by the testimony of witnesses skilled in the art, that the rib described in the plaintiff's specification was a new and useful improvement ; that the fastening of the rib to the framework in the manner therein stated had nothing to do with the ginning, but was only necessary to keep the rib firm ; that the rib of the defendants was substantially in principle like that of the plaintiff, and operated in the same manner and produced the same effect ; and that, in their opinion, it differed from the plaintiff's rib only by taking away a part which was wholly immaterial in the operation of ginning.

Opinion of the court.

The defendants then produced witnesses skilled in the art, who testified that the ribs of the defendants did not substantially operate in the same manner with the plaintiff's, but were different in form and principle, and proceeded to state the particulars in which they differed; and testified that the defendants' ribs were entirely detached from the breast-band, and stood out in front of it, like the bar of the "Edenton grate," which was known and in use long before the plaintiff's; and that the front and back surfaces of the defendants' ribs did not slope and meet at the upper end above the saws as the plaintiff described his to do, and was not shaped as the plaintiff's was exhibited and described in his drawings, specification, and claim.

"Whereupon the defendants' counsel insisted that the ribs of the defendant were, according to the whole evidence, substantially different from those described and claimed by the plaintiff, not only because, as the counsel alleged, it appeared by the whole of said evidence, that, in the defendants' said ribs, no part of the under surface sloped upward, and met the upper surface above the periphery of the saw, and was there fastened against the framework of the gin; but, also, in the other particulars above described.

"But the plaintiff's counsel insisted that said ribs were substantially alike, in all respects; and that in the rib of the defendants, the under surface did, according to said evidence, in fact, slope upward, and meet the upper surface above the periphery of the saw, but that it was not necessary to the plaintiff's invention, as described and claimed in his said specification; nor was it essential to the said invention, in fact, that the under surface of the rib should be fastened against the framework of the gin, where the two surfaces meet, above the periphery of the saw.

"And the presiding judge who sat at the trial aforesaid did then and there declare and deliver his opinion to the jury aforesaid, as follows, viz.: That to entitle the plaintiff to maintain the action and issue aforesaid, on his part, it was necessary for the jury to be satisfied that the defendants had substantially violated and infringed the patent-

Opinion of the court.

right of the plaintiff, as set forth and described in his patent. That if the defendants used only such part of the said patented improvement as was known and used before his supposed invention, it was no violation or infringement thereof. That the improvement of the plaintiff, as specified and summed up by him, was in the following terms, viz. :

“ I now claim as my invention, and desire to secure, by letters patent, the increasing the depth or space between the upper or outer surface of the rib, and the lower or inner surface of it, at the part where the cotton is drawn through the grate, so that it shall be equal to the length of the fibre of the cotton to be ginned ; (whether this be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the particular form ;) and I also claim, as part of the same improvement, the sloping up of the lower or inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted into the frame, no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between the ribs, as above described.”

That the true construction and interpretation of the specification and summing is, that it claims and states as a substantial part of the improvement, not only the increasing the depth or space between the upper or outer surface of the rib and the lower or inner surface thereof, at the part where the cotton is drawn through the grate, so that it shall be equal to the length of the fibre of the cotton to be ginned in the manner above stated, but it also claims and states as a substantial part of the same improvement, the sloping up of the lower and inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted in the framework, no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between the ribs, as described in the same specification ; and that thereby the fixing or fastening of the ribs against the framework, in the manner stated in the specification, is made by the patentee a substantial part of the said improvement ; so that if the de-

Opinion of the court.

defendants do not fix or fasten the ribs of their machine against the framework in the manner stated in the specification, either at all or substantially in the same manner as the patentee, or fix or fasten it only in a manner known or used before the plaintiff's supposed invention, the defendants are not guilty of any violation or infringement of the plaintiff's patent, as stated in the declaration; and with this declaration, the said presiding judge left the said cause to the jury, who thereupon then and there returned a verdict for the defendants.

It will be seen by this statement, that the question of law presented by the exception is a very narrow one, and depends altogether on the construction of the specification; and it is difficult to make it understood, without the aid of the drawing or model.

The plaintiff considers the invention secured by the patent to consist of the rib only—and of that part of the rib which by its form increases the depth between its upper or outer surface and the lower or inner one, at the place where the cotton is drawn through the grate. He insists that the sloping up of the rib, so as to meet the upper or outer surface of the saw, as well as the manner of fastening it against the framework of the gin, as mentioned in his specification, are not substantial or essential parts of his invention.

The question is, whether they are claimed as such by his patent. The Circuit Court held that they were so claimed; and we think the opinion was clearly right. They are expressly stated by the patentee to be a part of the improvement for which he asks a patent, and he describes particularly the smooth and uninterrupted passage upward between the ribs, leaving no break or shoulder between the two surfaces, when the ribs were inserted in the frame, as one of the advantages resulting from his improvement. And this smooth and uninterrupted surface must necessarily depend not merely on the form of the rib, but also in the manner in which it is connected with the framework.

The rib in question is not an invention to be used by itself, but an improvement upon that portion of the cotton-

Opinion of the court.

gin ; and is to be used in connection with other parts of a machine which has been publicly known and used a long time. There must, therefore, be some mode of fastening and connecting it with the other machinery ; and the effect produced by the rib necessarily depends, in a great degree, upon the mode in which it is arranged and connected with the saw, and the other parts of the machine. He specifies the mode, and claims it as part of his invention. According to his statement, his improvement consisted in the form of the rib which increased the depth between the upper and lower surface, at the part where the cotton is drawn through the grate, in the sloping up so as to meet the upper or outer surface above the saws, and in the smooth and uninterrupted passage produced by the manner in which it was connected with the frame. These three things he represents as constituting his improvement, and they are all combined together in his specification and claim, making together one invention, to be used in connection with the other and old machinery of the cotton-gin. And the drawing which accompanies his patent shows the manner in which the rib is sloped and arranged with the saw and annexed to the framework, in order to attain the object of the invention.

Now, the end to be accomplished is not the subject of a patent. The invention consists in the new and useful means of obtaining it. And if the defendant had, by a rib of a substantially different form, or differently arranged with the saw, or not fastened at all to the frame, made an improvement which more effectually secured the object intended to be accomplished by the plaintiff's patent, it would be difficult to maintain that it could not be lawfully used, because it produced the same result with the plaintiff's invention.

The usefulness of the rib depends altogether, as described in the specification, upon the manner of its connection with the periphery of the saw, and with the framework. And if, therefore, as was said by the Circuit Court, the rib made by the defendant was not fastened at all to the framework,

Notes and Citations.

or in a manner substantially different from the plaintiff's, or in a manner known and used before the plaintiff's invention, it was no infringement of his patent. And whether the manner was the same in substance or not, was a question of fact for the jury ; and as they found for the defendant, we must assume that it was substantially different.

The judgment of the Circuit Court is therefore

AFFIRMED.

Notes :

1. Patentee is bound by his claim :

Le Roy *v.* Tatham, 14 How. 156.

Keystone Bridge Co. *v.* Phoenix Iron Works, 95 U. S. 274.

Schumacher *v.* Cornell, 96 U. S. 549.

Union Water Meter Co. *v.* Desper, 101 U. S. 332.

Railroad Co. *v.* Mellon, 104 U. S. 112.

Fay *v.* Cordesman, 109 U. S. 408.

Thompson *v.* Boisselier, 114 U. S. 1.

Sargent *v.* Hall Safe & Lock Co., 114 U. S. 63.

Western Electric M'f'g Co. *v.* Ansonia Brass Works, 114 U. S. 447.

Shepard *v.* Carrigan, 116 U. S. 593.

Yale Lock M'f'g Co. *v.* Sargent, 117 U. S. 373.

Sutter *v.* Robinson, 119 U. S. 530.

2. Form the essence of the particular invention :

Winans *v.* Denmead, 15 How. 330.

Keystone Bridge *v.* Phoenix Iron Co., 95 U. S. 274.

Werner *v.* King, 96 U. S. 218.

Clark *v.* Beecher M'f'g Co., 115 U. S. 79.

Notes and Citations.

3. Result not patentable :

Le Roy *v.* Tatham, 14 How. 156.

Corning *v.* Burden, 15 How. 252.

Case *v.* Brown, 2 Wall. 320.

Fuller *v.* Yentzer, 94 U. S. 288.

Patent in suit :

No. 777. Carver, E. June 12, 1838. Ribs of Cotton Gin.

Reissue No. 17. November 16, 1839.

OTHER SUITS ON SAME PATENT :

Carver *v.* Braintree M'f'g Co., 1843. 2 Story, 432 ; 2 Robb. 141.

Citations :

IN SUPREME COURT OF UNITED STATES :

Stimpson *v.* Railroad Co., 1850. 10 How. 329 ; Bk. 13, L. ed. 441.

Stimpson *v.* Woodman, Diss. opin., 1869. 10 Wall. 117 ; Bk. 19, L. ed. 866.

Gould *v.* Rees, 1871. 15 Wall. 187 ; Bk. 21, L. ed. 39.

Gill *v.* Wells, 1874. 22 Wall. 1 ; Bk. 22, L. ed. 699. .

Reedy *v.* Scott, 1874. 23 Wall. 352 ; Bk. 23, L. ed. 109.

IN CIRCUIT COURTS :

Hale *v.* Stimpson, October, 1865. 2 Fish. 565.

Notes and Citations.

IN DECISIONS OF COMMISSIONER OF PATENTS:

Robert Dick, July, 1872. 2 O. G. 147.

IN TEXT-BOOKS:

Walker on Pats., 1883, pp. 125, 258.

Syllabus.

WILLIAM T. McCLURG, JOHN C. PARRY, AND ENOCH J. HIGBY, PARTNERS, DOING BUSINESS UNDER THE FIRM OF McCLURG, PARRY, AND HIGBY, ASSIGNEES OF JAMES HARLEY, PLAINTIFFS IN ERROR, v. LAWRENCE KINGSLAND, ISAAC LIGHTNER, AND JAMES CUDDY, PARTNERS, DOING BUSINESS UNDER THE FIRM OF KINGSLAND, LIGHTNER, AND CUDDY, DEFENDANTS.

1 How. 202-211. Jan., 1848.

[Bk. 11, L. ed. 102; 2 Robb. 105; 1 Whit. 322.]

Powers of Congress. Inventor and employer. License, when presumed. "Thing patented."

1. It is no objection to the validity of the patent law that it may be retrospective in operation; the power of Congress to legislate upon the subject is plenary under the Constitution, so that they do not take away the rights of property in existing patents (p. 387).
2. The validity of a patent is determined in view of the statutes in force at the time of its grant (p. 387).
3. Act 1836, §§ 14 and 15, give rules of action which must govern on the trial of actions for the violation of patented rights, whether granted before or after its passage (p. 388).
4. Where an inventor permits the use of his invention by his employers, prior to patenting, it could well be held an abandonment by public use, in view of decision in *Pennock v. Dialogue*, 2 Pet. 7 [p. 217 *ante*] and of Act 1793, §§ 1 and 3; Act 1800, § 1; Act 1832, § 3; and Act 1836, § 15 (p. 388).
5. Where prior to patenting the inventor fully acquiesces in the use of his invention by his employers, it raises the presumption of a license from the inventor to continue its use subsequent to the grant of a patent (p. 389).
6. Act 1839, § 7, "newly-invented machine, manufacture or composition of matter," signify "invention" or "thing patented" (§ 15, Act 1836) (p. 389).

Statement of the case.

[Citations in the opinion of the Court :]

- (1) *Pennock v. Dialogue*, 2 Pet. 1-24, pp. 388, 389, 391.
- (2) *Grant v. Raymond*, 6 Pet. 248, p. 388.
- (3) *Shaw v. Cooper*, 7 Pet. 313, p. 388.
- (4) 4 Story, 2301, 2510, 2511, 2546, pp. 388, 392.
- (5) Pamphlet Laws, 1839, 74, 75, p. 390.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Western District of Pennsylvania.

The facts are sufficiently stated in the opinion of the court.

The bill of exceptions which was taken on the trial below was as follows :

And the plaintiff thereupon excepted to certain parts of the instructions so given by the court to the jury, which instructions so excepted to are hereinafter set forth, to wit :

“ It has, however, been urged, by the plaintiff's counsel, that the right to the continued use is restricted to the ‘ specific machine, manufacture, or composition of matter so made or purchased,’ so that a defendant is protected no farther than in the case of the invention (for which this patent was granted) prior to the application, and is liable to damages if he makes any rolls by Harley's plan afterward.

“ We, therefore, feel bound to take the words, ‘ newly-invented machine,’ in the act of 1839, manufacture, or composition of matter and such invention, to mean the invention patented, and the words ‘ specific machine’ to refer to the thing originally invented, whereof the exclusive right is procured by patent, but not to any newly-discovered improvement to an existing patent.

“ The use of the patent must be of the same specific improvement originally invented, as was, before the application, used by any person who had purchased or constructed the machinery on which he operated to produce the effect described in the specification ; but when such person confines the future use to the specific mode, method, manner, and process of producing the described effect, it is, by the words

Statement of the case.

and true meaning of the law, without liability to the inventor or other person interested in the invention, so construed ; and by thus protecting the person who has engaged the use of an invention before the application for a patent, the great object of the Patent Laws, as declared in the fourth section of the act of 1837, will be consummated,—that is, to protect the rights of the public and ‘of patentees in patented inventions and improvements.’ 4 Story, 2547. A different construction would make it necessary to carry into all the former laws the same literal exposition of the various terms used to express the same thing, and, thereby changing the law according to every change of phraseology, make it a labyrinth of inextricable confusion.

“ Our opinion, therefore, is, that the defendants have a right to the continued use of the improvement patented to Harley. The facts of the case, which are not controverted, have equal effect with a license, and the evidence brings the defendant under the protection of the act of 1839, by the unmolested notorious use of the invention before the application for a patent. Nothing has been shown, on the part of the plaintiffs, to counteract the effect of this prior use ; as the assignees of Harley, they stand in his place as to right and responsibility ; they took the patent subject to the legal consequences of his previous acts ; and connecting these with the want of an assertion of a right to the use by the defendants of the invention patented, till this suit was brought in September, 1835, protects them from liability.

“ In our opinion, your verdict ought to be for the defendants. Verdict accordingly, and judgment for defendants.”

Dunlap, on behalf of the plaintiffs in error, contended that the court below had erred in charging the jury—

1. That the facts justified the presumption of a license or grant to use the invention, and that defendants were protected thereby, independent of any act of Congress.

2. That the words “ specific machine,” in the fourth section of the act of 1839, referred to the invention itself, and

Opinion of the court.

that the authority to use it before the patent carried the right to continue to make and use it after the patent had issued.

Mr. Justice BALDWIN delivered the opinion of the court.

This case comes here on a writ of error to the Circuit Court for the Western District of Pennsylvania, in an action brought by the plaintiffs, assignees of James Harley, against the defendants, for the infringement of a patent granted to Harley for an improvement in the mode of casting chilled rollers and other metallic cylinders and cones, in which judgment was rendered for the defendants. On the trial, it appeared in evidence that it had long been a desideratum to find out some mode by which iron rollers, or cylinders, could be so cast that when the metal was introduced into the mould it should cause a swirl or rotatory motion, by which the flog or dross would be thrown into the centre instead of the surface of the cylinder. By the old mode, the metal was conveyed from the furnace to the mould through a gate or pipe, placed in a horizontal or perpendicular direction. The mode alleged to have been invented by Harley is thus described in the specification annexed to the patent: "The tube or tubes, or passages called gates, through which the metal to be conveyed into the moulds shall not enter the mould perpendicularly at the bottom, but slanting, or in a direction approaching to a tangent of the cylinder, or if the gates enter the moulds horizontally, or nearly so, shall not enter in the direction of the axis of the cylinder, but in a tangent form, or inclining toward a tangent of the cylinder."

This was the thing patented, consisting solely in changing the direction of the tube which conveyed the metal to the mould, from a horizontal or perpendicular position to an angular one. It produced the desired effect, and was highly useful.

The novelty of the invention was much contested at the trial, but as the case turned on other points, that became an immaterial question; and the case comes before us, on

Opinion of the court.

exceptions to the charge of the court, which assumed that Harley was the original and true inventor of the improvement, and put the case to the jury on the following facts, which were in full proof, in nowise contradicted, and admitted to be true :

That Harley was employed by the defendants at their foundry in Pittsburg, receiving wages from them by the week ; while so employed, he claimed to have invented the improvements patented, and after several unsuccessful experiments made a successful one in October, 1834. The experiments were made in the defendants' foundry, and wholly at their expense, while Harley was receiving his wages, which were increased on account of the useful result. Harley continued in their employment, on wages, until January or February, 1835, during all which time he had made rollers for them. He often spoke about procuring a patent, and prepared more than one set of papers for the purpose. Made his application the 17th February, 1835, for a patent. It was granted on the 3d of March, and assigned to the plaintiffs on the 16th of March, pursuant to an agreement made in January.

While Harley continued in the defendants' employment, he proposed that they should take out a patent and purchase his right, which they declined. He made no demand on them for any compensation for using his improvement, nor gave them any notice not to use it, till, on some misunderstanding on another subject, he gave them such notice about the time of his leaving their foundry, and after making the agreement with the plaintiffs, who owned a foundry in Pittsburg, for an assignment to them of his right. The defendants continued to make rollers on Harley's plan. The present action was brought in October, 1835, without any previous notice by them. The court left it to the jury to decide what the facts of the case were, but, if they were as testified, charged that they would fully justify the presumption of a license, a special privilege or grant to the defendants to use the invention ; that the facts amounted to " a consent and allowance of such use," and show such

Opinion of the court.

a consideration as would support an express license or grant, or call for the presumption of one to meet the justice of the case, by exempting them from liability—having equal effect with a license, and giving the defendants a right to the continued use of the invention. The court also charged the jury, that the facts of the case which were not controverted brought it within the provisions of the seventh section of the act of 1839, by the unmolested notorious use of the invention before the application for a patent by Harley, and that nothing had been shown by the plaintiffs to counteract the effect of this prior use. That as assignees of Harley, the plaintiffs stand in his place as to right and responsibility; they took the assignment of the patent subject to the legal consequences of his previous acts, and connecting these with the absence of an assertion of a right adverse to the defendants' use till this suit was brought, protected the defendants from liability for any damages therefor.

The exceptions to the charge were confined to these two points, which constitute the only subject for our consideration. Whether these exceptions are well taken or not, must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made; for though they may be retrospective in their operation, that is not a sound objection to their validity. The power of Congress to legislate upon the subject of patents is plenary, by the terms of the Constitution; and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.

When the patent to Harley was granted and this suit brought, the acts of 1793 and 1800 were the tests of its validity, but the twenty-first section of the act of 1836 repealed all existing laws on the subject of patents, with a proviso, that all suits brought before may be prosecuted in the same manner as if that act had not been passed, "excepting and saving the application to any such action of

Opinion of the court.

the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto." This repeal, however, can have no effect to impair the right of property then existing in a patentee or his assignee, according to the well-established principles of this court in 8 Wheat. 493. The patent must, therefore, stand as if the acts of 1793 and 1800 remained in force ; in other respects, the fourteenth and fifteenth sections of the act of 1836 prescribe the rules which must govern on the trial of actions for the violation of patented rights, whether granted before or after its passage.

In *Pennock v. Dialogue*, this court held, in 1829, " that if an inventor makes his discovery public, looks on, and permits others freely to use it, without objection or assertion of claim to the invention of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for before such use, and that it makes no difference in the principle, that the article so publicly used and afterward patented was made by a particular individual, who did so by the private permission of the inventor." 2 Peters, 14, 15 ; *Grant v. Raymond*, 6 Peters, 248, 249 ; *Shaw v. Cooper*, 7 Peters, 313-323.

On this construction of the acts of 1793 and 1800, Harley's patent would have been void on the evidence in this case. Such seems to have been the sense of Congress as expressed in the act of 1832, which authorized the issuing a new patent, when an original one was invalid by accident, inadvertence, or mistake, and without any fraudulent intent, by reason of the terms of the third section of the act of 1793 not having been complied with ; " provided, however, that such new patent so granted shall in all respects be liable to the same matters of objection and defence as any original patent granted under the said first-mentioned act. That no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be free public use

Opinion of the court.

thereof, shall in any manner prejudice the right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid." 4 Story, 2301.

This act is an affirmance of the principles laid down by this court in the three cases before referred to, and as the exception to the proviso is limited to an use of the invention under a special license of the inventor after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in 2 Peters, 14, 15, whereby the patent would become void.

The same conclusion follows from the fifteenth section of the act of 1836, which declares, that if the thing patented "had been in public use or on sale, with the consent and allowance of the patentee, before the application for a patent," judgment shall be rendered for the defendant with costs. 4 Story, 2511. The case before us is one of this description: the defendants use the invention of Harley for four months before his application for a patent; this use was public; and not only with his express consent and allowance, but he himself made the rollers, on the plan he invented, during those months, from the time when he had ascertained the utility of his invention.

It would, therefore, be no strained, if not the fair construction of this act, if, under such and the other circumstances in evidence in the cause, the court charged the jury that, if they believed the witnesses, the patent subsequently obtained was void. The Circuit Court, however, did not go so far. They held that the defendants might continue to use the invention, without saying that the public might use it without liability to the plaintiffs, in which we think there was no error in their direction to the jury; that they might presume a license or grant from Harley, or on the legal effect of the uncontroverted evidence as to the right of recovery by the plaintiffs, or on the construction of the acts of 1793, 1800, 1832, and 1836.

The remaining exception is to the charge of the court below, on the effect of the seventh section of the act of

Opinion of the court.

1839, which is in these words: "That every person or corporation who has or shall have purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer of a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent." Pamphlet Laws, 1839, 74, 75.

The object of this provision is evidently twofold: first, to protect the person who has used the thing patented, by having purchased, constructed, or made the machine, &c., to which the invention is applied, from any liability to the patentee or his assignee; second, to protect the rights granted to the patentee against any infringement by any other persons. This relieved him from the effects of former laws and their construction by this court, unless in case of abandonment of the invention, or a continued prior use for more than two years before the application for a patent; while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor to use his invention, which, if given before the application for a patent, would justify the continued use after it issued, without liability.

At the trial below, and here, the plaintiffs' counsel have contended that this act cannot apply to the present case, inasmuch as the protection it affords to the person who had the prior use is confined to the specific machine, &c., and does not extend to such use of the invention or thing patented, if it does not consist of a machine, &c., as contradistinguished from the new mode or manner in which an old machine or its parts operate, so as to produce the de-

Opinion of the court.

sired effect ; but we think that the law does not admit of such construction, whether we look at its words or its manifest objects, when taken in connection with former laws, and the decisions of this court in analogous cases.

The words "such invention" must be referred back to the preceding part of the sentence, in order to ascertain the subject-matter to which it relates, which is none other than the newly-invented machine, manufacture, or composition of matter constituting the thing patented ; otherwise these words become senseless, when the invention is not strictly of a machine, &c. Now, in the present case, we find the invention consists solely in the angular direction given to the tube through which the metal is conducted into the cylinder in which the roller is cast. Every part of the machinery is old ; the roller itself is no part of the invention, and cannot be the machine, manufacture, or composition of matter contemplated by Congress ; nor can the word "specific" have any practical effect, unless it is applied to the thing patented, whatever it may be, without making a distinction between a machine, &c., and the mode of producing a useful result by the mere direction given to one of the parts of an old machine. Such a construction is not justified by the language of the law, and would defeat both of its objects. If it does not embrace the case before us, the consequence would be that the use of the invention, under the circumstances in evidence, would, according to the decision in 2 Peters, 14, 15, *ante*, invalidate the patent ; for if the act operates to save the avoidance of the patent, it must, of consequence, protect the person who uses the invention before the application for a patent. Both objects must be effected or both must fail, as both parts of the act refer to the same thing, and the same state of things, as affecting the person using the newly-invented machine, or the thing patented, as well as the inventor. Had the words "invention" or "thing patented" been used instead of machine, &c., there could have been no room for doubt of the application of the act to the present case ; and by referring to the phraseology of the different acts of

Opinion of the court.

Congress denoting the invention, it is apparent that, though there is a difference in the words used, there is none as to their meaning or reference to the same thing. Thus, we find in the fourteenth section of the act of 1836, relating to suits for using "the thing whereof the exclusive right is secured by any patent;" in the fifteenth, "his invention, his discovery, the thing patented," "that which was in fact invented or discovered," "the invention or discovery for which the patent issued," "that of which he was the first inventor." In the first section of the act of 1837, "any patent for any invention, discovery, or improvement," "inventions and discoveries;" in the second section, "the invention;" in the third, "invention or discovery;" in the fourth, "patented inventions and improvements;" in the fifth, "the thing as originally invented." 4 Story, 2510, 2511, 2546.

We, therefore, feel bound to take the words "newly-invented machine, manufacture, or composition of matter" and "such invention," in the act of 1839, to mean the "invention patented," and the words "specific machine" to refer to "the thing as originally invented," whereof the right is secured by patent; but not to any newly-invented improvement on a thing once patented. The use of the invention before an application for a patent, must be the specific improvement then invented and used by the person who had purchased, constructed, or used the machine to which the invention is applied. So construed, the objects of the act of 1839 are accomplished. A different construction would make it necessary to carry into all former laws the same literal exposition of the various terms used to express the same thing, and, thereby changing the law according to every change of mere phraseology, make it a labyrinth of inextricable confusion.

We are, therefore, of opinion that there is no error in the charge of the court below, and that its judgment be affirmed.

This cause came on to be heard on the transcript of the

Notes and Citations.

record from the Circuit Court of the United States for the Western District of Pennsylvania, and was argued by counsel ; on consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

Notes :

1. Congressional power over patents.

Bloomer v. McQuewan, 14 How. 539.

2. Hogg v. Emerson, 6 How. 437.
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3. Act 1836, § 14 ; Act 1870, § 59 ; R. S., § 4919.

Act 1790, § 6 ; Act 1793, § 6 ; Act 1836, § 15 ; Act 1870, § 61 ; R. S., § 4920.

4. Abandonment by public use.

See Pennock v. Dialogue [p. 217 *ante*], and notes.

Act 1832, § 3 ; Act 1836, § 13 ; Act 1837, §§ 5 and 8 ;

Act 1870, § 53 ; R. S., § 4916.

Act 1836, § 15. See note 3.

Worley v. Loker Tobacco Co., 104 U. S. 340.

5. Implied license from employé to employer.

Hapgood v. Hewitt, 119 U. S. 226.

Notes and Citations.

6. Act 1839, § 7 ; Act 1870, § 37 ; R. S., § 4899.

“Thing patented :”

Wilson v. Rousseau, 4 How. 646.

Patent in suit :

No. . Harley, J. March 3, 1835. Casting Chilled
Rollers.

Citations :

IN SUPREME COURT OF UNITED STATES :

Wilson v. Rousseau, 1846. 4 How. 646 ; Bk. 11, L. ed. 1141
[p. 436 *post*].

O'Reilly v. Morse, Dis. opin., 1853. 15 How. 62 ; Bk. 14, L. ed.
601.

Burr v. Duryee, 1863. 1 Wall. 531 ; Bk. 17, L. ed. 650.

Agawam v. Jordan, 1868. 7 Wall. 583 ; Bk. 19, L. ed. 177.

Consolidated Fruit Jar Co. v. Wright, 1876. 94 U. S. 92 ; Bk. 24,
L. ed. 68.

Egbert v. Lippman, 1881. 104 U. S. 333 ; Bk. 26, L. ed. 755.

Worley v. Tobacco Co., 1882. 104 U. S. 340 ; Bk. 26, L. ed. 821.

Manning v. Cape Ann Isinglass and Glue Co., 1883. 108 U. S.
462 ; Bk. 27, L. ed. 793.

Hapgood v. Hewitt, 1886. 119 U. S. 226 ; Bk. 30, L. ed. 369.

IN CIRCUIT COURTS :

Pierson v. Eagle Screw Co., June, 1844. 3 Story, 402 ; 2 Robb.
268.

Wilson v. Turner, April, 1845. Taney, 278 ; Fish. Pat. Rep. 28.

Notes and Citations.

Allen *v.* Blunt, October, 1846. 2 Wood. & Minot, 121 ; 2 Robb. 530.

Smith *v.* Downing, June, 1850. 1 Fish. 64.

Day *v.* Union India Rubber Co., August, 1856. 3 Blatch. 488.

Wood *v.* Cleveland Rolling Mill Co., May, 1871. 4 Fish. 550.

Wetherill *v.* Passaic Zinc Co., October, 1872. 6 Fish. 50 ; 9 Phila. R. 385 ; 2 O. G. 471.

Chabot *v.* Amer. Buttonhole and Overseaming Co., October, 1872. 6 Fish. 71 ; 9 Phila. R. 378.

Jones *v.* Sewall, April, 1873. 3 Cliff. 563 ; 6 Fish. 343 ; 3 O. G. 630.

Andrews *v.* Carman, April, 1876. 13 Blatch. 307 ; 2 Ban. & Ard. 277 ; 9 O. G. 1011.

Wilkins *v.* Spafford, April, 1878. 3 Ban. & Ard. 274 ; 13 O. G. 675.

Henry *v.* Providence Tool Co., October, 1878. 3 Ban. & Ard. 501 ; 14 O. G. 855.

McKeever's Case, December, 1878. 14 Ct. of Claims, 396 ; 23 O. G. 1525.

Manning *v.* Cape Ann Isinglass and Glue Co., November, 1879. 4 Ban. & Ard. 612 ; 9 Rep. 337.

Perkins *v.* Nashua Card and Glazed Paper Co., May, 1880. 5 Ban. & Ard. 395 ; 17 O. G. 1285 ; 2 Fed. Rep. 451 ; 10 Rep. 7.

Brickill *v.* Mayor, &c. of City of New York, July, 1880. 18 Blatch. 273 ; 5 Ban. & Ard. 544 ; 18 O. G. 463 ; 7 Fed. Rep. 479.

Wade *v.* Metcalf, April, 1883. 16 Fed. Rep. 130.

Keller *v.* Stolzenbach, March, 1884. 20 Fed. Rep. 47 ; 27 O. G. 209.

New Process Fermentation Co. *v.* Maus, June, 1884. 20 Fed. Rep. 725.

Duffy *v.* Reynolds *et al.*, August, 1885. 24 Fed. Rep. 855 ; 33 O. G. 621.

American Tube Works *v.* Bridgewater Iron Co., February, 1886. 26 Fed. Rep. 334.

Jencks *v.* Langdon Mills, May, 1886. 27 Fed. Rep. 622.

Herman *v.* Herman, November, 1886. 29 Fed. Rep. 92.

Notes and Citations.

IN DECISIONS OF COMMISSIONER OF PATENTS :

Page v. Bowers, May, 1872. 1 O. G. 521.

Ex parte Roe, April, 1874. 5 O. G. 397.

IN STATE COURTS :

Slemmer's Appeal, January, 1868. 58 Penn. 155.

Hollida & Ball v. Hunt, September, 1873. 70 Ill. Rep. 109.

Wilch v. Phelps, January, 1883. 14 Neb. Rep. 134.

Deane v. Hodge, April, 1886. 27 N. Western Rep. 917.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 1, 38, 109, 136, 216, 220, 238, 265, 333.

Curt. on Pats., 4th ed., §§ 11, 102, 103, 391, 393, 394, 448.

Merwin on Pat. Inv't., 1883, pp. 559, 42, 43.

Walker on Pats., 1883, pp. 8, 102, 110, 133.

Statement of the case.

JAMES STIMPSON, PLAINTIFF IN ERROR, *v.* THE
WEST CHESTER RAILROAD COMPANY, DEFEND-
ANTS.

4 How. 380-404. Jan., 1846.

[Bk. 11, L. ed. 1020 ; 2 Robb. 335 ; 1 Whit. 330.]

Exceptions. Use after reissue. Identity of original and reissued patent. Conclusiveness of grant of reissue.

1. Exceptions should be to the points ruled by the court, and not to the charge as published at length (p. 428).
2. Under Act 1832, § 3, no prior use of the defective original patent can authorize the use after the reissue (p. 428).
3. The use referred to in Act 1839, § 7, refers to the original application, and not to a reissue of it (p. 429).
4. Whether the reissue was substantially for a different invention from that in the original patent, is a question for the jury on the evidence (p. 430).
5. Under Act 1836, § 13, the grant of a reissue is conclusive as to how the mistake or inadvertence arose, leaving open the question of fraud only (p. 431).

THIS case was brought up by writ of error from the Circuit Court of the United States for East Pennsylvania.

It was a suit brought in the Circuit Court by Stimpson against the Railroad Company for a violation of his patent-right.

On the 23d of August, 1831, Stimpson took out letters patent for an improvement in the mode of turning short curves on railroads. These letters were not given in evidence upon the trial, having been burned in the conflagration of the Patent Office, in December, 1836, and no copy could be found. Secondary evidence was given of their contents by the following publication in the Franklin Journal :

“ For an improvement in the mode of turning short

Statement of the case.

curves on railroads, such as the corners of streets: James Stimpson, city of Baltimore, August 23.

“ 37. The plan proposed is to make the extreme edges of the flanches flat, and of greater width than ordinary, and to construct the rails in such a manner that, where a short turn is to be made, the extreme edge of the flanch shall rest upon it, instead of upon the tread of the wheel, thus increasing the effective diameter of the wheel, in a degree equal to twice the projection of the flanch. The claim is made to ‘ the application of the flanches of railroad carriage-wheels to turn short curvatures upon railroads or tracks, particularly turning the corners of streets, wharves, crossing of tracks or roads, and passing over turnabouts, ’ &c.” Franklin Journal, vol. 9, p. 124.

On turning to pages 270 and 271, volume 4, there will be found specifications of two patents granted to James Wright, of Columbia, Pennsylvania, for the mode of turning curves claimed by Mr. Stimpson. The only difference is, that Mr. Wright proposes to adapt his cars to several different curves, by having three or more offsets in his wheels, when necessary.

On the same day, namely, the 23d of August, 1831, Stimpson took out, also, letters patent for an improvement in the mode of forming and using cast or wrought iron plates or rails, for railroad carriage-wheels to run upon. These letters being also destroyed, the following extract from the Franklin Journal was given in evidence.

Franklin Journal, vol. 9, p. 125. “ 39. For an improvement in the mode of *forming and using cast or wrought iron plates or rails, for railroad carriage-wheels to run upon*: James Stimpson, city of Baltimore, Maryland, August 23, 1831.

“ The claim in this case is to ‘ the application of cast or wrought iron plates for the use of railways on the streets or wharves of cities or elsewhere. The objects of said improvement being to employ rails that will not present any obstacles to the ordinary use of streets, or sustain injury therefrom, and so to form the plates at the intersection of

Statement of the case.

streets or other crossings that cars will readily pass over them, and also on circles of small radius.'

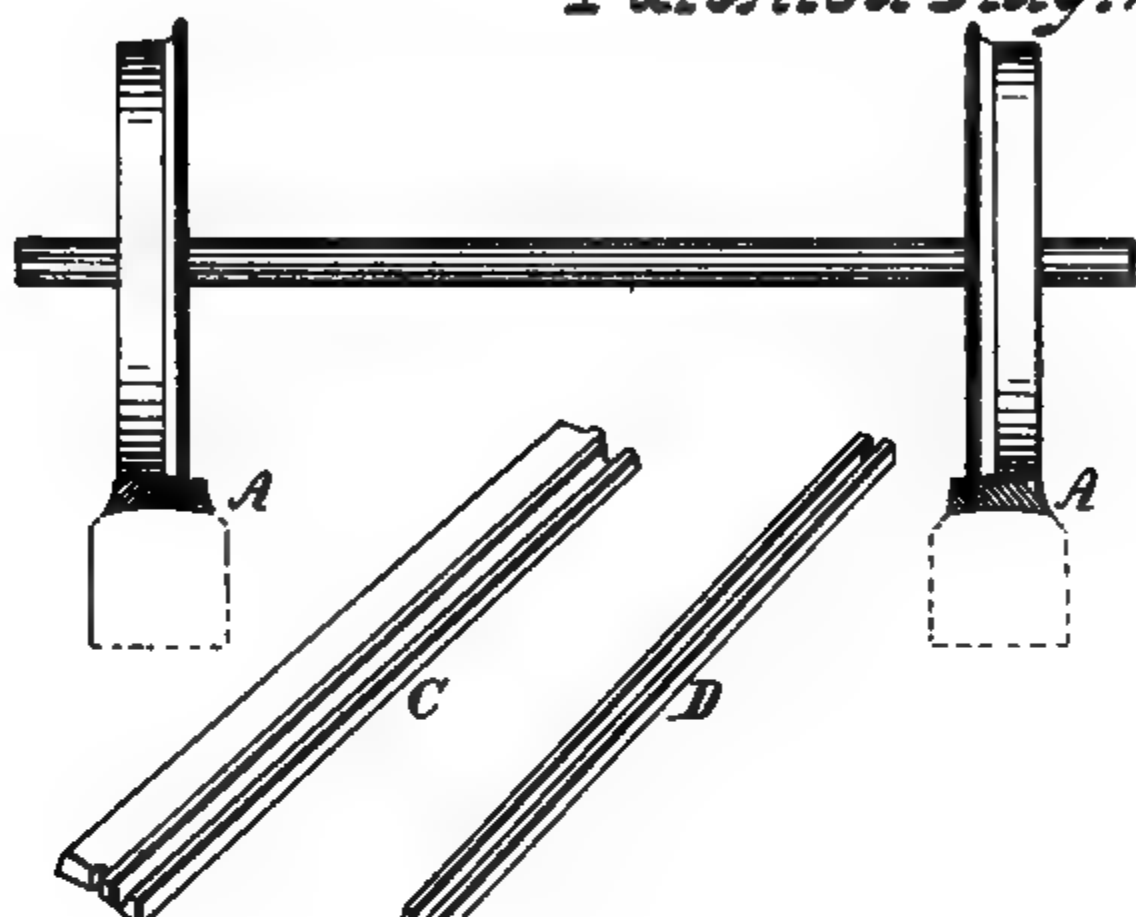
"The rails are to be formed with a groove in them to receive the flanches of the wheels; on one side of the groove, the width is to be sufficient for the tread of the wheel; on the other, it need not exceed three quarters of an inch. These rails are to be laid flush with the pavement of the streets. At corners to be turned, the rails are to be cast or made of the proper curvature, one of them only being provided with a groove, as the flanch is to run upon the other, upon the principle described in No. 37. Provision is to be made by scrapers or brushes, preceding the carriages, to clear the grooves of dust, ice, and other obstructions."

In 1835, the first mentioned of these letters, namely, for an "improvement in the mode of turning short curves on railroads," were surrendered on account of a defective specification; and on the 26th of September, 1835, a renewed patent was issued for the term of fourteen years from the 23d of August, 1831. The schedule referred to in this patent was as follows:

"Short Curves. 23d August, 1831. Renewed 26th September, 1835.

"To all whom these presents shall come: Be it known, that I, James Stimpson, of the city and county of Baltimore, and the State of Maryland, have invented a new and useful improvement in the mode of turning short curves upon railroads with railroad carriages, particularly those round the corners of streets, wharves, &c., and that the following is a full and exact description of said invention or improvement, as invented or improved by me, namely, I use or apply the common peripheries of the flanches of the wheels for the aforesaid purpose, in the following manner: I lay a flat rail, which, however, may be grooved, if preferred, at the commencement of the curvation, and in a position to be centrally under the flanches of the wheels upon the outer track of the circle, so that no other part of the wheels which run upon the outer circle of the track

J. Stimpson,
R.R. Rails,
Patented Aug. 23, 1831.



Statement of the case.

rails shall touch or bear upon the rails, but the peripheries of the flanches, they bearing the whole weight of the load and carriage, while the opposite wheels, which run upon the inner track of the circle, are to be run and bear upon their treads in the usual way, and their flanches run freely in a groove or channel, which treads are ordinarily about three inches in diameter less than the peripheries of the flanches.

“ Were the bearing surfaces of the wheels which are in contact with the rails while thus turning the curve, to be connected by the straight lines from every point, there would thus be formed the frustums of two cones, if there be four wheels and two axles to the carriage, or if but one axle and two wheels, then but one cone, which frustums, or the wheels representing their extremities, will, if the wheels are thirty inches in diameter, and are coupled about three feet six inches apart, turn a curve of about sixty feet radius of the inner track rail. The difference in diameter between the flanches and treads before stated, the tracks of the usual width, and the wheels coupled as stated, would turn a curve of a somewhat smaller radius, if the axles were not confined to the carriage in a parallel position with each other; but this being generally deemed necessary, the wheels run upon lines of tangents, and these upon the inner track, being as wide apart in the coupling as the outer ones, keep constantly inclining the carriage outward, and thus cause the carriage to tend to run upon a larger circle than the difference in diameter of the treads and flanches would otherwise give; but the depth of the flanches and the couplings may be so varied as to turn any other radius of a circle desired.

“ What I claim as my invention or improvement is the application of the flanches on the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways, particularly such as turning the corners of streets, wharves, &c., in cities and elsewhere, operating upon the principle herein set forth.

“ JAMES STIMPSON.

“ Witnesses: JAMES H. STIMPSON, GEORGE C. PENNIMAN.”

Statement of the case.

In October, 1840, Stimpson brought his action against the West Chester Railroad Company for a violation of this renewed patent, and laid the infringement to have taken place in 1839.

In April, 1842, the case came on for trial.

The plaintiff produced his patent, and gave evidence that the defendants had used upon their road several curves of this description.

The defendants disputed the originality of the invention of the thing patented, under which head of defence much evidence was given; and also contended that the groove was not claimed in the first patent of 1831, and, therefore, was not included in the renewed patent of 1835. The evidence of Dr. Jones upon this last head being referred to by the court below, it is proper to insert that part of it.

“Interrogatory fifth. What are the contents of the specification of the alleged improvement of August 23, 1831? What are your means of knowing what were their contents? If you know them, are they dissimilar or similar to those of the plaintiff's specification of September 26, 1835, a copy of which, marked A, is hereto annexed? If dissimilar, state in what particulars, and whether they are as to matters of form and substance, and particularly describe the difference, if any. Answer fully.

“To the fifth interrogatory, I answer, that the plaintiff exhibited to me the specification in question, previously to his filing the same in the Patent Office; as he likewise did at the same time the specification of a patent for ‘forming and using cast-iron plates or rails for railroad carriage-wheels to run upon,’ which last patent is noticed on page 125, vol. 9, second series, of the Journal of the Franklin Institute. I then examined them cursorily, and expressed an opinion that the improvements described in the two specifications might have been embraced in one, and that it would have been better to have pursued that course. The specification of the mode of turning short curves appeared to me incomplete, an essential feature of it being contained in that for ‘forming and using cast-iron plates,’ &c. The

Statement of the case.

papers, however, remained as drawn up by Mr. Stimpson's legal adviser, and when the patents were subsequently surrendered, in 1835, it was thought best to preserve the division into two. It was probably in fact necessary to pursue this course, as I am not aware of any precedent for uniting two patents into one, although one may be divided into two or more.

“ Nearly ten years have elapsed since I first saw the specifications upon which these patents were first issued, and nearly six years since I last read them ; and my recollection of them extends to certain prominent points only. The claim under the patent for turning short curves, as given in vol. 9, p. 124, of my Journal, is, I have no doubt, literally correct. There has been an omission in the printing of inverted commas [“] after the word ‘turnabout,’ &c. In this specification it was proposed to make the extreme edges of the flanches flat, and of greater width than ordinary. This, however, did not enter in the claim, and it is not probable that I should have recollected the fact, had it not been noted in my Journal, or called up by some other collateral circumstance. The main defect, in my judgment, of the original specification in the patent for turning short curves, was the omission of the mention of the groove in the inner rail. I believe, however, that it was alluded to in this specification, but the description of it was contained principally, if not wholly, in the specification of the patent for ‘forming and using cast-iron or wrought plates,’ &c., above noticed, as may be inferred from a reference to my Journal, vol. 9, p. 125, patent 39.

“ *Cross-interrogatories.* 1. Did you or did you not prepare the papers of the plaintiff, when his patent for short curves was surrendered and renewed ? What was the object of such surrender and renewal ? Was it or was it not that the claim of running over or across tracks at right angles might not continue any longer to be incorporated in the same patent with the claim for short curves, as it had been theretofore ?

“ To the first cross-interrogatory, I answer, that I did

Statement of the case.

prepare the papers of the plaintiff, when his patent for turning short curves was surrendered for reissue ; that the object of such surrender and renewal was to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts ; and to define the subject-matter of the patent more clearly, without its being necessary to refer to that, simultaneously obtained, for 'forming and using cast or wrought iron plates,' &c."

The bill of exceptions taken by the plaintiff was to the following part of the charge of the court to the jury, namely :

"Having thus presented you with a view of the rules and principles of the common law applicable to the renewal of patents, as laid down by the Supreme Court, together with the provisions of the different acts of Congress on this subject, we will now state to you what is, in our opinion, their legal result.

"To authorize the surrender of an old patent and issue of a new one, consistently with the provisions of the original Patent Law of 1793 and the decisions of the Supreme Court, independently of any act of Congress conferring such power, there are these requisites indispensable to the power arising : (1.) The original patent must be inoperative or invalid, for the causes set forth in the act of 1832—the non-compliance with the third section of the act of 1793, for the want of a proper specification of the thing patented, through inadvertence, accident, or mistake, without any fraudulent or deceptive intention ; this being the only case embraced in the law to which the authority conferred applies. (2.) 1, The defect in the specification, which makes it incompetent to secure the rights of the patentee, must have arisen from inadvertence, accident, or mistake, and, 2, not from any fraud or misconduct. The reissue of the patent by the appropriate officer is presumptive evidence that the requisites of the law have been complied with, on the production of such evidence or proof otherwise as justified it ; but the question of the validity of the new

Statement of the case.

patent is a judicial one, depending on the fact of inadvertence or fraud, as you shall find it, and the opinion of the court on matters of law involved in the inquiry. [Railroad Co. v. Stimpson] 14 Peters, 458; [Grant v. Raymond] 6 Peters, 243; [Shaw v. Cooper] 7 Peters, 321; act of 1839 (5 Little & Brown's edition, 353). The reason why there must be an inquiry into both the inadvertence and fraud, arises from the settled construction of the act of 1793, that where the defect is not owing to fraud, the defendant is entitled to a verdict and judgment in his favor, but not to a judgment that the patent is void for the defect, unless he shows that the defect was owing to fraud. 1 Bald. ; 6 Peters, 246. You must then be satisfied, affirmatively, that the defect of the patent arose from the inadvertence of the patentee, and, negatively, that it did not arise from his fraud or misconduct, or, in the words of the acts of 1832 and 1836, 'without any fraudulent or deceptive intention.' The finding of the fact of inadvertence may negative the fact of fraud; but in this, as in other cases, fraud may be inferred from gross inadvertence or negligence, such as may be the indication of a design to deceive the public. The defects in the old patent must be in the specification, when it does not comply with the requisites of the third section of the act of 1793, calling for a correct description of the thing patented; [Grant v. Raymond] (6 Peters, 247;) a new one may be issued on compliance with those requisites which are there prescribed. But the new patent must be confined to the thing patented by the old one—the thing invented or discovered—'*the same invention*;' it cannot embrace another substantive and essential matter, which was not before patented; the thing, the invention, must be the same in both patents; the only object in the renewal being to cure a defect in the description,—not to supply the omission of an essential part of the invention. The new patent cannot be broader than the old one. If the thing patented is the same in both patents, its public use did not, under the former laws, amount to an abandonment, or such an acquiescence as to affect the new patent on the ground of

Statement of the case.

delay or negligence in the assertion of the right of the patentee, from the date of the old patent to its reissue. But when an essential part is omitted, and the patentee suffers it to remain unpatented until it has come into public use, before the new patent issues, it will be subject to the same rules which apply to an original patent, making it incompetent to protect the patentee in his claim to such part in virtue of the patent reissued, if it was not described in the one surrendered. The thirteenth section of the act of 1836 authorizes a new improvement, invented since the first patent, to be added in a renewed one. No law gives any authority to add an improvement which had been invented by the patentee before the original grant; for it is not, and cannot be, any part of the description or specification of another distinct improvement. A patent for the combination of the parts of an old machine must show wherein such combination exists; what parts compose it; how they are combined in their action. If the description is defective, it may be corrected by a new one. The correction, however, must not extend beyond the combination of the parts first specified, as the introduction of other parts, not before specified, makes an entirely new combination; consequently, the thing patented becomes essentially different, being not the same invention, but a new one, made by a combination of a part not combined before, which might be a proper subject of an original patent, yet would not be authorized in a renewed one.

“These are the tests which the law applies to the description of the thing patented, in order to ascertain whether, in the words of the act of 1832, the old patent was ‘invalid or inoperative’ by reason that the conditions of the former law not having been complied with, or, in the language of the Supreme Court, the patent ‘is found to be incompetent to secure the reward which the law intended to confer on the patentee for his invention.’ In such case, the patent may be surrendered for reissue, in order to correct the defects which invalidated the first, but the law expressly makes the new patent ‘in all respects liable to the

Statement of the case.

same matter of objection and defence' as the old one, and imposes on the patentee the obligation of 'compliance with the terms and conditions prescribed by the third section of the act of 1793.' This is done by showing, according to its requisitions, what was the invention, the thing patented, by a designation of the invention principally, made in fuller, clearer, and more exact terms than those used, so as to give it validity and effect, and secure the same invention, which is the only legitimate office of the renewed or reissued patent. A specification consists of two parts—description and claim. The descriptive part is the explanation of the improvement in all the particulars required by the law; the claim, or summary at the close of the description or specification, is the declaration of the patentee of what he claims as his invention, by which he is bound, so that he can claim nothing which is not included in the summary, and could disclaim nothing which was included in it, till the passage of the act of 1837. But the summary may be referred to the description, and both will be liberally construed, to ascertain what was claimed; and if the words will admit of it, both parts will be connected, in order to carry into effect the true intention of the patentee, as it may appear on a judicial inspection of the whole specification. This makes it a question of law what is the thing patented, depending not on the actual or supposed intention of the patentee, but the conclusion of the law on the language he has used to express it. A part of the description may be construed as a claim, and carried into the summary, and made a part of the thing patented, the effect of which is the same as if it was included in the summary in express terms. *Cooper v. Matheys*, C. C. MS. To authorize a recovery for the violation of a patent-right, the plaintiff must show that he is the inventor of everything he claims as new, that it is embraced in the patent, and that everything so claimed and patented has been infringed by the defendant. Thus, where the patent is for a particular combination of the parts of an old machine, and the defendant has not used the whole combination, as specified in the

Statement of the case.

description and carried into the summary, the plaintiff cannot recover. *Prouty et al. v. Ruggles*, 16 Peters, 336."

The court then proceeded to state the substance of the plaintiff's declaration, and referred to the patent of 1835, and the specification thereto attached, in order to ascertain the thing patented by that patent, which was stated therefrom. They then inquired what was the thing patented in 1831, by referring to the evidence of Thomas P. Jones, contained in the deposition aforesaid, in connection with the Journal of the Franklin Institute, referred to by him. The court, remarking that there being in evidence no copy of the patent of 1831, any drawing or specification of the thing patented, or other proof of the contents of either than was contained in the deposition and Journal aforesaid, then gave their opinion to the jury, that, on this evidence, the use of grooves was not claimed, and was no part of the thing patented in 1831 for turning short curves, but was a part of the thing patented in 1835; that it was an essential part of this invention, as Jones testified, and without which all the witnesses agreed that the invention was useless, as without the groove the cars would run off the road; and that the patent was not for any parts of the machine which were new, but for a new combination of the old parts. It was then submitted to the jury, whether, on the evidence aforesaid, the omission of the groove in the patent of 1831 arose from inadvertence, and if it was done contrary to the advice of Jones, and in conformity with the opinion of the legal adviser of the plaintiff, and whether, without the groove, the description of the thing patented was sufficient, under the third section of the act of 1793, which was read and commented on by the court, who then proceeded as follows:

"The Secretary of State is a ministerial officer, who must issue a patent if the requisites are performed. 6 Peters, 241. The question of inadvertence or mistake is a judicial one, which the Secretary cannot decide, nor those judicial questions on which the validity of the patent depends. He issues the patent without inquiry. The correct perform-

Statement of the case.

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Statement of the case.

ance of all the preliminaries to the validity of the original patent are always examinable in the court where the fact is brought. [Schimmelpennick v. Turner] 6 Peters, 6, [Davis v. Packard, *ibid.*] 47, [Grant v. Raymond, *ibid.*] 242.

“ In the application of the law to the evidence before you, the first inquiry is into the state of facts existing at the time of granting the patent of 1835 : did they present a case for renewal, under the rules of law on which we have given you our instructions ? Whether the original patent was invalid or inoperative, is more a question of law than fact, to be ascertained on a judicial inspection of the patent, specification, drawings, models, and the evidence of the contents. The court must construe all written evidence ; but, as depositions are considered merely as oral testimony, a jury must decide what parts are proved by them. The court must take as true the statements of witnesses as they are made, and lay down the law on the assumption of their credibility, and both court and jury must take an agreed or admitted, uncontested state of facts to be their rule of action. A jury may deem a witness unworthy of credit, or not believe his statement, but ought to do neither without good cause. Whether the defects in the old patent arose from inadvertence or otherwise, is also a mixed question of law and fact : of law, so far as depends on written, and of fact, as to parol evidence. On this subject you have the evidence of Dr. Jones, who officially examined the old patent, &c., and made out the new, and we are mainly left to ascertain the facts in relation to both patents from him. In laying down the law to you, we assume his verity in all he says, and, taking his statement as proof of the facts there existing, our opinion is, that, connected with the publication in the Journal of the Franklin Institute, in 1832, when the matter was fresh in his recollection, and the specification in the new patent, the old one was invalid and inoperative, by reason of non-compliance with the requisites of the act of 1793 ; that it did not embrace the groove, which was essential to its validity ; that the new patent is not for the same invention, and that

Statement of the case.

the plaintiff has not made out a case of such inadvertence, accident, or mistake as justified the issue of the new patent, inasmuch as it appears—from the patent for plates on railroads, issued at the same time with the one for short curves—that he had known and described the grooves.

“It is for you to say whether you will take this evidence as we do. If you discredit it, in the whole or in part, you will find accordingly.

“Another important question arises in this case, on the construction of the seventh section of the act of 1839, taken in connection with former laws, which is, whether the plaintiff can sustain an action for the use of his invention in the construction of his curves, before the granting of the patent of 1835.

“This section provides: ‘That every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be valid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.’

“Though this act is retrospective in its effects on then existing patents, it is not void on that account. It was within the constitutional power of Congress to enact it as a rule for all cases to which its words and intentions apply, by its fair and legal interpretation, which we must ascertain by looking at the old law, the mischief and the remedy, which must be traced through the decisions of the Supreme Court, and the acts of Congress on the same subject.

“In 1808, an act was granted to Oliver Evans, renewing his patent, which had expired by its own limitation. In

Statement of the case.

the interval, the defendant had constructed a machine of his invention, and continued to use it. After the new patent issued, he was held liable, according to the words of the law, for such subsequent use ; but the Supreme Court thus express their opinion of the case, had it rested on general principles : ‘ The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one, &c. The argument, founded on the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction.’ *Evans v. Jordan*, 9 Cranch, 203.”

And thereupon the counsel for the plaintiff did then and there except to the aforesaid charge and opinion of the said court.

The above not being enough of the charge of the court below to the jury, the counsel for the plaintiff in error applied for and obtained a writ of *certiorari* to bring up additional extracts.

The return was as follows :

On searching the record and proceedings of the Circuit Court of the United States in and for the Eastern District of Pennsylvania, in the third circuit, in a certain cause therein lately depending between James Stimpson, plaintiff, and the West Chester Railroad Company, defendants, we find the following omission in the charge of the judge to the jury, which, in obedience to the annexed writ of *certiorari*, is hereby certified, to wit :

“ In *Morris v. Huntington*, Judge Thompson held, that after a patent was surrendered, the patent would be open to public use without hazard, so far as depends on such patent. 1 Paine, 355. In *Grant v. Raymond*, the court notice the case of the use of the invention between the date of the old and before the new patent, but remark that that defence is not made ; and the Circuit Court did not say that such defence would not be successful ; and they add : ‘ The defence, when true in fact, may be sufficient in law,

Statement of the case.

notwithstanding the validity of the new patent.' 6 Peters, 244. The court, in this and the subsequent case of *Shaw v. Cooper*, held, that the new patent was a continuation of the old, but gave no opinion on the question whether damages could be recovered for the intermediate use of a machine constructed after the first.

"This question was, however, put at rest by the last clause of the act of 1832, which, assuming that damages could not be recovered for a use of the patented invention before the new patent, provides: 'But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall in any manner prejudice his right of recovery for any use or violation of his invention, after the grant of such new patent as aforesaid.' The act of 1836 is still more explicit, by providing for the right of recovering damages only for 'causes subsequently accruing.'

"It thus appears, that the act of 1839 goes only one step beyond those of 1832 and 1836, and is a dead-letter, if it protects the person who has purchased, constructed, or used the machine invented by the patentee, no farther than from damages accruing prior to the new patent; for the same protection is given by those laws.

"To have any effect, it must be held to be, in the words of the Supreme Court, 'a shield,' which covers the party from all liability, and by so construing it, the act of 1839 embodies the very principle, and none other, which in *Evans v. Jordan*, 9 Cranch, 203, that court declared to be one which they believed that no one could question its reasonableness, in order to prevent the hardship of a case precisely similar in principle to that presented. Such construction is the more reasonable, when it is considered that the protection is confined to the specific machine used before the patent, and cannot be extended to protect the use of any new or other machine, or construed to invalidate the pat-

Statement of the case.

ent, or justify the subsequent use k
than those so protected.

“ That such was the intention of C
an original patent, cannot be doubted,
no reason why they should omit the v
Supreme Court had so explicitly decla
the words of the act of 1808 would ha
apply an unquestionable principle.
only does not exclude its application,
requires it. In referring to the applic
was evidently intended to apply it to
the patentee sought to recover, the rer
alone his right rested ; for the law can
be intended to apply to a patent whi
inoperative, as a ground of action, ha
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and was thus divested of all intrinsic e
of 1832 and 1836. It could have no ef
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and looked only to that which derive
Besides, the act of 1839 would take fr
protection of the acts of 1832 and 18
operation to the old patent, for damage
coverable for the use between the date a
conclusion wholly inadmissible, on a sou
either of the acts in question.

“ The act of 1832 expressly declares t
shall be subject in all respects to the san
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would protect a defendant from all liabili
the same defence is available when appli

“ This view of the act of 1839 suffices to
the present case. A broader one has be
all its bearings, in another district in thi

Argument of counsel.

is not now necessary to examine, to decide the point now under consideration.

“In the case before us, it clearly appears that the defendants constructed their railroad with the plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent ; consequently, they may continue its use, without liability to the plaintiff.”

The case was argued by *C. J. Ingersoll* and *J. R. Ingersoll*, for the plaintiff in error, and *Miles*, for the defendants in error.

The brief of the counsel on the part of the plaintiff in error was as follows :

This case comes up for argument upon a bill of exceptions taken by the plaintiff to the charge of the learned judge in the court below, by which, in effect, the jury were directed to find for the defendants, which they accordingly did.

The plaintiff took a patent the 23d of August, 1831, for an invention or improvement in the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn short curves upon railroads.

It was surrendered, in consequence of a defect in the specification, and a new patent taken by him the 26th of September, 1835.

“The object of such surrender and renewal (see deposition of Dr. Thomas P. Jones, a witness for the defendant, in answer to the first cross-interrogatory, *ante*) was to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts, and to define the subject-matter of the patent more clearly, without its being necessary to refer to that, simultaneously obtained, ‘for forming and using cast or wrought iron plates,’ &c.”

The action was brought at the October session, 1840. The

Argument of counsel.

curves used by the defendants were said to have been constructed and first used by them between the dates of the first and second patents, the use being continued by them since the date of the second patent.

The learned judge, after considering at length the law touching this part of the case, said to the jury :

“ It clearly appears that the defendants constructed their railroad with the plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent ; consequently, they may continue its use, without liability to the plaintiff.”

In *Grant v. Raymond*, 6 Peters, 244, the defendant made it a question, whether the patentee who took an amended patent could recover damages for the defendant's use, subsequent to the amendment of the patent, of machinery which had been constructed prior to the amendment. The court did not decide the point, thinking it did not come directly up for decision. But they said of it, “ This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examined it for the purpose of pirating the invention.”

Grant v. Raymond was decided early in 1832.

On the 3d of July, 1832, was passed (4 Little & Brown's ed. 559) the first act by which the amendment of patents for defective specifications was statutorily recognized. The third section of the act contains a proviso, that the new patent shall be open to all objections which existed against the old one, by virtue of which, if the phrase stood alone, a defendant in this case, for example, might say : I used your curves before 1835—before the date of your patent—that is, between the new patent and the old one ; and as a use by the public prior to the date of the patent would be fatal as against the old patent, so it is against the new.

Now, to meet such an argument, the same proviso goes on to say that no use of the patented invention between the dates of the first and second patents, excepting under a surrender of the invention to public use, shall prejudice the

Argument of counsel.

patentee's right to recover damages "for any use" after the grant of the new patent.

We quote at length the proviso of the third section : "*Provided, however, That such new patent so granted shall, in all respects, be liable to the same matters of objection and defence as any original patent under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.*"

It is submitted, that, by the terms of this statute, to use, after date of the second patent, the patented machinery, even though the specific machine used had been constructed and used between the dates of the first and second patents, is expressly denied to the public.

On the faith of this statute of the 3d of July, 1832, the plaintiff, in September, 1835, surrendered the patent granted him the 23d of August, 1831, and took an amended one.

Has any act of Congress changed the law, in this particular, since 1832 ?

As any such law, so far as regards this plaintiff, would be retroactive, it ought to be clearly expressed.

On the 6th of July, 1836, was passed the new Patent Act, by which the whole system was recast ; but the thirteenth section, which relates to amended patents, says in broad terms :

"And the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent."

It is submitted, that the words "for causes subsequently accruing," are not to be strained from their natural construction, in order to be made to retroact against the rights

Argument of counsel.

already vested under the protection of a statute ; and that the cause of action against these defendants, as far as concerns their use of the patented invention since the 26th of September, 1835, is a cause subsequently accruing, within the just and obvious meaning of the act.

In 1837, the 3d of March, was passed an amendment to the law of 1836.

The plaintiff submits that the seventh and ninth sections of the act of 1837 bear on his case, by analogy. They permit a patentee who has patented too much, and more than he invented, to make disclaimer of the excess, with the same effect, as regards the validity of the patent, as if his disclaimer were part of his original specification—that is to say, the patentee shall recover as if his patent had been originally right, instead of wrong ; and no exception is made in favor of parties who, like the defendants here, use, after disclaimer, one of the patented things which they had constructed and begun to use while the patent was too broad ; the legislature being influenced, perhaps, by the suggestion of this court in *Grant v. Raymond*, that that party is not entitled to much favor who scans a specification in order to pirate it.

On the 3d of March, 1839, the latest amendment of the Patent Laws was passed.

The seventh section of this act is cited by the learned judge, who asks what this section means, if it do not mean that the use of a patented machine shall be free to a defendant after the patent, if he constructed it before. It reads thus :

“ SEC. 7. *And be it further enacted*, That every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and to vend to others to be used, the specific machine, or manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention ;

Argument of counsel.

and no patent shall be held to be invalid by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

It is admitted, in answer to the learned judge, that the seventh section of the act of 1839 was intended to protect defendants, constructors of machinery prior to the patent, in the use of such machinery after the grant to the patentee. This section, which has no reference to renewed or amended more than to all other patents, is believed to provide for a case till 1839 unprovided for, namely, the case in general, whether it arise under an original patent, or under one which has been amended, or which has been modified by disclaimer of the use by a defendant, after the issuing of the letters, of a machine such as they patent, but which specific machine was purchased or constructed before their date. But it is respectfully submitted that this prior use meant a use prior to the first or original application of the inventor for his patent, and that the legislature had not in their contemplation the second application of the inventor, when they used the words "prior to the application of the inventor or discoverer for a patent." The last clause of the section has obvious reference to the original application alone, when it is declared that "such purchase, sale, or use, prior to the application for a patent," shall not (except under certain circumstances) make the patent invalid; for it was clear already, and quite independently of this statute, that no renewed or amended patent could be worth paying for, if the use of the patented machinery by third persons, prior to the renewal, could make it invalid.

Grant v. Raymond, however, furnishes the best answer to the learned judge's position, that the plaintiff's patent is liable to be damaged by what has taken place since the date of the original letters. At page 244, 6 Peters, the court says:

"It has also been argued, that the new patent must issue

Argument of counsel.

on the new specification, and on the application which accompanies it; consequently, it will be true that the machine was 'not known or used before the application.' But the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application."

The plaintiff in error contends, that a true interpretation of the letter of these several acts, and a due regard to the spirit of all recent legislation on the subject of patent-rights, which has been kind and liberal toward patentees, enforce the conclusion that it was meant, when the new patent was granted, to give to the new, in all particulars, the charter of the old, unless when restrained by express words to narrower limits. And further, that while, for obvious reasons, the acts deny to the patentee a right to recover damages, under the new patent, for a use of the invention of earlier date than the patent itself, (which denial is in terms,) no express words of the statutes, or fair or necessary implication from them, or leaning, can be found, in the whole course of the legislation since 1832, to warrant the conclusion that the new patent does not confer upon the grantee an entire monopoly of the fruits of his invention from the date of the second letters to the expiration of the fourteen years from the date of the first.

The plaintiff in error therefore assigns for error the learned judge's instructions to the jury, recognizing the defendants' right to use the patented invention, after the date of the second patent, provided they had commenced its use prior to that date, and continued after that date to use only the specific machine at first used.

The learned judge also charged the whole case to be against the plaintiff upon another question, namely, that of the description of the "groove" in the original patent.

The judge was of opinion that the groove was not in the first patent, and was in the second; and, therefore, that

Argument of counsel.

the second was broader than the first, and not confined to the thing there patented, and thus was defective as an amended patent. The plaintiff's patent being, as he supposed, established fully by judicial sanction of the highest sort, in his contest with the Trenton Railroad Company, reported in 14 Peters, 448, had not even brought with him, when he came to try his cause in Philadelphia, the original letters patent, and the drawings which accompanied them. Nor was any notice given him by the defendant to produce them.

The result of his suit against the Baltimore and Susquehanna Railroad Company, tried in the Maryland District, in April Term, 1843, when both the original patent and the drawings were produced in court, proved to be quite ill-founded, the attempt of the defendants, in the present case, to criticise his second patent as actually varying from the first, by the addition of this new matter, the groove.

He is aware, however, that he must sustain his case as it appears by this record, and he proceeds to do so.

The whole invention of the plaintiff consisted of a new method of attaining conical action in turning short curves on railroads; and the groove had no more to do with it than this: that when, to attain this action, the outer wheel was mounted upon its flanch, the groove, by receiving the inner wheel, prevented the car from slipping off the track—a very material consideration, it is true—in turning the corner; and so was the car, or the steam-engine that drew the car; but neither of them had anything to do with the plaintiff's method of producing conical action. Without a groove,—just as without steam, a horse, or other power,—the corner could not be turned; and, therefore, in describing the plaintiff's invention, both this power and the groove must needs be referred to; but it is respectfully denied that more than the merest allusion to either is necessary, neither of them being any part of the invention, nor so occult as to demand, for even the most unenlightened observer, more than a mere allusion to it.

Now, it was in proof, from the witness called by the

Argument of counsel.

defendants to testify to the contents of the original specification, that it alluded to the groove.

“ I believe, however, that it (the groove) was alluded to in this specification.” Evidence of Dr. Jones.

This allusion to the groove in the first patent, the learned judge rules, in his charge, to be insufficient, and in the paragraph *ante*, after so holding, he goes on to declare that the groove should have been “ claimed.” It may be mentioned that it is not claimed in the new patent, nor even alluded to in the summary of the specification, so collateral is it to the invention.

The plaintiff in error further assigns for error, in this portion of the charge touching the groove, the learned judge’s decision against the plaintiff’s right to claim under his patent, because of his alleged omission in regard to the groove ; and particularly to the judge’s saying, that, assuming the truth of Dr. Jones’ deposition, the opinion of the court was, that the old patent was “ invalid and inoperative by reason of non-compliance with the requisition of the act of 1793 ; that it did not embrace the groove, which was essential to its validity ; that the new patent is not for the same invention.”

Also, the learned judge’s taking from the jury the question, which came fairly up as a question of fact, namely, whether this mention of, or allusion to, the groove was or was not too slight a description of that part of the combination to enable one skilled as an engineer to make a curve, or to stand for a compliance, by the patentee, with the requisition of the statute touching the proper description of the invention.

Also, the learned judge’s deciding it to be a matter of law, and not of fact for the jury, what the thing patented in 1831 was, when the evidence of what it was lay not in a written paper, which the judge could read and construe, but in parol evidence and explanations *per testes*.

Also, the learned judge’s not giving the due legal effect to the Secretary’s seal and letters patent, as *prima facie* evidence that the second patent legitimately succeeded to the

Argument of counsel.

first, and to his assuming, on the contrary, that it was incumbent on the plaintiff, and not on the defendant, (who assailed it,) to show what the first patent contained, and what its character and defects were ; and in the absence of the patent, and of any notice or call for it by the defendant, and in the absence of any satisfactory account of its contents to the learned judge, making the plaintiff, and not the defendant, responsible for the imperfectness of the proofs regarding the same.

The judge left nothing to the jury, as distinctly appears in his summing up, in regard to the groove, but the question whether Dr. Jones' testimony was to be believed or not. If believed, he told the jury they must find for the defendants, the old patent being defective, in not embracing the groove, and the new patent, which he said did embrace it, being therefore for a different invention altogether.

The plaintiff in error also assigns it for error, that the learned judge ruled "mistake," in the statute about amending patents, to mean inadvertence or accident only, and excluded cases of honest mistakes of judgment.

Mr. Miles, for the defendants in error, filed the following brief :

Abstract of Case.

1. This is a writ of error to the Circuit Court for the Eastern District of Pennsylvania. The plaintiff in the Circuit Court is the plaintiff in error in this court. The verdict in the Circuit Court was for the defendants.

2. The action was brought to recover damages for an alleged infringement by the defendants of an exclusive right, alleged to belong to the plaintiff, to make, use, construct, and vend an improvement "in the mode of turning short curves on railroads," of which he claimed to be the original inventor, and alleged to have been secured to him by letters patent of the United States, according to the acts of Congress.

The plaintiff claimed under letters patent, dated September 26th, 1835, which recited that letters for the improve-

Argument of counsel.

ment were granted to him on August 23d, 1831, but which were "hereby cancelled, on account of a defective specification."

3. The plaintiff declared on the letters patent of September 26th, 1835, in four counts, (only varying in the allegation of different modes of infringement, namely, making, constructing, selling, and using,) all setting forth that "the said letters patent (that is, of August 23d, 1831) were cancelled in due form of law, on account of a defective specification."

4. The defendants pleaded not guilty, gave due notice to the plaintiff, under the acts of Congress, of a defence based upon the want of originality of invention of the thing patented on the part of the plaintiff, under the several patents of 1831 and 1835, said notice including the prior use and knowledge of other persons, and of prior printed and published descriptions of the same, &c., and under such plea and notice gave evidence to the jury.

The original letters of the 23d of August, 1831, were not in evidence, they having been destroyed in the conflagration of the Patent Office in December, 1836, nor was there any copy of them given in evidence.

Their loss or destruction having been proved, secondary evidence was given of their contents. (Journal of Franklin Institute, vol. 9, p. 124, No. 37; and by deposition of Dr. Thomas P. Jones.)

The claim by this evidence, under the patent of 1831, was "to the application of the flanches of railroad carriage-wheels to turn short curvatures upon railroads or tracks, particularly turning the corners of streets, wharves, crossings of tracks or roads, and passing over turnabouts," &c. No mention was made therein of the use of a groove upon the inner circle for the flanch to run in, so as to enable the wheel on the inner circle to run on its tread, without which there was evidence tending to show that the whole alleged invention was useless.

The claim under the patent of 1835 was to "the application of the flanches of the wheels on one side of railroad

Argument of counsel.

carriages, and of the treads of the wheels on the other side, to turn curves upon railways," &c., "operating upon the principles herein set forth." The specification referred to in this summary describes the use of the flanch running on the surface of the outer rail, and of the tread running on the inner rail, which is formed with a groove to receive the flanch of the wheel on the inner rail, as the essential parts which, combined together, form the improvement.

5. Upon the trial, several questions of law and of fact arose. His honor, Mr. Justice BALDWIN, charged the jury upon the law, and left the facts falling within the scope of the principles of the law, as laid down by him, to the determination of the jury.

Points of law, arising under the charge, contended for by defendants.

The third section of the act of 21st February, 1793, in substance, provides that the applicant for a patent shall give a description, in full, clear, and exact terms, of the thing invented, and its modes of application.

By the sixth section of the same act, a defendant in a suit brought on letters patent may show that the description (that is, specification) does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the desired effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing secured by patent was not originally discovered by the patentee, &c.

The third section of the act of July 3, 1832, provides, in substance, that if any patent shall be invalid or inoperative by reason of non-compliance with the terms of the third section of 1793, by "inadvertence, accident, or mistake," and "without any fraudulent or deceptive intention," it may be lawful for the Secretary of State, on surrender of the original patent, to grant a new patent, on compliance with the conditions of the third section of the act of 1793, for the residue of the term unexpired.

The thirteenth and fifteenth sections of the act of 4th July, 1836, which supplied the former laws enacted on the

Argument of counsel.

subject, contain in substance the same provisions as to the inoperation of a patent by reason of the defective description, and allowing a surrender and regrant where the defect arose from "inadvertency, accident, or mistake, and without any fraudulent or deceptive intention."

The seventh section of the act of March 3, 1839, provides "that every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, &c., prior to the application by the inventor, &c., for a patent," may use and vend it at all times, without liability to the inventor, or any person, &c.

Under these acts, the following points are submitted to have been judicially decided :

1. That where a patentee, under the act of February 21, 1793, has not complied with the terms of its third section, even through inadvertence, accident, or mistake, the plaintiff cannot recover for an infringement prior to a surrender and new grant. *Grant v. Raymond*, 6 Peters, 244 ; *Shaw v. Cooper*, 7 Peters, 320 ; *Whitney v. Emmett*, 1 Bald. 303.

2. That if the patentee, under the act of 1793, has not complied with the terms of its third section, through fraudulent and deceptive intention, by the concealment of or addition to his real discovery, his patent, by the sixth section, is absolutely void. *Grant v. Raymond*, 6 Peters, 246, 247 ; *Whitney v. Emmett*, 1 Bald. 303.

3. (1.) That a surrender, under the act of 1832, and a new grant, are only sustainable where the defect in the description of the first patent was the result of inadvertence, accident, or mistake. *Grant v. Raymond*, 6 Peters, 246, 247. (2.) That a new grant, on such a surrender, is not sustainable, but is absolutely void, if it appear that the defect in the description of the first patent, whether of concealment or addition, was the result of a fraudulent and deceptive intention on the part of the patentee. (3.) That if a patentee surrendered his first patent, and, under pretence of an inadvertence, accident, or mistake in its description, obtained a new patent, adding thereto a new material or element of which he was not the original inventor, and

Argument of counsel.

which is necessary to make the thing patented useful, thus in the second patent specifying another combination, constituting a mode or a machine substantially different from that described and claimed in the first, it is fraud in the patentee, and the patent is void. *Grant v. Raymond*, 6 Peters, 218, 244; *Philadelphia Railroad v. Stimpson*, 14 Peters, 462; *Shaw v. Cooper*, 7 Peters, 292.

Note. The act of 1832, (July 3d,) authorizing a surrender and regrant, shortly followed the decision in *Grant v. Raymond*, 6 Peters, (January Term, 1832,) and, by express enactment, provided for that which had before been allowed by practice and judicial construction only.

4. That an original patent, as well as that granted on a surrender of the first under these acts, are *prima facie* evidence only of the novelty and utility of the alleged invention, and of the compliance by the patentee with the terms of the several acts of Congress entitling him to a patent; but their validity is examinable in a judicial proceeding upon any such patent, part of the inquiry being within the province of the court, where the construction of written documents is to be made, and part being for the determination of the jury, where questions of fact are involved. *Grant v. Raymond*, 6 Peters, 218; *Shaw v. Cooper*, 7 Peters, 292; *Philadelphia Railroad v. Stimpson*, 14 Peters, 448; *Prouty v. Ruggles*, 16 Peters, 336.

5. If a patentee's first patent be inoperative, for want of a full and exact description, and he stands by for a long and unreasonable period of time, without surrendering and remedying the defect, by furnishing such a description and obtaining a regrant, and in the meantime permits others to use what he subsequently claims to be his invention, with a knowledge of such use, without objection or asserting his right, this is evidence from which a jury may infer his acquiescence and abandonment to the public as a matter of fact. *Shaw v. Cooper*, 7 Peters, 320-322.

6. Under the act of 1839, if the defendants purchased or constructed this mode of turning curves before the application for the patent of 1835, and this combination or mode

Opinion of the court.

described in that patent was newly invented by the patentee, the plaintiff cannot recover, notwithstanding the act of 1839 was subsequent to the dates of such purchase or construction, and the patent of 1835. *Shaw v. Cooper*, 7 Peters, 320-322; *McClurg v. Kingsland*, 1 How. 204; *Evans v. Jordan*, 9 Cranch, 201.

Note 1. This statute was intended to provide expressly, and in terms, (designating a specific point of time,) for all that class of cases of implied acquiescence and waiver in favor of the public, resulting from the negligence of the patentee, by which judicial construction held that the patentee had no claim against persons using or constructing the alleged invention under such circumstances.

Note 2. This action was brought in the Circuit Court after the passage of the act of 1839, to wit, at the October session, 1840.

The charge of the court left all the facts falling within the scope of the legal principles therein stated to the determination of the jury.

1. "The question of the validity of the new patent is a judicial one, depending on the fact of inadvertence or fraud, as you shall find it." "You must then be satisfied affirmatively," &c. "The finding of the fact of inadvertence may negative the fact of fraud," &c.

2. "It was then submitted to the jury, whether, on the evidence aforesaid, the omission in the patent of 1831 arose from inadvertence," &c.

3. "Depositions are considered merely as oral testimony. A jury must decide what facts are proved by them; * * * a mixed question of law and fact: of law, so far as depends on written, and of fact, as to parol, evidence," &c.

4. "It is for you to say whether you will take the evidence as we do. If you discredit it, in whole or in part, you will find accordingly."

Mr. Justice M'LEAN delivered the opinion of the court.

The plaintiff brought an action against the defendant for an infringement of his patent for a "new and useful im-

Opinion of the court.

provement in the mode of turning short curves on railroads." The questions for decision arise on exceptions to the charge of the court to the jury. And here it may be proper to remark that the exceptions are to the charge as published at length, and not to the points ruled by the court, as is the correct practice. Under the peculiar circumstances of this case, the court will not dismiss the writ of error upon this ground, but it is expected that a different course will hereafter be pursued.

On the 21st of August, 1831, the plaintiff obtained a patent for an invention or improvement in the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn short curves upon railroads. The specification of this patent being defective, it was surrendered the 26th of September, 1835, and a renewed one obtained, in order, as proved, "to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts, and to define the subject-matter of the patent more clearly, without its being necessary to refer to that, simultaneously obtained, for forming or using cast or wrought iron plates," &c.

In his charge, the judge said to the jury: "It clearly appears that the defendants constructed their railroad with the plaintiff's curves, in 1834, one year or more before the plaintiff's application for his renewed patent; consequently, they may continue its use, without liability to the plaintiff."

The patent was surrendered, and a new one obtained, under the third section of the "Act concerning Patents," of the 3d of July, 1832, and the correctness of the above opinion is to be ascertained by a reference to the proviso of that section. It is there declared: "No public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in

Opinion of the court.

any manner, prejudice his right of recovery for any use or violation of his invention, after the grant of such new patent as aforesaid."

The charge of infringement, in the declaration, is laid some years after the new patent ; so that the question does not arise, whether an action could be sustained for a violation of the right prior to the corrected patent. The above proviso would seem to be susceptible of but one construction, and that is, that the patentee may sustain an action "for any use or violation of his invention after the grant of a new patent." Now, it is plain that no prior use of the defective patent can authorize the use of the invention after the emanation of the renewed patent under the above section. To give to the patentee the fruits of his invention, was the object of the provision ; and this object would be defeated, if a right could be founded on a use subsequent to the original patent, and prior to the renewed one.

The thirteenth section of the act of the 4th of July, 1836, which remodelled the Patent Law in this respect, made no material change in the act of 1832. The words in the latter act are : " And the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent." Now, any person using an invention protected by a renewed patent, subsequently to the date of this act, is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent.

The Circuit Court relied upon the seventh section of the act of the 3d of March, 1839, as sustaining their construction in regard to the use of the invention after the renewed patent. But that section has exclusive reference to an original application for a patent, and not to a renewal of it. We think the court erred in their instruction to the jury, above stated.

In their charge, the court said : " The use of grooves was

Opinion of the court.

not claimed, and was no part of the thing patented in 1831, for turning short curves, but was a part of the thing patented in 1835." "That it was an essential part of the invention." And further, "in taking the statement" of Dr. Jones, "as proof of the facts there existing, our opinion is, that, connected with the publication in the Journal of the Franklin Institute, in 1832, when the matter was fresh in his recollection, and the specification in the new patent, the old one was invalid and inoperative, by reason of non-compliance with the requisites of the act of 1793; that it did not embrace the groove, which was essential to its validity; that the new patent is not the same invention, and that the plaintiff has not made out a case of such 'inadvertence, accident, or mistake,' as justified the issue of the new patent, inasmuch as it appears, from the patent for plates on railroads, issued at the same time with the one for short curves, that he had known and described the grooves."

The original patent, as proved by Dr. Jones, was burnt with the Patent Office, and no part of the specifications is preserved, except that which was published by the witness in the Franklin Journal. That publication does not purport to give the whole of the specifications, and, consequently, the claim is not limited by the notice in that journal. Doctor Jones, speaking of the patent issued in 1831, says: "The main defect, in my judgment, of the original specifications in the patent for turning short curves, was the omission of the mention of the groove in the inner rail. I believe, however, that it was alluded to in the specifications, but the description of it was contained principally, if not wholly, in the specification of the patent for forming and using cast-iron or wrought plates," &c.

That there was a defect in regard to the grooves in the specifications of the first patent, is shown, and, also, that the patent was surrendered in order to remedy that defect. But whether this vitiated the patent, is not a question in this case, as it does not affect the right now asserted, if the first patent were void. Whether the new patent was sub-

Opinion of the court.

stantially for a different invention from the first one, was a question for the jury on the evidence. But the court ruled this point, withdrawing the facts from the jury. The witness thinks "that in the first patent the grooves were alluded to," but the terms used are not recollected by him; and, as the patent has been burnt, they cannot now be proved. We think the Circuit Court erred in not leaving the jury to act upon the facts, as regards the difference between the original and the renewed patent. On the facts, we should draw a different conclusion from that which was given to the jury by the Circuit Court. An allusion to the grooves in this specification, as more particularly described in the other patent, would, at least, show the intention of the patentee, if it did not make good his patent.

By the thirteenth section of the act of 1836, "if the patent shall be inoperative or invalid, by reason of a defective or insufficient description or specification," &c., "if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful" to surrender it, &c. Now, as in granting the renewed patent, the officers of the government act under the above provisions, their decisions must, at least, be considered as *prima facie* evidence that the claim for a renewal was within the statute. But this would not be conclusive against fraud in the surrender and renewal, which, on the evidence, would be a matter for the jury. And we suppose that the inquiry in regard to the surrender is limited to the fairness of the transaction. In whatever manner the mistake or inadvertence may have occurred, is immaterial. The action of the government, renewing the patent, must be considered as closing this point, and as leaving open for inquiry, before the court and jury, the question of fraud only.

The judgment of the Circuit Court is reversed, and the cause remanded to that court, with instructions to award a *venire facias de novo*.

Notes and Citations.

Notes :

2. Act 1832, § 3 ; Act 1836, § 13 ; Act 1837, § 5 ; Act 1870, § 53 ;
R. S., § 4916.

3. Act 1839, § 7 ; Act 1870, § 37 ; R. S., § 4899.

4. Want of identity of original and reissued invention a question
for jury.
Battin *v.* Taggart, 17 How. 74.

5. Act 1836, § 13. See note 2.

Conclusiveness of reissue proceeding :

Grant *v.* Raymond, 6 Pet. 218 [p. 245 *ante*].

Shaw *v.* Cooper, 7 Pet. 292 [p. 286 *ante*].

Seymour *v.* Osborne, 11 Wall. 516.

Klein *v.* Russell, 19 Wall. 433.

Corn Planter Patents, 23 Wall. 181.

Russell *v.* Dodge, 93 U. S. 460.

Powder Co. *v.* Powder Works, 98 U. S. 126.

Ball *v.* Langles, 102. U. S. 128.

See note under Grant *v.* Raymond [p. 245 *ante*].

Patent in suit :

No. . Stimpson, J. August 23, 1831. Rails for Rail-
road Carriages.

Notes and Citations.

OTHER SUITS ON SAME PATENT :

Stimpson *v.* The Railroads, 1847. 1 Wall., Jr. 164 ; 2 Robb. 595.
Stimpson *v.* Balt. & Susquehanna R. R., 1850. 10 How. 329 ;
Fish. Pat. Rep. 479 ; 1 Whit. 535.

Citations :

IN SUPREME COURT OF UNITED STATES :

Brooks *v.* Fiske, Dis. opin., 1853. 15 How. 212 ; Bk. 14, L. ed. 665.
Battin *v.* Taggert, 1854. 17 How. 74 ; Bk. 15, L. ed. 37.
Agawam *v.* Jordan, 1868. 7 Wall. 583 ; Bk. 19, L. ed. 177.
Seymour *v.* Osborne, 1870. 11 Wall. 516 ; Bk. 20, L. ed. 33.

IN CIRCUIT COURTS :

Allen *v.* Blunt, October, 1846. 2 Wood. & Minot, 121 ; 2 Robb. 530.
Blanchard *v.* Haynes, 1848. 6 West. L. J. 82.
French *v.* Rogers, November, 1851. 1 Fish. 133.
Cahoon *v.* Ring, April, 1861. 1 Cliff. 592.
Hussey *v.* Bradley, March, 1863. 5 Blatch. 134 ; 2 Fish. 362.
Howe *v.* Williams, October, 1863. 2 Cliff. 245 ; 2 Fish. 395.
Forbes *v.* Barstow Stove Co., November, 1864. 2 Cliff. 379.
Whitely *v.* Swayne, February, 1865. 4 Fish. 117.
Cahart *v.* Austin, May, 1865. 2 Cliff. 528 ; 2 Fish. 543.
Hoffheins *v.* Brandt, July, 1867. 3 Fish. 218.
Blake *v.* Stafford, September, 1867. 6 Blatch. 195 ; 3 Fish. 294.
Woodward *v.* Dinsmore, February, 1870. 4 Fish. 163.
Jordan *v.* Dobson, September, 1870. 4 Fish. 232 ; 2 Abb. C. C. R. 398 ; 7 Phil. (Penn.) 533.
Parham *v.* Am. Button-hole Overseaming and Sewing Machine Co., April, 1871. 4 Fish. 468 ; 1 Leg. Gaz. Rep. 145.

Notes and Citations.

- Tilghman *v.* Mitchell, August, 1871. 9 Blatch. 18 ; 4 Fish. 615.
Gear *v.* Grosvenor, March, 1873. 1 Holmes, 215 ; 6 Fish. 314 ;
3 O. G. 380.
Jones *v.* Sewall, April, 1873. 3 Cliff. 563 ; 6 Fish. 343 ; 3 O. G.
630.
Henry *v.* Francetown Soapstone Stove Co., January, 1876. 2 Ban.
& Ard. 221 ; 9 O. G. 408.
Thomas *v.* Shoe Machinery M'fg Co., October, 1878. 3 Ban. &
Ard. 557 ; 16 O. G. 541.
Smith *v.* Merriam, January, 1881. 6 Fed. Rep. 713 ; 19 O. G.
601.
Combined Patents Can Co. *v.* Lloyd, January, 1882. 11 Fed. Rep.
149 ; 21 O. G. 713.
McWilliams M'fg Co. *v.* Blundell, February, 1882. 11 Fed. Rep.
419 ; 22 O. G. 177.
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IN CANADIAN COURTS :

- Hunter *v.* Carrick, October, 1884. 10 Ontario App. R. 449.
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IN TEXT-BOOKS :

- 2 Abb. Pat. Law, 1886, pp. 199, 238, 450, 463.
Curt. on Pats., 4th ed., §§ 282, 395*a*, 471*a*.
Walker on Pats., 1883, pp. 156, 182.
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[illegible]

Syllabus.

JAMES G. WILSON, PLAINTIFF, v. LEWIS ROUSSEAU
AND CHARLES EASTON.

4 How. 646-709. Jan., 1846.

[Bk. 11, L. ed. 1140 ; 2 Robb. 373 ; 1 Whit. 357.]

Grant of extension to administrator. Assignee's right to use during extension. Particular reissue sustained. Reissue during extension.

1. Act 1836, § 18, authorized the extension of a patent on the application of the executor or administrator of a deceased patentee (p. 477).
2. The extension of the patent under Act 1836, § 18, is a new grant of the exclusive right for a term of seven years, and all rights of assignees or grantees terminate at the end of the original term and become reinvested in the patentee, and Woodworth's patent inured to the benefit of the administrator only in his said capacity (p. 482).
3. Rule of construction of statutes in cases of obscure and doubtful phraseology (p. 483).
4. Act 1836, §§ 11 and 14. Interest of assignee and grantee considered (p. 485).
5. Assignee's "right to use the thing patented," Act 1836, § 18, during extended term, extends to the specific thing in use at the time of the extension (p. 490).
6. The "thing patented," Act 1836, § 18, is the invention (p. 491).
7. A covenant dated 1829 construed in view of the then established law, and the term "renewal" held not to cover an extension authorized only by Act 1832, subsequent thereto (p. 494).
8. Under Act 1836, § 14, the grantee of an exclusive right to construct, use, and vend to others to use, two machines within a certain town, may maintain an action for infringement in his own name (p. 496).
9. Reissued patent No. 71 granted Woodworth, W., July 8, 1845, for planing mill, held sufficiently full and explicit in its specification and drawings (p. 498).

Statement of the case.

10. The decision of the Board of Commissioners, who are to determine upon the application for the extension under Act 1836, § 18, is not conclusive upon the question of their jurisdiction to act in a given case (p. 498).
11. An extended patent can be reissued at any time during the extended term (p. 498).

[Citations in the opinion of the Court :]

- (1) *McClurg v. Kingsland*, 1 How. 202 [p. 382 *ante*], p. 491.
- (2) *Grant v. Raymond*, 6 Peters, 218 [p. 245 *ante*], p. 495.

[Citations in dissenting opinions :]

- (3) *Brooks v. Bicknell*, 4 McLean, 64, p. 499.
- (4) *Wilson v. Turner*, Taney, 278, p. 507.
- (5) *Dwarris on Statutes*, 692, p. 507.
- (6) *Bac. Abr. Statute, T.*, p. 507.
- (7) 2 Inst. 107, 386, p. 507.
- (8) *Brandling v. Barrington*, 6 Barn. and Cressw. 475, p. 510.
- (9) *McClurg v. Kingsland*, 1 How. 210 [p. 382 *ante*], p. 512.
- (10) *Dwarris*, 658, p. 516.
- (11) *Standen v. University of Oxford*, 1 Jones, 26, p. 516.
- (12) 8 Coke, 118 b., p. 516.
- (13) *Webster's Pat. Cases*, 477, p. 517.
- (14) *Herbert v. Adams*, 4 Mason, 15, p. 519.
- (15) 1 Hawk. P. C. 477, note, p. 519.
- (16) *Woodworth v. Sherman*, 8 Story, 171, p. 520.
- (17) *Van Hook v. Wood.*, p. 520.
- (18) *Wilson v. Curties*, p. 520.
- (19) *Butler's Opinion*. Opin. of Atty. Gen., pp. 1134, 1209, p. 520.
- (20) *Jones v. Smart*, 1 D. and E. 52, pp. 521, 523.
- (21) *Dwarris on Statutes*, 711, p. 521.
- (22) *The King v. The Poor Law Commr.*, 6 Adolph. and Ellis, 7, p. 523.
- (23) *Grant v. Raymond*, 6 Peters, 218, p. 527.
- (24) 1 Sumner, 485, p. 527.
- (25) *Wyeth v. Stone*, 1 Story, 287, p. 527.
- (26) *Blanchard v. Sprague*, 2 Story, 169, p. 527.

THIS case and the three subsequent ones, namely, *Wilson v. Turner*, *Simpson et al. v. Wilson*, and *Woodworth & Bunn v. Wilson*, were argued together, being known as the patent cases. Many of the points of law involved were common to them all, and those which were fully argued in the first case which came up were but incidentally touched in the discussion of the subsequent cases. They all related to the rights which were derived under a patent for a plan-

Statement of the case.

ing machine taken out by Woodworth, and renewed and extended by his administrator. The validity of the original patent was questioned only in one case, namely, that which came from Kentucky, which was the last argued. There were four cases in all, namely, one from New York, one from Maryland, one from Louisiana, and one from Kentucky. In the course of the argument, counsel referred indiscriminately to the four records, as some documents were in one which were not to be found in another.

The cases will be taken up and reported *seriatim*, and the documents which are cited in the first will not be repeated in the others.

The first in order was the case from New York, the titling of which is given at the head of this report.

It came up from the Circuit Court of the United States for the Northern District of New York, on a certificate of division in opinion.

On the 26th of November, 1828, William Woodworth presented the following petition :

“ To the Hon. Henry Clay, Secretary of State of the United States.

“ The petition of William Woodworth, of the city of Hudson, in the county of Columbia, and State of New York, respectfully represents :

“ That your petitioner has invented a new and improved method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, not known or used before the application by him, the advantages of which he is desirous of securing to himself and his legal representatives. He therefore prays that letters patent of the United States may be issued, granting unto your petitioner, his heirs, administrators, or assigns, the full and exclusive right of making, constructing, using, and vending to others to be used his aforesaid new and improved method, agreeably to the acts of Congress in such case made and

Statement of the case.

provided ; your petitioner having paid thirty dollars into the treasury of the United States, and complied with the other provisions of the said acts.

“ November 26, 1828.

WILLIAM WOODWORTH.”

On the 4th of December, 1828, Woodworth executed to James Strong the following assignment :

“ Whereas I, William Woodworth, of the city of Hudson, in the State of New York, heretofore, to wit, on the 13th day of September, 1828, assigned and transferred, for a legal and valuable consideration, the one equal half of all my right, title, claim, and interest in and to the invention or improvement mentioned and intended in the foregoing petition, oath, and specification, to James Strong, of the city of Hudson ;

“ And whereas, also, the subjoined assignment is intended only to convey and assign the same interest transferred and assigned in the assignment of the 13th of September above mentioned, without any prejudice to my one equal half part of said invention or improvement, which is expressly reserved to myself and my legal representatives :

“ Now, know all men, that I, the said William Woodworth, for and in consideration of the sum of ten dollars, and other valuable considerations me moving, have, and do hereby, for myself and legal representatives, give, assign, transfer, and assure to the said James Strong and his legal representatives the one full and equal half of all my right, title, interest, and claim in and to my new and improved method of planing, tonguing, grooving, and cutting into mouldings, either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, mentioned and intended to be secured by the foregoing petition, oath, and specification, together with all the privileges and immunities, as fully and absolutely as I do or shall enjoy or possess the same ; to have and to hold and

Statement of the case.

enjoy the same, to the said James Strong and his legal representatives, do or may.

“ In witness whereof, I have hereunto set my hand and seal, the 4th day of December, 1828.

“ WILLIAM WOODWORTH. [SEAL.]

“ Witnesses : HENRY EVERTS, DAVID GLEASON.”

On the 6th of December, 1828, Woodworth took the following oath :

“ *State of New York, Rensselaer County, ss.:*

“ On this sixth day of December, A.D. 1828, before the subscriber, a justice of the peace in and for the county of Rensselaer aforesaid, personally appeared the aforesaid William Woodworth, and made solemn oath, according to law, that he verily believes himself to be the true and original inventor of the new and improved method, above described and specified, for planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances ; and that he is a citizen of the United States.

‘ JOHN THOMAS, *Justice of the Peace.*’

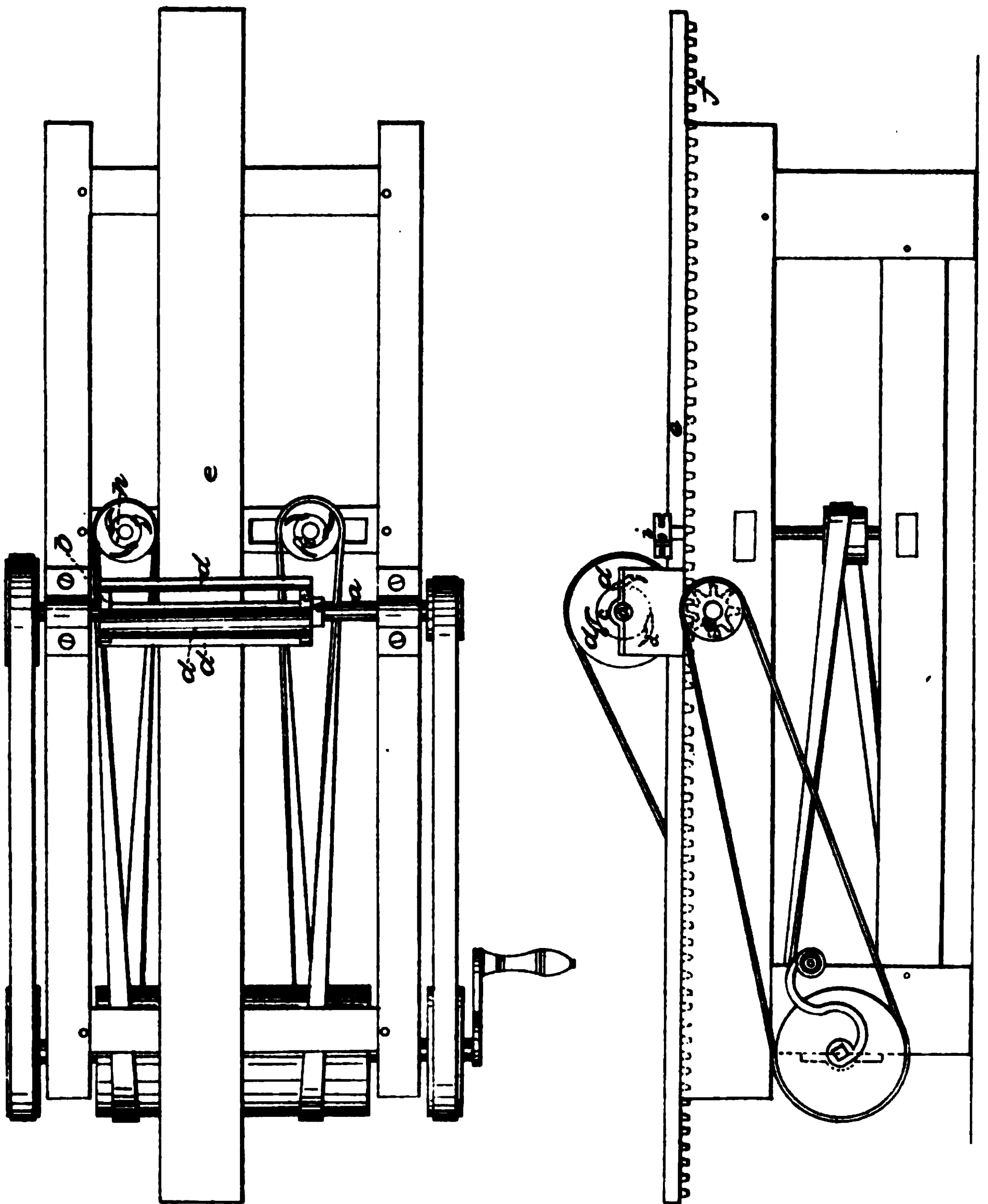
The above documents appear to be recorded in the third volume of Transfers of Patent-Rights, pages 155, 156, in the Patent Office of the United States.

On the 27th of December, 1828, a patent was issued as follows :

“ Letters Patent to W. Woodworth. The United States of America to all to whom these letters patent shall come :

“ Whereas, William Woodworth, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width

W. Woodworth,
Planing and Matching Machine,
Patented Dec. 27, 1828.



Statement of the case.

and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, which improvements, he states, have not been known or used before his application ; hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement ; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvements, and praying that a patent may be granted for that purpose : These are, therefore, to grant, according to law, to the said William Woodworth, his heirs, administrators, or assigns, for the term of fourteen years from the 27th of December, 1828, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said William Woodworth himself, in the schedule hereto annexed, and is made a part of these presents.

“ In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed.

“ Given under my hand, at the city of Washington, this 27th day of December, in the year of our Lord 1828, and of the independence of the United States of America the fifty-third.

[SEAL.]

“ (Signed,)

J. Q. ADAMS.

“ By the President.

“ (Signed,)

H. CLAY, *Secretary of State.*”

Certificate of William Wirt, Attorney-General of the United States.

“ *City of Washington, to wit :*

“ I do hereby certify, that the foregoing letters patent were delivered to me on the 27th day of December, in the year of our Lord 1828, to be examined ; that I have examined the same, and find them conformable to law ; and I do hereby return the same to the Secretary of State,

Statement of the case.

within fifteen days from the date aforesaid, to wit, on this 27th day of December, in the year aforesaid.

“WILLIAM WIRT,
“*Attorney-General of the United States.*”

Schedule.

“The schedule referred to in these letters patent, and making part of the same, containing a description, in the words of the said William Woodworth himself, of his improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances.

“The plank, boards, or other material, being reduced to a width by circular saws or friction-wheels, as the case may be, is then placed on a carriage, resting on a platform, with a rotary cutting-wheel in the centre, either horizontal or vertical. The heads or circular plates, fixed to an axis, may have one of the heads movable, to accommodate any length of knife required; the knife fitted to the head with screws or bolts, or the knives or cutters for moulding, fitted by screws or bolts to logs, connecting the heads of the cylinder, and forming, with the edges of the knives or cutters, a cylinder. The knives may be placed in a line with the axis of the cylinder, or diagonally. The plank or other material, resting on the carriage, may be set so as to reduce it to any thickness required; and the carriage, moving by a rack and pinion, or rollers, or any lateral motion, to the edge of the knives or cutters on the periphery of the cylinder or wheel, reduces it to any given thickness. After passing the planing and reducing wheel, it then approaches, if required, two revolving cutter-wheels, one for cutting the groove, and the other for cutting the rabbets that form the tongue; one wheel is placed directly over the other, and the lateral motion moving the plank or other material between the grooving and rabbeting wheels, so that one

Statement of the case.

edge has a groove cut the whole length, and the other edge a rabbet cut on each side, leaving a tongue to match the groove. The grooving-wheel is a circular plate, fixed on an axis, with a number of cutters attached to it, to project beyond the periphery of the plate, so that when put in motion it will perform a deep cut or groove, parallel with the face of the plank or other material. The rabbeting-wheel, also of similar form, having a number of cutters on each side of the plate, projecting like those on the grooving-wheel, cuts the rabbet on the side of the edge of the plank, and leaves the tongue or match for the groove. By placing the planing-wheel axis and cutter-knives vertical, the same wheel will plane two planks or other material in the same time of one, by moving the plank or other material opposite ways, and parallel with each other, against the periphery of the planing or moulding wheel. The groove and tongue may be cut in the plank or other material at the same time, by adding a grooving and rabbeting-wheel.

“ Said William Woodworth does not claim the invention of circular saws or cutter-wheels, knowing they have long been in use ; but he claims as his invention the improvement and application of cutter or planing wheels to planing boards, plank, timber, or other material ; also his improved method of cutters for grooving and tonguing, and cutting mouldings on wood, stone, iron, metal, or other material, and also for facing and dressing brick ; as all the wheels may be used single and separately for moulding, or any other purpose before indicated. He also claims, as his improved method, the application of circular saws for reducing floor-plank and other materials to a width.

“ Dated Troy, December 4, 1828.

“ WILLIAM WOODWORTH.

“ Witnesses : HENRY EVERTS, D. S. GLEASON.”

On the 25th of April, 1829, one Uri Emmons obtained a patent for a new and useful improvement in the mode of planing floor-plank, and grooving and tonguing and straightening the edges of the same, planing boards,

Statement of the case.

straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing machine ; the said letters patent, and specification attached thereto, being in the following words and figures :

Uri Emmons' Patent.

“ United States of America to all to whom these letters patent shall come :

“ Whereas, Uri Emmons, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the mode of planing floor-plank, and grooving and tonguing the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called ‘ the cylindrical planing machine,’ which improvement, he states, has not been known or used before his application ; hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement ; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose : These are, therefore, to grant, according to law, to the said Uri Emmons, his heirs, administrators, or assigns, for the term of fourteen years from the twenty-fifth day of April, one thousand eight hundred and twenty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said Uri Emmons himself, in schedule hereto annexed, and is made a part of these presents.

“ In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed.

“ Given under my hand, at the city of Washington, this twenty-fifth day of April, in the year of our Lord one thousand eight hundred and twenty-nine, and of the in-

Statement of the case.

dependence of the United States of America the fifty-third.

[SEAL.]

“(Signed,)

ANDREW JACKSON.

“By the President.

“(Signed,)

M. VAN BUREN.’

“*City of Washington, to wit:*

“I do hereby certify that the foregoing letters patent were delivered to me on the twenty-fifth day of April, in the year of our Lord one thousand eight hundred and twenty-nine, to be examined; that I have examined the same, and find them conformable to law; and I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit, on the twenty-fifth day of April, in the year aforesaid.

“(Signed,)

J. MACPHERSON BERRIEN,

“*Attorney-General of the United States.*”

Schedule.

“The schedule referred to in these letters patent, and making part of the same, containing a description, in the words of the said Uri Emmons himself, of his improvement in the mode of planing floor-plank, and grooving and tonguing and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing machine.

“The machinery for the improvement consists—

“1st. Of a frame of wood or metal.

“2d. Of the gear and fixtures combined and connected together for the above-named operation, the principle of which consists in running the plank, boards, or timber over, under, or at the sides of a cylinder of wood or metal, on which knives are placed, straight or spiral, with their edges exactly corresponding with each other, having from two to twelve knives or edges; also burrs or saws, similar to those used for cutting teeth in brass wheels, to groove and tongue the edge of the boards or plank as they pass through between rollers, or on a carriage, by the surface of

Statement of the case.

the cylinder. The shape, form, and construction of the above principle may be varied in shape and position, dimensions, &c., still the same in substance,—the same principle producing the same effect. I have, by experimental operation, found that the following mode, in form, is the best :

“1st. A frame composed of two pieces of timber, from twelve to eighteen feet long, about six to ten inches broad, placed about fifteen inches apart, framed together with four girths, one at each end, and at equal distances from the centre, and flush with the under side. This frame is supported by posts of a proper length, framed into the under side of the above pieces of timber, and braced so as to be of sufficient strength to maintain the operative posts. There is placed a roller in the centre, of metal or hard wood, across the frame, the surface of the roller being even with the surface of the frame ; directly above and parallel with this roller is hung the cylinder, with two or four spiral edges or knives, six to ten inches diameter and hung on a cast-steel arbor, resting in movable boxes attached to the sides of the frame, so as to set the cylinder up and down from the roller, to give the thickness of the timber to be planed. On each side of the cylinder is placed a pair of feeding-rollers, of hard wood or metal, the under one of each pair being level with the centre one. The upper ones are hung in boxes, which are pressed down with springs or weights, so that, when the timber comes between them, they will hug and carry it through. These rollers are connected and turned by wheels, at a velocity of about twelve feet surface of the roller per minute ; the cylinder, with two edges, to make about two thousand five hundred revolutions per minute, cutting five thousand strokes every twelve feet. This can be varied, according to the number of edges, power, and velocity of the different parts. The power is attached to the cylinder by a bolt running on a pulley, on the outward end of the cylinder shaft. Each way from the feeding-rollers is placed rollers, about two feet apart, for the timber to rest on while running through.

Statement of the case.

On one side of the frame is fastened a straight edge, to serve as a guide, lined with metal; on the other side, rollers are placed in a piece of timber, which is pressed up to the plank or board, to keep it close to the guide or straight edge, by a spring. The grooving and tonguing is done by burrs or circular cutters similar to a saw; these burrs are hung on perpendicular spindles, the arbors of which rest in boxes attached to the inward side of the frame, a burr on one side to cut the groove, and on the other is placed two burrs, just as far apart as the thickness of the above one, for cutting the groove. At or near one end of the frame is hung a shaft, with a drum or roller, from which belts pass over to pulleys on each spindle of the burrs or circular cutters, which must have about the same velocity of the cylinder. These burrs are placed on one side of the cylinder, opposite to each other, so as to cut the tongue to match the groove; on the other side of the cylinder is an arbor parallel with the cylinder, on which is placed circular cutters, for planing the edges of the board or plank as they pass through. The cutter on the side next to the guide is stationary on the arbor; the opposite one is movable in the arbor, but fastened with screws, to set it for different widths. A belt runs from a pulley on the end of the arbor, outside the frame, to the said drum, as also the same from the cylinder, each having about the same motion. The feeding-rollers are put in motion by a belt from the slow part of the driving power. I have also put in operation a carriage for feeding, but rollers save the time of running the carriage back.

“ Now, what I, the said Uri Emmons, consider and claim as my improvement, and for which I solicit a patent, is as follows, namely :

“ 1st. The principle of planing boards and plank with a rotary motion, with knives or edges on a cylinder, placed on the same, straight or spiral, as before described, which I put in operation at Syracuse, in the county of Onondaga, in the State of New York, in the early part of the year 1824.

“ 2d. The burrs for grooving and tonguing, in contradis-

Statement of the case.

inction from the mode used by William Woodworth, he using the duck-bill cutters.

“ 3d. The feeding, by running the timber through on a carriage, or between feeding-rollers, guided by a straight edge, as before described.

“ In testimony that the foregoing is a true specification of my said improvement, as before described, I have hereunto set my hand and seal, the eighth day of April, in the year of our Lord one thousand eight hundred and twenty-nine.

“ (Signed,)

URI EMMONS.

“ Witnesses : THOS. THOMAS, SILAS HATHAWAY.”

On the 16th of May, 1839, the said Emmons sold his entire interest in the last-mentioned patent to Daniel H. Toogood, Daniel Halstead, and William Tyack, by the following instrument :

Deed from Emmons to Toogood, Halstead, and Tyack.

“ Whereas, Uri Emmons, of the State of New York, machinist, has received letters patent of the United States of America, dated April 25th, one thousand eight hundred and twenty-nine, [for] the full and exclusive right and liberty of making, constructing, using, and vending to others to be used a new and useful improvement in the mode of planing floor-plank, and grooving and tonguing and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing-machine :

“ Now, know all men by these presents, that I, Uri Emmons, of the city of New York, in consideration of five dollars to me in hand paid by Daniel H. Toogood, Daniel Halstead, and William Tyack, all of said city of New York, who fully viewed and considered the said improvement, and the said patent and specifications therein contained, have granted, sold, and conveyed, and by these presents do grant, sell, and convey, to the said Daniel H. Toogood, Daniel Halstead, and William Tyack, their heirs, executors, administrators, and assigns, the full and exclusive right

Statement of the case.

and liberty derived from the said patent, of making, using, and vending to others to be made, used, and sold the said improvement, within and throughout the United States of America. To have and to hold and enjoy all the privileges and benefits which may in any way arise from the said improvement by virtue of said letters patent. And I do hereby empower the said Daniel H. Toogood, Daniel Halstead, and William Tyack, their heirs, executors, administrators, and assigns, to commence and prosecute to final judgment and execution, at their own cost, any suit or suits against any person or persons who shall make, use, or vend the said improvement, contrary to the intent of the said letters patent and law in such case made and provided, and to receive, for their own benefit, the avails thereof, in such manner as I might do.

“ In witness whereof, I have hereunto set my hand and seal, this sixteenth day of May, in the year of our Lord one thousand eight hundred and twenty-nine.

“ URI EMMONS. [SEAL.]

“ Witnesses : THOMAS AP THOMAS, ALEX. DEDDER.”

“ *City and County of New York, ss.:*

“ Be it remembered, that on the sixteenth day of May, in the year of our Lord one thousand eight hundred and twenty-nine, before me personally appeared Uri Emmons, known to me to be the person described in and who executed the within deed, and acknowledged that he executed the same for the purposes therein mentioned ; and there being no material alterations, erasures, or interlineations, I allow the same to be recorded.

“ THOMAS THOMAS, *Commissioner, &c.*”

On the 28th of November, 1829, the following mutual deed of assignment was executed between Woodworth and Strong, on the one part, and Toogood, Halstead, Tyack, and Emmons, on the other part, by which Woodworth and Strong convey to Toogood, Halstead, and Tyack all their interest in the patent of December 27th, 1828, in the follow-

Statement of the case.

ing places, namely : In the city and county of Albany, in the State of New York ; in the State of Maryland, except the western part which lies west of the Blue Ridge ; in Tennessee, Alabama, South Carolina, Georgia, the Floridas, Louisiana, Missouri, and the territory west of the Mississippi ;—and Toogood, Halstead, Tyack, and Emmons conveyed to Strong and Woodworth all their interest in Emmons' patent of 25th April, 1829, for the rest and residue of the United States ; by which mutual deed of assignment the parties agreed that any improvement in the machinery, or alteration or renewal of either patent, such improvement, alteration, or renewal should accrue to the benefit of the respective parties in interest, and might be applied and used within their respective districts.

Mutual Deed between Woodworth, Strong, Toogood, Halstead, Tyack, and Emmons.

“ Know all men by these presents, that William Woodworth, now of the city of New York, the patentee of an improved method of planing, tonguing, grooving, &c., plank, boards, &c., by letters patent from the United States, dated December 29th, 1828, and James Strong, of the city of Hudson, in the State of New York, the assignee of one equal half of the rights and interests secured by the aforesaid letters patent, of the one part, and Uri Emmons, of the city of New York, the patentee of an improvement in the mode of planing floor-plank, and grooving, tonguing, and straightening the edges of the same, &c., by letters patent from the United States, dated April 25th, 1829, and Daniel H. Toogood, Daniel Halstead, and William Tyack, of the city of New York, the assignees, by deed dated the 16th day of May, 1829, of all the rights and interest secured by the last aforesaid patent to said Emmons, of the other part, in consideration of the following covenants and agreements, do hereby covenant and agree as follows :

“ First. The said Woodworth and Strong, and their assigns, have, and hereby do assign to the said Toogood,

Statement of the case.

Halstead, and Tyack, and their assigns, all their right and interest in the aforesaid patent to William Woodworth, to be sold and used, and the plank or other materials prepared thereby to be vended and used, in the following places, namely : In the city and county of Albany, in the State of New York ; in the State of Maryland, except the western part thereof which lies west of the Blue Ridge ; in Tennessee, Mississippi, Alabama, South Carolina, Georgia, the Floridas, Louisiana, and the territory west of the river Mississippi, and not in any other State or place within the limits of the United States or the Territories thereof. To have and to hold the rights and privileges hereby granted to them and their assigns for and during the term of fourteen years from the date of the patent. And they are also authorized to prosecute, at their own costs and charges, any violation of the said patent, in the same manner as the patentee, Woodworth, might lawfully do.

“ Secondly. The said Emmons, Toogood, Halstead, and Tyack, in consideration aforesaid, have, and hereby do covenant and agree to assign, and do assign, for themselves and assigns, to the said Woodworth and Strong and their assigns, all their right and interest in the aforesaid patent granted to the said Uri Emmons, to be sold and used, and the plank or other material prepared thereby to be vended and used, in all and singular the rest and residue of the United States and the Territories thereof ; that is to say, in all places other than in those especially assigned to the said Toogood, Halstead, and Tyack, as aforesaid. To have and to hold the said rights and privileges hereby granted to them and their assigns for and during the term of fourteen years from the date of the said letters patent to the said Uri Emmons. And they are also authorized to prosecute, at their own costs and charges, any violation of the said patent, in the same manner as the patentee, Uri Emmons, might lawfully do.

“ Thirdly. And the two parties further agree, that any improvement in the machinery, or alteration or renewal of either patent, such alteration, improvement, or renewal

Statement of the case.

shall accrue to the benefit of the respective parties in interest, and may be applied and used within their respective districts, as hereinbefore designated.

“ Witness our hands and seals, at the city of New York, the 28th of November, 1829.

“ WILLIAM WOODWORTH. [SEAL.]

“ JAMES STRONG. [SEAL.]

“ WILLIAM TYACK. [SEAL.]

“ D. H. TOOGOOD. [SEAL.]

“ DANIEL HALSTEAD. [SEAL.]

“ URI EMMONS. [SEAL.]

“ Sealed and delivered in presence of THOMAS AP THOMAS, witness to the signing of Toogood, Tyack, Halstead, and Emmons.”

Under this mutual assignment, the respective parties and their assignees would possess the following rights, namely : If they claimed under Woodworth's patent, to use the same for fourteen years from the 29th of December, 1828, that is to say, until the 29th of December, 1842 ; and if they claimed under Emmons' patent, to use the same for fourteen years from the 25th of April, 1829, that is to say, until the 25th of April, 1843.

On one or the other of these days, therefore, if things had remained in the same condition, all rights, either in the patentees or their assignees, would have ceased, as far as respected an exclusive use of the thing patented.

In 1836, Congress passed an act from which the following is an extract, and the construction of which was the chief controversy (Act approved July 4th, 1836, ch. 357, 5 Little & Brown's ed., 117, sec. 18) : “ And be it further enacted, that whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof ; and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a

Statement of the case.

patent, cause to be published, in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them, both for and against the extension, and shall sit, for that purpose, at the time and place designated in the published notice thereof. The patentee shall furnish to the said board a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear, to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault upon his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the term,—which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office ; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein : Provided, how-

. Statement of the case.

ever, that no extension of a patent shall be granted after the expiration of the term for which it was originally issued.”

On the 3d of February, 1839, William Woodworth, the patentee, died ; and on the 14th of February, 1839, William W. Woodworth took out letters of administration upon his estate, in the county of New York.

In 1842, William W. Woodworth, the administrator, applied for an extension of the patent under the above-recited act of 1836, and on the 16th of November, 1842, the board issued the following certificate :

“ In the matter of the application of William W. Woodworth, administrator of the estate of William Woodworth, deceased, in writing, to the Commissioner of Patents, for the extension of the patent for a new and useful improvement in the method of planing, tonguing, and grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, granted to the said William Woodworth, deceased, on the 27th day of December, 1828, for fourteen years from said 27th day of December.

“ The applicant having paid into the treasury the sum of forty dollars, and having furnished to the undersigned a statement in writing, under oath, of the ascertained value of the invention, and of the receipts and expenditures thereon, sufficiently in detail to exhibit a true and faithful account of loss and profits in any manner accruing to said patentee from or by reason of said invention ; and notice of application having been given by the Commissioner of Patents according to law, said board met at the time and place appointed, namely, at the Patent Office, on the 1st September, 1842, and their meetings having been continued by regular adjournments until this 16th day of November, 1842, they, on that day, heard the evidence produced before them, both for and against the extension of said patent, and do now certify, that, upon hearing of the

Statement of the case.

matter, it appears, to their full and entire satisfaction, having due regard to the public interest therein, that it is just and proper that the term of the said patent should be extended, by reason of the patentee, without neglect on his part, having failed to obtain from the use and sale of his invention a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use.

“ Washington City, Patent Office, November 16th, 1842.

DANIEL WEBSTER,

Secretary of State.

CHAS. B. PENROSE,

Solicitor of the Treasury.

HENRY L. ELLSWORTH,

Commissioner of Patents.”

And on the same day the Commissioner of Patents issued the following certificate :

“ Whereas, upon the petition of William W. Woodworth, administrator of the estate of William Woodworth, deceased, for an extension of the within patent, granted to William Woodworth, deceased, on the 27th day of December, 1828, the Board of Commissioners, under the eighteenth section of the act of Congress approved the 4th day of July, 1836, entitled ‘ An act to promote the progress of useful arts, to repeal all acts and parts of acts heretofore made for that purpose,’ did, on the 16th day of November, 1842, certify that the said patent ought to be extended :

“ Now, therefore, I, Henry L. Ellsworth, Commissioner of Patents, by virtue of the power vested in me by said eighteenth section, do renew and extend said patent, and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, namely, the 27th day of December, 1842, which certificate of said Board of Commissioners, together with this certificate of the Commissioner of Patents, having been duly entered of record in the Patent Office, the said pat-

Statement of the case.

ent now has the same effect in law as though the term had been originally granted for the term of twenty-one years.

“In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 16th day of November, 1842.

[SEAL.]

“HENRY L. ELLSWORTH,
“*Commissioner of Patents.*”

On the 2d of January, 1843, William W. Woodworth, the administrator, filed the following disclaimer :

“To all men to whom these presents shall come : I, William W. Woodworth, of Hyde Park, in the county of Dutchess, and State of New York, Esq., as I am administrator of the goods and estate which were of William Woodworth, deceased, hereinafter named, send greeting :

“Whereas letters patent, bearing date on the twenty-seventh day of December, in the year of our Lord eighteen hundred and twenty-eight, were granted by the United States to Wm. Woodworth, now deceased, for an improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either boards, plank, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances ; and whereas, before the term of fourteen years, for which the said letters patent were granted, had fully expired, such proceedings were had that, pursuant to the act of Congress in such case made and provided, the said letters patent were renewed or extended for the term of seven years from and after the expiration of the said term of fourteen years, and to the certificate granting the said extension and renewal unto me, in my said capacity, bearing date on the sixteenth day of November now last past, and which is duly recorded according to act of Congress in that behalf, reference is hereby made, as showing my title and interest in and to the said letters patent ;

Statement of the case.

“ And whereas the said William Woodworth, through inadvertence, accident, or mistake in his application for letters patent, made his specification of claim too broad, in this, namely, that he, the said William Woodworth, claimed as his improved method the application of circular saws for reducing floor-plank and other material to width, of which he was not the original and first inventor; and whereas some material and substantial part of the said patented thing was justly and truly the invention and improvement of the said William Woodworth :

“ Now, therefore, know ye, that I, the said William W. Woodworth, in my capacity aforesaid, and as the person to whom the said certificate was granted as aforesaid, have disclaimed, and do by these presents, for myself and for all claiming under me, disclaim, all and any exclusive right, title, property, or interest of, in, or to the application of circular saws for reducing floor-plank or other materials to a width, by reason of the aforesaid letters patent, and the aforesaid renewal or extension thereof.

“ In testimony whereof, I have hereto, in my capacity aforesaid, set my hand and seal, on this second day of January, in the year eighteen hundred and forty-three.

[SEAL.]

“ WILLIAM W. WOODWORTH,

“ *Administrator of W. Woodworth, deceased.*

“ Executed in presence of CHAS. W. EMESN, B. R. CURTIS.”

In March, 1843, Woodworth, the administrator, made an assignment of his patent-rights in some of the States to James G. Wilson, the plaintiff. At what time the assignment was made for New York, the record in that case did not state; but it was one of the admitted facts that he was the grantee. The assignment first referred to was recorded in the Patent Office, in Liber 4, pages 291, 292, on the 20th of March, 1843.

On the 9th of August, 1843, the administrator assigned his right to Wilson in and for the State of Maryland.

On the 26th of February, 1845, Congress passed the following act :

Statement of the case.

"An Act to extend a Patent heretofore granted to William Woodworth.

"Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the patent granted to William Woodworth on the twenty-seventh day of December, in the year one thousand eight hundred and twenty-eight, for his improvement on the method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on and facing several other substances, a description of which is given in a schedule annexed to the letters patent granted as aforesaid, be, and the same is hereby, extended for the term of seven years from and after the 27th day of December, in the year one thousand eight hundred and forty-nine; and the Commissioner of Patents is hereby directed to make a certificate of such extension, in the name of the administrator of the said William Woodworth, and to append an authenticated copy thereof to the original letters patent, whenever the same shall be requested by the said administrator or his assigns.

"Approved February 26, 1845.

"A true copy from the roll of this office.

"R. K. CRALLE, *Chief Clerk.*

"*Department of State, March 3, 1845.*"

And on the 3d of March, 1845, the following certificate was issued:

"In conformity, therefore, with the directions in the said act contained, I, Henry L. Ellsworth, Commissioner of Patents, do hereby certify that the patent therein described is, by the said act, extended to William W. Woodworth, administrator of said William Woodworth, for the term of seven years from and after the twenty-seventh day of December, in the year one thousand eight hundred and forty-nine; and this certificate of such extension is made on the original letters patent, on the application of William

W. Woodworth,

Wood Planing Machine,

No 71,

Reissued July 8, 1845.

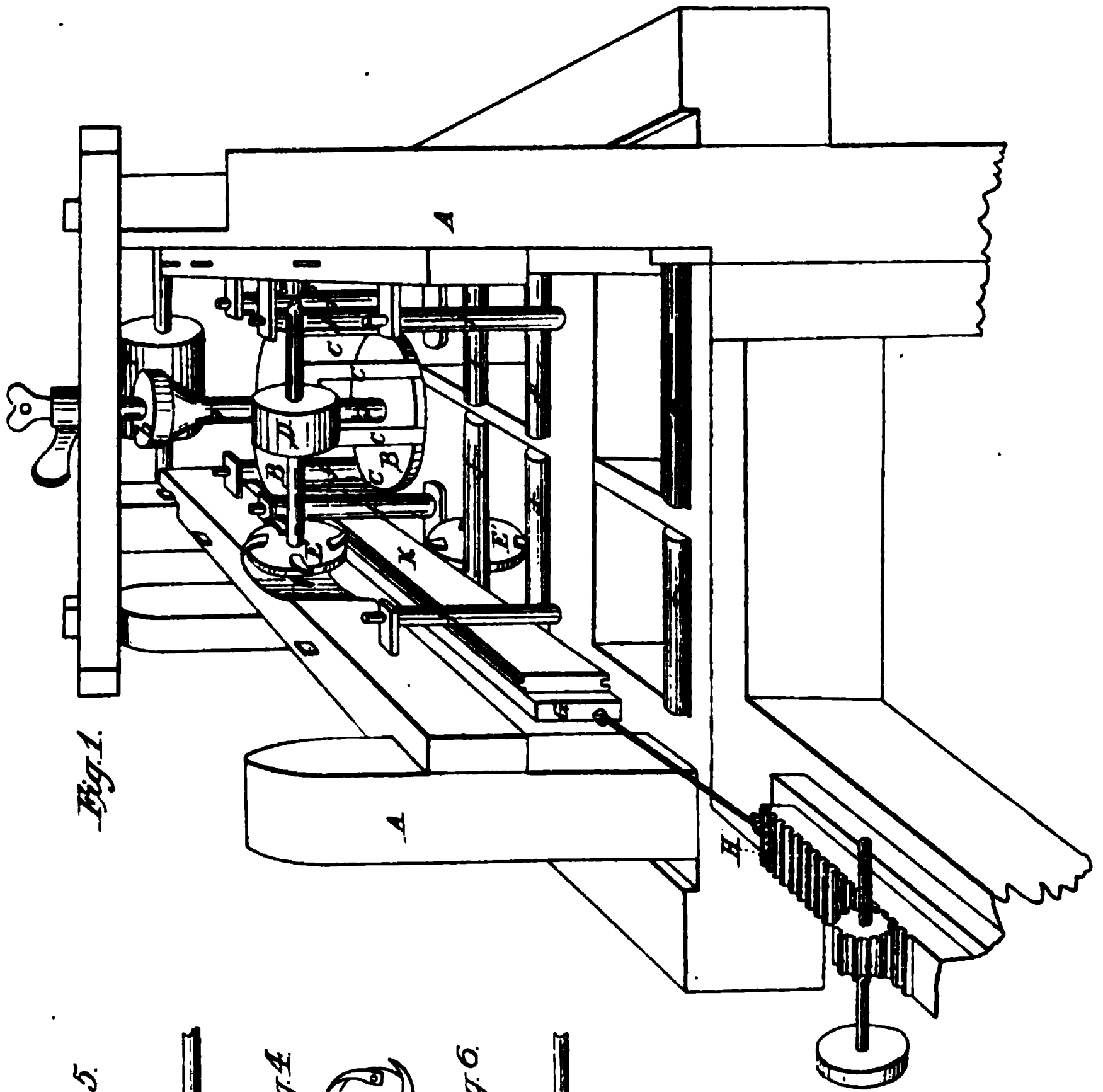


Fig. 1.

Fig. 5.

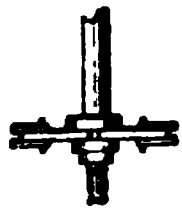


Fig. 4.



Fig. 6.

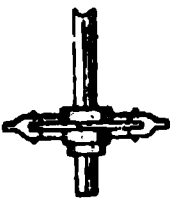


Fig. 3.

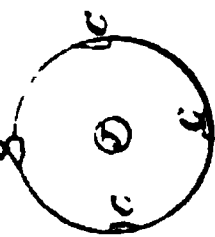
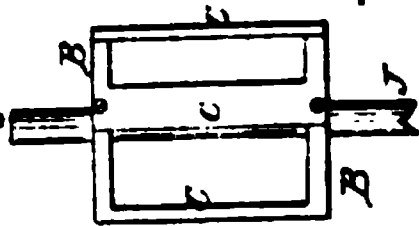


Fig. 2.



Statement of the case.

W. Woodworth, the administrator of the said William Woodworth.

“In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 3d day of March, 1845.

[SEAL.]

“HENRY L. ELLSWORTH,
“*Commissioner of Patents.*”

On the 8th of July, 1845, a new patent was issued, with an amended specification, as follows :

“The United States of America to all to whom these letters patent shall come :

“Whereas, William W. Woodworth, administrator of William Woodworth, deceased, of Hyde Park, N. Y., has alleged that said William Woodworth invented a new and useful improvement in machines for planing, tonguing, and grooving and dressing boards, &c., for which letters patent were granted, dated the 27th day of December, 1828, which letters patent have been extended (as will appear by the certificates appended thereto, copies of which are hereunto attached) for fourteen years from the expiration of said letters patent ; and which letters patent are hereby cancelled, on account of a defective specification, which he states has not been known or used before said William Woodworth's application ; has made oath that he is, and that said William Woodworth was, a citizen of the United States ; that he does verily believe that said William Woodworth was the original and first inventor or discoverer of the said improvement, and that the same hath not, to the best of his knowledge and belief, been previously known or used ; has paid into the treasury of the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose :

“These are, therefore, to grant, according to law, to the said William W. Woodworth, in trust for the heirs at law

Statement of the case.

of said W. Woodworth, their heirs, administrators, or assigns, for the term of twenty-eight years from the twenty-seventh day of December, one thousand eight hundred and twenty-eight, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said William W. Woodworth, in the schedule hereunto annexed, and is made part of these presents.

“ In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

“ Given under my hand, at the city of Washington, this eighth day of July, in the year of our Lord one thousand eight hundred and forty-five, and of the independence of the United States of America the seventieth.

[SEAL.]

“ JAMES BUCHANAN,
Secretary of State.”

“ Countersigned, and sealed with the seal of the Patent Office.

“ HENRY H. SYLVESTER,
Acting Commissioner of Patents.”

“ The schedule referred to in these letters patent, and making part of the same :

“ To all whom it may concern : Be it known that the following is a full, clear, and exact description of the method of planing, tonguing, and grooving plank or boards, invented by William Woodworth, deceased, and for which letters patent of the United States were granted to him on the 27th day of December, in the year one thousand eight hundred and twenty-eight, the said letters patent having been surrendered for the purpose of describing the same invention, and pointing out in what it consists, in more clear, full, and exact terms than was done in the original specification.

“ *Amended Specification.*

“ The plank or boards which are to be planed, tongued, or grooved are first to be reduced to a width, by means of

Statement of the case.

circular saws, by reducing-wheels, or by any other means. When circular saws are used for this purpose, two such saws should be placed upon the same shaft, on which they are to be capable of adjustment, so that they may be made to stand at any required distance apart; under these, the board or plank is to be forced forward, and brought to the width required. This apparatus and process do not require to be further explained, they being well understood by mechanics.

“When what has been above denominated reducing-wheels are used, these are to consist of revolving cutting-wheels, which resemble in their construction and action the planing and reducing wheel to be presently described; these are to be made adjustable, like the circular saws, but the latter are preferred for this purpose. The plank may be reduced to a width on a separate machine.

“When the plank or boards have been thus prepared, (on a separate machine,) they may be placed on or against a suitable carriage, resting on a frame or platform, so as to be acted upon by a rotary cutting or planing and reducing wheel, which wheel may be made to revolve either horizontally or vertically, as may be preferred. The carriage which sustains the plank or board to be operated upon may be moved forward, by means of a rack and pinion, by an endless chain or band, by geared friction-rollers, or by any of the devices well known to machinists for advancing a carriage, or materials to be acted upon, in machines for various purposes. The plank or board is to be moved on toward the cutting edges of the cutters or knives on the planing-cylinder, so that its knives or cutters, as they revolve, may meet and cut the plank or board in a direction contrary to that in which it is made to advance; the edges of the cutters are, in this method, prevented from coming first into contact with its surface, and are made to cut upward from the reduced part of the plank toward said surface, by which means their edges are protected from injury by gritty matter, and the board or plank is more evenly and better planed than when moved in the reversed direction.

Statement of the case.

“ After the board or plank passes the planing-cylinder, and as soon or fast as the planing-cylinder has done its work on any part of the board or plank, the edges are brought into contact with two revolving cutter-wheels, one of which wheels is adapted to the cutting of the groove, and the other to the cutting of the two rebates that form the tongue. When the axis of the planing and reducing wheel stands vertically, the grooving and tonguing wheels are placed one above the other, with the plank edge-wise between them. When the axis of the planing-wheel stands horizontally, these wheels are on the same horizontal plane with each other, standing on perpendicular spindles.

“ The grooving-wheel consists of a circular plate fixed on an axis, and having one, two, three, four, or more cutters, which are to be screwed, bolted, or otherwise attached to it, the edges of which cutters project beyond the periphery of the plate to such distance as is required for the depth of the groove. Their thickness may be such as is necessary for its width. They are, of course, so situated as to cut the groove in the middle of the edge of the board, or as nearly so as may be required. The tonguing-wheel is similar in form to the grooving-wheel, but it has cutters on each of its sides, or otherwise so formed and arranged as to cut the two rebates which are necessary to the formation of the tongue.

“ The grooving and tonguing cutters, at the same time, and by the same operation, reduce the board or plank to an exact width throughout. When the axis of the planing-wheel is placed vertically, the knives or cutters may be made to plane two planks at the same time, the planks being in this case moved in contrary directions, and so as to meet the edges of the revolving knives or cutters. When the machine is thus constructed, a second pair of grooving and tonguing wheels may be made to operate in the same way with those above described. A machine to operate upon a single plank or board, and having the axis of the planing-wheel placed horizontally, will, however, be more

Statement of the case.

simple and less expensive than that intended to operate on two planks simultaneously.

“In the accompanying drawing, fig. 1 is a perspective representation of the principal operating parts of the machine, when arranged and combined for planing, tonguing, and grooving, and when so arranged as to be capable of planing two planks at the same time, the axis of the planing-wheel being placed vertically. A A is a stout, substantial frame of the machine, which may be of wood or iron, and may be varied in length, size, and strength, according to the work to be done. B B are the heads of the planing-cylinder, and C C the knives or cutters, which extend from one to the other of said heads, to the peripheries of which they may be attached, by means of screws. The knives, C C, with the faces forming a planing angle, may be placed in a line with the axis, J, of the cylinder, or they may stand obliquely thereto, as may be preferred ; but in the latter case the edge should form the segment or portion of a helix ; *b* represents a pulley near to the upper end of the axis, J ; and L, a pulley, or drum, which may be made to revolve by horse, steam, or other motive power, and from which a belt may extend around the pulley, *b*, to drive the planing-cylinder and other parts of the machinery. G is the carriage which is represented as being driven forward by means of a rack and pinion, H ; against this carriage, the plank, K, which is to be planed, tongued, and grooved, is placed, and is made to advance with it. It will be manifest, however, that the plank may be moved forward by other means, as, for example, by an endless chain or band passing around drums or chain-wheels, or by means of geared friction-wheels borne up against it. To cause the carriage and plank to move forward readily, there may be friction-rollers, *f f f*, placed horizontally, and extending under them ; the rollers, *f f f*, which stand vertically, are to be made to press against the plank and keep it close to the carriage, and thus prevent the action of the cutters from drawing the plank up from its bed, in cutting from the planed surface upward ; they may be borne against it by

Statement of the case.

means of weights or springs, in a manner well known to machinists. In a single horizontal machine, the horizontal friction-rollers may be geared, and the pressure-rollers placed above them, to feed the board, with or without the carriages, a bed-plate being used directly under the planing-cylinder.

“ Fig. 2 is a separate view of the planing-cylinder, with its knives or cutters, and fig. 3 an end view of one of the heads. E E are the revolving cutters, or tonguing and grooving wheels, and D D whirls upon their shafts, which may be driven by bands, or otherwise, so as to cause said wheels to revolve in the proper direction.

“ Fig. 4 is a side view of one of these wheels ; fig. 5 is an edge view of the tonguing-wheel ; and fig. 6 an edge view of the grooving-wheel, the latter being each shown with two cutters in place. The number of cutters on these wheels may be varied, but they are represented and furnished with four. The cutters may be fixed on the sides of circular plates, with their edges projecting beyond the periphery of said plate.

“ The edges of the plank, as its planed part passes the planing-cylinder, are brought in contact with the above-described tonguing and grooving wheels, which are so placed upon their shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness, and correctly tongued and grooved.

“ In fig. 1, above referred to, only one carriage and one pair of cutter-wheels are shown, it not being deemed necessary to represent those on the opposite side, they being similar in all respects.

“ Fig. 7 represents the same machine, with the axis of the planing-cylinder placed horizontally, and intended to operate on one plank only at the same time. A A is the frame ; B B, the heads of the planing-cylinder ; C C, the knives or cutters attached to said heads. To meet the

Statement of the case.

different thicknesses of the planks or boards, the bearings of the shaft or cylinder may be made movable, by screws or other means, to adjust it to the work ; or the carriage or bed plate may be made so as to raise the board or plank up to the planing-cylinder. E and E' are the revolving cutters, or tonguing and grooving wheels, which are placed upon vertical shafts, having upon them pulleys, D D, around which pass belts or bands from the main drum, I, to which a revolving motion may be given by any adequate motive power.

“ From the drum, I, a belt, L, passes also around the pulley, b, on the shaft of the planing-cylinder, and gives to it the requisite motion. There may, in this machine, be a horizontal carriage, moved forward by a rack and pinion, in a manner analogous to that represented in fig. 1 ; but, in the present instance, the plank is supposed to be advanced by means of one or two pairs of friction or feed rollers, shown at *f f'*; the uppermost, *f' f'*, of the pairs of rollers may be held down by springs or weighted levers, which it has not been thought necessary to show in this drawing, as such are in common use. The lowermost of these rollers may be fluted, or made rough on their surfaces, so as to cause friction on the under side of the plank. M M' are pulleys on the axles of these lower rollers, which are embraced by bands, N N', which also pass around a pulley, O, on a shaft which crosses the frame, A A, and has a pulley, T, on it, which is embraced by the belt, P, on a pulley, Q, on the shaft of the main drum, I. These bands and pulleys serve to give motion to the feed-rollers, as will be readily understood by inspecting the drawing. R R are guide-strips, used in place of the rollers used for the same purpose, and also for bearing or friction rollers, when the machine is vertical, to direct one edge of the plank, and against its opposite edge. Any pressure may be used, equal to the weight of the board or plank, when worked in a vertical position. One of the cutter-wheels should be made adjustable, to adapt it to stuff of different widths.

“ The planing-cylinder, and, likewise, the cutter, or

Statement of the case.

tonguing and grooving wheels, may be constructed in the manner represented in figures 2, 3, 4, 5, and 6, and hereinbefore fully described. One of the heads of the planing-wheel may be made movable, to accommodate its width to the width of the boards or plank to be planed.

“ The respective parts of this machine may be varied in size, as may also the velocity of the motion of the planing-cylinders and cutter-wheels ; but the following has been found to answer well in practice : The planing-cylinder, having four knives or cutters, may be twelve inches in diameter, and may make two thousand and upward revolutions in a minute. In a machine like that shown in fig. 7, the main drum, I, may be two feet in diameter, and may be driven with the speed of five hundred and upward revolutions in a minute. The pulleys on the planing-cylinder, and on the cutter-wheels, may be six inches in diameter. The plank should be moved forward at the rate of about one foot for every hundred revolutions of the cutter-wheel ; and, of course, the diameter of the feed-rollers, and of the pulleys by which they are turned, must be so graduated as to produce this result. The size and speed of the above parts of this machine may be, in some degree, varied ; but the above have been found to work well.

“ Having thus fully described the parts, and combination of parts, and operation of the machine for planing, tonguing, and grooving boards or plank, and shown various modes in which the same may be constructed and made to operate, without changing the principle or mode of operation of the machine, what is claimed therein as the invention of William Woodworth, deceased, is the employment of rotating planes, substantially such as herein described, in combination with the rollers, or any analogous device, to prevent the boards from being drawn up by the planes, when cutting upward, or from the reduced or planed to the unplaned surface, as described.

“ And, also, the combination of the rotating planes with the cutter-wheels for tonguing and grooving, for the purpose of planing, tonguing, and grooving boards, &c., at one

Statement of the case.

operation, as described. And, also, the combination of the tonguing and grooving cutter-wheels for tonguing and grooving boards, and at one operation, as described.

“ And, finally, the combination of either the tonguing or the grooving cutter-wheel for tonguing or grooving boards, &c., with the pressure-rollers, as described, the effect of the pressure-rollers in these operations being such as to keep the boards, &c., steady, and prevent the cutters from drawing the boards toward the centre of the cutter-wheels, while it is moved through by machinery. In the planing operation, the tendency of the plane is to lift the boards directly up against the rollers ; but in the tonguing and grooving, the tendency is to overcome the friction occasioned by the pressure of the rollers.

“ WILLIAM W. WOODWORTH,

“ *Administrator of William Woodworth, deceased.*

“ Witnesses : JAMES MILHOLLAND, CHAS. M. KELLER.”

The above papers show the title of the administrator, who was the grantor of Wilson, the plaintiff in the suit. The record in the New York case was exceedingly brief, and contained neither the declaration nor pleas, but only the state of the pleadings and the existence of demurrers. But from the eighth fact in the statement of facts, in which it is said that “ the defendants trace no title to themselves to a right to use said machines from the assignment made by William Woodworth and James Strong to Halstead, Toogood, and Tyack,” the inference must be, that their defence was in showing an outstanding title.

The following is the entire case presented by the New York record :

“ *United States of America, Northern District of New York :*

“ At a Circuit Court of the United States, begun and held at Albany, for the Northern District of New York, on Tuesday, the twenty-first day of October, in the year of our Lord one thousand eight hundred and forty-five, and in the seventieth year of American independence—

Statement of the case.

“Present: Hon. Samuel Nelson and Hon. Alfred Conkling.

“ JAMES G. WILSON	}
v.	
LEWIS ROUSSEAU AND CHARLES EASTON.	

“ State of the Pleadings.

“ This is an action on the case to recover damages for the alleged infringement of letters patent issued to William Woodworth, on the 27th day of December, 1828, for the term of fourteen years, for an improvement in machinery for planing, tonguing, and grooving boards and plank at one operation, which letters patent were, on the 16th day of November, 1842, extended for seven years more, such extension being granted to William W. Woodworth, as administrator of said William Woodworth.

“ To the first count of the plaintiff's declaration, the defendants interposed three several special pleas in bar, to each of which pleas the plaintiff demurred, and the defendants joined in demurrer. To the second count of the plaintiff's declaration, the defendants demurred, and the plaintiff joined in demurrer.

“ The case coming on to be argued at this term, the following questions occurred for decisions, to wit :

“ 1. Whether the eighteenth section of the Patent Act of 1836 authorized the extension of a patent, on the application of the executor or administrator of a deceased patentee.

“ 2. Whether, by force and operation of the eighteenth section of the act of July 4, 1836, entitled ‘ An act to promote the progress of the useful arts,’ &c., the extension granted to William W. Woodworth, as administrator, on the 16th day of November, 1842, inured to the benefit of assignees under the original patent granted to William Woodworth, on the 27th day of December, 1828, or whether said extension inured to the benefit of the administrator only, in his said capacity.

“ 3. Whether the extension specified in the foregoing

Statement of the case.

second point inured to the benefit of the administrator, to whom the same was granted, and to him in that capacity exclusively, or whether, as to the territory specified in the contract of assignment made by William Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th day of November, 1829, (and set forth in the second plea of the defendants to the first count of the declaration,) and by legal operation of the covenants contained in said contract, the said extension inured to the benefit of the said Toogood, Halstead, and Tyack, or their assigns.

“4. Whether the plaintiff, claiming title under the extension from the administrator, can maintain an action for an infringement of the patent-right within the territory specified in the contract of assignment to Toogood, Halstead, and Tyack, against any person not claiming under said assignment, or whether the said assignment be, of itself, a perfect bar to the plaintiff's suit.

“5. Whether the extension specified in the second point could be applied for and obtained by William W. Woodworth, as administrator of William Woodworth, deceased, if the said William Woodworth, the original patentee, had, in his lifetime, disposed of all his interest in the then existing patent, having, at the time of his death, no right or title to, or interest in, the said original patent, or whether such sale carried with it nothing beyond the term of said original patent; and if it did not, whether any contingent rights remained in the patentee, or his representatives.

“6. Whether the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within said town, or whether, to maintain such action, the plaintiff must be possessed, as to that territory, of all the rights of the original patentee.

“7. Whether the letters patent of renewal, issued to William W. Woodworth, as administrator aforesaid, on the 8th day of July, 1845, upon the amended specification and explanatory drawings then filed, be good and valid in law,

Statement of the case.

or whether the same be void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

“ 8. Whether the court can determine, as matter of law, upon an inspection of the said two patents and their respective specifications, that the said new patent of the 8th of July, 1845, is not for the same invention for which the said patent of 1828 was granted.

“ 9. Whether the decision of the Board of Commissioners who are to determine upon the application for the extension of a patent, under the eighteenth section of the act of 1836, is conclusive upon the question of their jurisdiction to act in the given case.

“ 10. Whether the Commissioner of Patents can lawfully receive a surrender of letters patent for a defective specification, and issue new letters patent upon an amended specification, after the expiration of the term for which the original patent was granted, and pending the existence of an extended term of seven years, or whether such surrender and renewal may be made at any time during such extended term.

“ On which questions the opinions of the judges were opposed.

“ Whereupon, on a motion of the plaintiff, by William H. Seward, his counsel, that the points on which the disagreement hath happened may, during the term, be stated under the direction of the judges, and certified under the seal of the court to the Supreme Court, to be finally decided—

“ It is ordered that the foregoing state of the pleadings, and the following statement of facts, which is made under the direction of the judges, be certified, according to the request of the plaintiff, by his counsel, and the law in that case made and provided, to wit :

“ 1. That William Woodworth, as the inventor of a machine, or improvement in machinery, for planing, tonguing, and grooving boards and plank at one operation, on the 27th day of December, in the year 1828, applied to the proper department of the government for a patent for said

Statement of the case.

invention, and upon the same day, on filing his specifications and explanatory drawings, and complying with the other legal prerequisites, letters patent, signed by the President, and under the seal of the United States, were duly issued to the said William Woodworth, granting to him the exclusive right throughout the United States to construct and use, and vend to others to be used, the machine or improvement patented, for and during the term of fourteen years from the said 27th day of December, 1828.

“2. That subsequently, to wit, on the 28th day of November, 1829, the said William Woodworth and James Strong, who had become jointly interested with said Woodworth in the rights secured by the said letters patent, by contract of assignment of that date, transferred to Daniel H. Toogood, Daniel Halstead, and William Tyack all their right and interest in and to the said patent for certain parts and portions of the United States, in said contract specifically set forth, including the city and county of Albany, in the State of New York, which is the domicile of the defendants.

“3. That the *habendum* in said contract or assignment is in the words following, to wit:

“‘To have and to hold the rights and privileges hereby granted for and during the term of fourteen years from the date of the patent.’

“And that the third clause in said contract of assignment is in the following words, to wit:

“‘And the two parties further agree, that any improvement in the machinery, or alteration or renewal of either patent, such improvement, alteration, or renewal shall inure to the benefit of the respective parties interested, and may be applied and used within their respective districts, as hereinbefore designated.’

“4. That previous to the expiration of the fourteen years’ limitation of said patent, William Woodworth, the patentee, died, to wit, on the 9th day of February, 1839; that William W. Woodworth was thereupon duly appointed, and now is, administrator of the estate of the said

Statement of the case.

William Woodworth, and that the said Woodworth, in his lifetime, had sold all his interest in the said original patent.

“ 5. That William W. Woodworth, as administrator aforesaid, on the 16th day of November, 1842, under the eighteenth section of the act of Congress of July 4th, 1836, applied to the Board of Commissioners created by the said section for an extension of said patent; and that, upon complying with the requisites in said section prescribed, an extension of said patent was granted by said board to William W. Woodworth, as administrator of the estate of William Woodworth, on said 16th day of November, 1842, and letters patent of extension were on said day duly issued to him, granting to him, in his aforesaid capacity, the exclusive right to make and use, and vend to others to be used, the said invention or improvement, for the term of seven years from and after the term of limitation of said original patent.

“ 6. That on the 8th day of July, 1845, the said William W. Woodworth, in his capacity as administrator aforesaid, and in accordance with the provisions of the thirteenth section of the said act of July 4th, 1836; made a surrender to the Commissioner of Patents of the letters patent to him granted on the 16th day of November, 1842, for an insufficiency of the specification upon which the said original patent was issued, and upon filing a corrected and amended specification, with explanatory drawings, a copy of which is annexed hereto and made a part of this statement, the said Commissioner, on the said 8th day of July, 1845, issued to the said William W. Woodworth new letters patent of said invention for the unexpired term of the first extension thereof, and of the extension granted by special act of Congress on the 26th day of February, 1845.

“ 7. That the defendants in this action have erected and put in operation, in the town of Watervliet, which is within the county of Albany and State of New York, one or more machines for planing, tonguing, and grooving boards and plank, substantially the same in principle and mode of oper-

Opinion of the court.

ation as that the subject of the patent granted to William Woodworth.

“ 8. That the defendants trace no title to themselves, to a right to use said machines, from the assignment made by William Woodworth and James Strong to Halstead, Toogood, and Tyack.

“ 9. That the plaintiff in this action is the grantee of William W. Woodworth, as administrator, of the exclusive right to construct and use, and vend to others to be used, two of said patented machines within the said town of Watervliet, in said county of Albany and State of New York.”

The case was argued by *Mr. Seward*, *Mr. Latrobe*, and *Mr. Webster*, (the latter two dividing the points,) on behalf of the plaintiff, and *Mr. Stevens*, for the defendants. The reporter has been kindly furnished with the arguments of these gentlemen, but his limits will not permit their publication *in extenso*, and he is unwilling to take the responsibility of condensing them.

Mr. Justice NELSON delivered the opinion of the court.

The questions in this case come before us on a certificate of division of opinion from the Circuit Court of the United States for the Northern District of New York, involving the construction of various provisions of the act of Congress to promote the progress of useful arts, commonly called the Patent Act. We shall examine the questions in the order in which they appear on the record. The first is as follows :

1. Whether the eighteenth section of the act of 1836 authorized the extension of a patent on the application of the executor or administrator of a deceased patentee.

The eighteenth section provides, in substance, that whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds

Opinion of the court.

thereof. That the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the application. The patentee shall furnish to the board a statement in writing, under oath, of the value and usefulness of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of the invention ; and if, upon a hearing of the matter, it shall appear, to the satisfaction of the board, having a due regard to the public interest, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension for the term of seven years from and after the expiration of the first term, &c.

This is the substance of the section, so far as is material to the consideration of the question ; and it will be seen, that, according to the words of the provision, the application is to be made by, and the new term to be granted to, the patentee himself ; and hence the objection on account of its having been granted to the administrator.

The main argument relied on to support the objection is, that the patentee had no interest or right of property in the extended term at the time of his death. That all he had was a mere possibility, too remote and contingent to be regarded as property, or any right of property, in the sense of the law, and therefore not assets or rights in the hands of the administrator which would authorize an application within the meaning of the statute.

At common law, the better opinion probably is, that the right of property of the inventor to his invention or discovery passed from him as soon as it went into public use with his consent. It was then regarded as having been ded-

Jan., 1846.]

WILSON v. ROUSSE

Opinion of the court

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Opinion of the court.

the enjoyment of the right secured under the first term, and as an act of justice to the inventors for the time, ingenuity, and expense bestowed in bringing out the discovery, frequently of incalculable value to the business interests of the country. And it is apparent, therefore, unless the executor or administrator is permitted to take the place of the patentee in case of his death, and make application for the grant of the second term, which continues the exclusive enjoyment of the right of property in the invention, the object of the statute will be defeated, and a valuable right of property, intended to be secured, lost to his estate.

The statute is not founded upon the idea of conferring a mere personal reward and gratuity upon the individual, as a mark of distinction for a great public service, which would terminate with his death, but of awarding to him an enlarged interest and right of property in the invention itself, with a view to secure to him, with greater certainty, a fair and reasonable remuneration. And to the extent of this further right of property, thus secured, whatever that may be, it is of the same description and character as that held and enjoyed under the patent for the first term. In its nature, therefore, it continues, and is to be dealt with, after the decease of the patentee, the same as an interest under the first, and passes, with other rights of property belonging to him, to the personal representatives, as part of the effects of the estate.

It would seem, therefore, from the nature of this interest in an extended term itself, as well as from a consideration of the object and purpose of the statute, plainly expressed upon its face, in providing for the prolonged enjoyment and protection of this species of property, that the Board of Commissioners were well warranted in making the renewed grant to the administrator, upon his complying with the conditions.

An argument has been urged against this conclusion, grounded upon the tenth and thirteenth sections of the Patent Law. The former provides in express terms for the

Opinion of the court.

issuing of a patent to the executor or administrator, in case of the death of the inventor before it is taken out ; and the latter, for the surrender of a patent defective by reason of an insufficient description, and the reissuing of a new one. These are supposed to be analogous cases, and manifest the sense of Congress, that, without the express provisions of law, the patent in the one case, and the surrender in the other, could not be issued to or be made by the legal representative. The argument is no doubt a proper one, and entitled to consideration ; but it is not necessarily conclusive.

As it respects the provision for a surrender by the executor or administrator, which is most analogous to the question in hand, we think there could be no great doubt that the right would exist in the absence of any such express authority, regard being had to the nature of the property, and the rights and duties of the legal representative, within the spirit and object of the Patent Law. It would be the surrender of a patent, the legal interest and property in which had become vested in him as part of the assets, which he was bound to take care of and protect against waste. A step necessary to perfect the title and give value to the property, would seem to be not only directly within the line of his duty, but in furtherance of the chief object of the law, namely, to secure remuneration to the meritorious inventor.

It has also been argued, that the executor or administrator could not comply with the terms and conditions of the eighteenth section, upon which the right of property in the extended term is made to depend. In other words, that he would be unable to furnish to the Board of Commissioners a statement, under oath, of the usefulness of the invention, and of the receipts and expenditures of the patentee, exhibiting a true and faithful account of the loss and profit in any manner accruing from and by reason of the invention. This argument assumes, as a matter of fact, that which may well be denied. Suppose the dealings of the patentee in the subject of his discovery have been

Opinion of the court.

carried on through the instrumentality of agents or clerks, or, if not, that the patentee himself, as business men usually do, has kept an accurate account of his receipts and expenditures, all difficulty at once disappears. The account-books of a deceased party, in many of the States of the Union, identified, and the handwriting proved, are received as legal evidence of the demand in the courts of justice, and afford full authority, upon legal principles, for the admission of the books before the board, in support of the application. We perceive no great difficulty in a substantial compliance with the terms of the section on the part of the executor or administrator.

The second question is, whether, by force and operation of the eighteenth section, already referred to, the extension granted to W. W. Woodworth, as administrator, on the 16th day of November, 1842, inured to the benefit of assignees under the original patent granted to William Woodworth, on the 27th day of December, 1828, or whether said extension inured to the benefit of the administrator only, in his said capacity.

The most of this section has already been recited in the consideration of the first question, and it will be unnecessary to repeat it. It provides for the application of the patentee to the commission for an extension of the patent for seven years ; constitutes a board to hear and decide upon the application ; and if his receipts and expenditures, showing the loss and profits accruing to him from and on account of his invention, shall establish, to the satisfaction of the board, that the patent should be extended, by reason of the patentee, without any fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for his time, ingenuity, and expense bestowed upon the same, and the introduction of it into use, it shall be the duty of the Commissioners to extend the same, by making a certificate thereon of such extension for the term of seven years from and after the first term ; “ and thereupon the said patent shall have the same effect in law as though it had been originally granted for the

term of twenty-one years." And the question: "*And the benefit of such extension to assignees and grantees of the right extended, to the extent of their respective shares.*"

The answer to the second question is upon the true construction of the clause, and the rights of assignees and grantees.

Various and conflicting interpretations have been put upon it by the learned counsel, on the one hand, and the different and opposite results, which have been reached, on the other, will be examined.

On one side, it has been strongly argued, that the operation and effect of the clause is to extend the rights and interests of assignees and grantees existing at the time of the extension, so as to continue the exclusive use and enjoyment of the rights and interests for the seven years, in as ample a manner, as held and enjoyed during the term. That if A holds an assigned patent, he will hold the same for the seven years; if of the whole patent, then for the whole of that period; and that as soon as the term expires, the patentee the interest therein passes to the assignees of the old patent, and they enjoy their respective shares.

On the other side, it has been argued, that, according to the true effect of the clause, protection is given only to the rights and interests of assignees and grantees acquired and held by assignees and grantees of the patentee in and under the section. That it does not refer to or embrace the rights and interests of assignees and grantees of the patentee under the old patent.

In connection with this view, it is argued, that the right thus protected in the new term may be the result of the legal operation of the clause, and not of the assignment or grant after the extension.

Opinion of the court.

an appropriate provision for that purpose, looking to an extension, contained in the assignment or grant under the old.

It is not to be denied, but that, upon any view that has been taken or that may be taken of the clause, its true meaning and legal effect cannot be asserted with entire confidence ; and, after all, must depend upon such construction as the court can best give to doubtful phraseology and obscure legislation, having a due regard to the great object and intent of Congress, as collected from the context and general provisions and policy of the Patent Law.

The rule is familiar and well settled, that, in case of obscure and doubtful words of phraseology, the intention of the law-makers is to be resorted to, if discoverable from the context, in order to fix and control their meaning, so as to reconcile it, if possible, with the general policy of the law.

Now, the serious difficulty in the way, and which renders the first interpretation inadmissible, except upon the most explicit and positive words, is, that it subverts at once the whole object and purpose of the enactment, as is plainly written in every line of the previous part of the section. It gives the assignees and grantees of the patent, as far as assigned under the old term, the exclusive right and enjoyment of the invention—the monopoly—in the extended term for the seven years ; when, by the same provision, it clearly appears that it was intended to be secured to the patentee, as an additional remuneration for his time, ingenuity, and expense in bringing out the discovery, and in introducing it into public use. It gives this remuneration to parties that have no peculiar claims upon the government or the public, and takes it from those who confessedly have.

The whole structure of the eighteenth section turns upon the idea of affording this additional protection and compensation to the patentee, and to the patentee alone ; and hence the reason for instituting the inquiry before the grant of the extension, to ascertain whether or not he has failed to realize a reasonable remuneration from the sale

Jan., 1846.]

WILSON v. ROUS

Opinion of the co

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We think this construction not
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The eleventh section of the Pat
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&c., shall be recorded in the Patent

Opinion of the court.

teenth section authorizes suits to be brought in the name of the assignee or grantee, for an infringement of his rights, in a court of law.

One object of these provisions found in the general patent system, is to separate the interest of the assignee and grantee from that which may be held by the patentee, and to make each fractional interest held under the patent distinct and separate ; in other words, to change a mere equitable into a legal title and interest, so that it may be dealt with in a court of law.

Now, in view of these provisions, it is difficult to perceive the materiality of the clause in question, as it respects the rights of assignees and grantees, held by an assignment or grant in and under the new term, any more than in respect to like rights and interests in and under the old.

The eleventh and fourteenth sections embrace every assignment or grant of a part or the whole of the interest in the invention, and enable these parties to deal with it, in all respects, the same as the patentee. They stand upon the same footing, under the new term, as in the case of former assignments under the old. Nothing can be clearer. It is impossible to satisfy the clause by referring it to these assignments and grants, or to see how Congress could, for a moment, have imagined that there would be any necessity for the clause, in this aspect of it. It would have been as clear a work of supererogation as can be stated.

The only color for the argument in favor of the necessity of this clause, in the aspect in which we are viewing it, is as respects the contingent interest in the new term, derived from a provision in an assignment under the old one, looking to the extension. As the right necessarily rested on contract, at least till the contingency occurred, there may be some doubt whether, even after its occurrence, the eleventh and fourteenth sections had the effect to change it into a vested legal interest, so that it could be dealt with at law ; and that a new assignment or grant from the patentee would be required, which could be enforced only in a court of equity. To this extent, there may be some color for the

argument—some supposed matter to be given effect to the clause.

But what is the amount of it? It creates or secures this contingent interest for that depends upon the contract before the contract alone, and which, even decisions of the law respecting the rights of grantees could not have the effect to deny that right, might be enforced in a court of law.

The only effect, therefore, of the passage of assignees and grantees of this description is to change the nature of the contingent interest if it happened, from a right resting in contract to a right resting in property interest; or, to speak with more precision, to create a doubt about the nature of the interest which might arise after the happening of a certain contingency. This seems to me in itself was quite remote. This seems to me the amount of the effect that even ingenious lawyers have succeeded in finding, to satisfy the purposes that Congress looked to this in passing the new term, which might or might not arise, about to provide for it, for fear of the consequences of its nature and legal character, and the effect upon the system upon it.

We cannot but think a court should give to the clause a construction so decided in its consequences, both as it respects the individual rights and interests, upon so narrow a basis.

But there are other difficulties in the way of such a construction.

The eleventh section, regulating the rights of assignees and grantees, provides "that every person who is able at law," &c., "which assignment, conveyance of the exclusive right to make and use, and to grant to others, of any thing patented within and throughout any portion of the United States," &c., "shall be valid."

"Now, it will be apparent, we think

Opinion of the court.

examination of the clause in question, that it does not embrace assignees or grantees, in the sense of the eleventh section, at all ; nor in the sense in which they are referred to, when speaking of these interests generally, under the Patent Law, without interpolating words or giving a very forced construction to those composing it.

The clause is as follows : “ And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.”

It will be seen that the word “ exclusive,” used to qualify the right of a grantee in the eleventh section, and, indeed, always when referred to in the Patent Law, (sec. 14,) and also the words “ to make,” “ and to grant to others to make and use,” are dropped ; so that there is not only no exclusive right in the grantee, in terms, granted or secured by the clause, but no right at all—no right whatever—to make, or to grant to others to make and use, the thing patented ; in other words, no exclusive right to make or vend. And it is, we think, quite obvious, from the connection and phraseology, that assignees and grantees are placed, and were intended to be placed, in this respect, upon the same footing. We should scarcely be justified in giving to this term a more enlarged meaning as to the right to make and sell, as it respects the one class, than is given to the others, as they are always used as correlative in the Patent Laws, to the extent of the interests held by them. The clause, therefore, in terms, seems to limit studiously the benefit or reservation, or whatever it may be called, under or from the new grant, to the naked right to use the thing patented ; not an exclusive right even for that, which might denote monopoly, nor any right at all, much less exclusive, to make and vend. That seems to have been guardedly omitted. We do not forget the remaining part of the sentence, “ to the extent of their respective interests therein,” which is relied on to help out the difficulty. But we see nothing in the phrase, giving full effect to it, necessarily inconsistent with the plain meaning of the previous words.

Opinion of the court.

The exact idea intended to be expressed may be open to observation ; but we think it far from justifying the court in holding that the grant or reservation of a right to use a thing patented, well known and in general use at the time, means an exclusive right to make and use it ; and not only this, but an exclusive right to grant to others the right to make and use it, meaning an exclusive right to vend it.

The court is asked to build up a complete monopoly, in the hands of the assignees and grantees, in the thing patented, by judicial construction, founded upon the grant of a simple right to use it to the extent of the interest possessed ; for the argument comes to this complexion. A simple right to use is given, and we are asked to read it an exclusive right ; and not only to read it an exclusive right to use, but an exclusive right to make and vend the patented article.

Recurring to the Patent Law, it will be seen that Congress, in granting monopolies of this description, have deemed it necessary to use very different language. The grant in the patent must be in express terms, for “ the full and exclusive right and liberty of making, using, and vending,” in order to confer exclusive privileges. The same language is also used in the act, when speaking of portions of the monopoly in the hands of assignees and grantees. Sections 11, 14.

We cannot but think, therefore, if Congress had intended to confer a monopoly in the patented article upon the assignees and grantees, by the clause in question, the usual formula in all such grants would have been observed, and that we should be defeating their understanding and intent, as well as doing violence to the language, to sanction or uphold rights and privileges of such magnitude, by the mere force of judicial construction.

We conclude, therefore, that the clause has no reference to the rights or interest of assignees and grantees under the new and extended term—

1. Because, in that view, giving to the words the widest construction, there is nothing to satisfy the clause, or upon

Opinion of the court.

which any substantial effect and operation can be given to it. It becomes virtually a dead-letter, and work of legislative superfluity. And,

2. Because the clause in question, upon a true and reasonable interpretation, does not operate to vest the assignees and grantees named therein with any exclusive privileges whatever, in the extended term, and therefore cannot be construed as relating to or embracing such interests, in the sense of the law.

The extension of the patent under the eighteenth section is a new grant of the exclusive right or monopoly in the subject of the invention for the seven years. All the rights of assignees or grantees, whether in a share of the patent, or to a specified portion of the territory held under it, terminate at the end of the fourteen years, and become re-invested in the patentee by the new grant.

From that date, he is again possessed of "the full and exclusive right and liberty of making, using, and vending to others the invention," whatever it may be. Not only portions of the monopoly held by assignees and grantees as subjects of trade and commerce, but the patented articles or machines, throughout the country, purchased for practical use in the business affairs of life, are embraced within the operation of the extension. This latter class of assignees and grantees are reached by the new grant of the exclusive right to use the thing patented. Purchasers of the machines who were in the use of them at the time are disabled from further use immediately, as that right became vested exclusively in the patentee. Making and vending the invention are prohibited by the corresponding terms of this grant.

Now, if we read the clause in question with reference to this state of things, we think that much of the difficulty attending it will disappear. By the previous part of the section, the patentee would become reinvested with the exclusive right to make, use, and vend the thing patented; and the clause in question follows, and was so intended, as a qualification. To what extent, is the question. The lan-

Opinion of the court.

guage is, "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein,"—naturally, we think, pointing to those who were in the use of the patented article at the time of the renewal, and intended to restore or save to them that right which, without the clause, would have been vested again exclusively in the patentee. The previous part of the section operating in terms to vest him with the exclusive right to use as well as to make and vend, there is nothing very remarkable in the words, the legislature intending thereby to qualify the right in respect to a certain class only, leaving the right as to all others in the patentee, in speaking of the benefit of the renewal extending to this class. The renewal vested him with the whole right to use, and therefore there is no great impropriety of language, if intended to protect this class, by giving them in terms the benefit of the renewal. Against this view, it may be said that "the thing patented" means the invention or discovery, as held in *McClurg v. Kingsland*, 1 How. 202, *ante*, and that the right to use the "thing patented" is what, in terms, is provided for in the clause. That is admitted, but the words, as used in the connection here found, with the right simply to use the thing patented, (not the exclusive right, which would be a monopoly,) necessarily refer to the patented machine, and not to the invention; and, indeed, it is in that sense that the expression is to be understood generally throughout the Patent Law, when taken in connection with the right to use, in contradistinction to the right to make and sell.

The "thing patented" is the invention; so the machine is the thing patented; and to use the machine is to use the invention, because it is the thing invented, and in respect to which the exclusive right is secured, as is also held in *McClurg v. Kingsland*. The patented machine is frequently used as equivalent for the "thing patented," as well as for the invention or discovery, and, no doubt, when found in connection with the exclusive right to make and vend, always means the right of property in the invention—the

Jan., 1846.]

WILSON v. ROUSS.

Opinion of the court

The consequences of any different one proposed to be given, are always courts, when dealing with a statute for between two different interpretations, judicial expositions of ambiguous and that which will result in what may nearest to the intention of the legislature.

We must remember, too, that we are in a decision of the particular case before us, involved in the inquiry ; but with a general practical interest to the country ; and a decision upon the operation of the statute is its chief importance.

The eighteenth section authorizes in all cases where the Board of Commissioners find the usefulness of the invention, and of remuneration to the patentee. In such cases are the subject of the new grant,—public confidence, and which it may be entered largely, in one way and another, in the affairs of life.

By the report of the Commissioner that five hundred and two patents were granted in 1844,—for the last fourteen years, the number has exceeded this number,—and embrace every common use in every department of commerce, on the farm, in the workshop and factory. The right has been purchased from the patentee, and is now in common use. But if the construction of the act have been contending should prevail, the right of either article is renewed, the copy by the exclusive grant to the patent owner may repurchase the right that would be compelled, from necessity ; or from discretion or caprice of the patentee. In coming to such consequences, and fraught with evil, we must be satisfied, was never

Opinion of the court.

gress, and should not be adopted, unless compelled by the most express and positive language of the statute.

The third question certified is, whether the extension of the patent granted to W. W. Woodworth, as administrator, on the 16th of November, 1842, inured to the benefit of the administrator exclusively, or whether, as to certain territory specified in the contract of assignment made by W. W. Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th of November, 1829, and by legal operation of the covenants contained in said contract, the said extension inured to the benefit of said Toogood, Halstead, and Tyack, or their assigns.

William Woodworth was the original patentee, and took out letters patent on the 27th of December, 1828, and soon after conveyed a moiety of the same to James Strong. One Uri Emmons also obtained a patent for a similar machine on the 25th of April, 1829, and soon after conveyed all his interest in the same to Toogood, Halstead, and Tyack. With a view to avoid litigation, both parties mutually assigned to each other their interests in the respective patents to different and separate portions of the United States; and in the assignment from Woodworth and Strong to Toogood, Halstead, and Tyack, the following covenant was entered into by the parties: "And the two parties further agree, that any improvement in the machinery, or alteration or renewal of either patent, such improvement, alteration, or renewal shall inure to the benefit of the respective parties interested, and may be applied and used within their respective districts, as hereinbefore designated."

At the time this covenant was entered into, there was no provision in the Patent Laws authorizing an extension or renewal of the same beyond the original term of fourteen years. The first act providing for it was passed in July, 1832. Before this time, the only mode of prolonging the term beyond the original grant was by means of private acts of Congress, upon individual applications.

A construction had been given by the Circuit Court of

Opinion of the court.

the United States, in New York, as early as 1824, by which the patentee, on surrendering his patent on account of a defective specification, would be entitled to take out a new patent correcting the defect, which construction was afterward upheld by this court in *Grant v. Raymond*, 6 Peters, 218, and the principle since ingrafted into the Patent Law by the act of 1832.

The court is of opinion, that the covenant in question should be construed as having been entered into by the parties, with a reference to the known and existing rights and privileges secured to patentees under the general system of the government established for that purpose ; that the parties would naturally look to the established system of law on the subject of arranging their several rights and obligations, in dealing with property of this description, rather than to any possible change that might be effected by private acts of Congress, upon individual application. Contracts are usually made with reference to the established law of the land, and should be so understood and construed, unless otherwise clearly indicated by the terms of the agreement. If the parties in this case contemplated any alteration or modification of their rights, more advantageous, by the further legislation of Congress, we think some more specific provision, having reference to it, should have been inserted in their covenant. The term renewal may be satisfied by a reference to the law as it then stood. The patentee might surrender his patent, and take out a new one, within the fourteen years ; and the term was used, probably, to guard against any question that might be raised as to the right under the assignment in the new patent, if a surrender and new issue should become necessary. The specification accompanying the patent was a complicated one, and has been the subject of much controversy, and the necessity of a surrender for correction and amendment might very well have been anticipated.

We think this view satisfies the use of the term, and that no right is acquired in the new grant by virtue of the assignment or covenant.

Opinion of the court.

The fourth and fifth questions certified are answered by the opinion of the court upon the first and second questions.

The sixth question certified is as follows: Whether the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within the said town, or whether, to maintain such action, the plaintiff must be possessed, as to that territory, of all the rights of the original patentee.

The plaintiff is the grantee of the exclusive right to construct and use, and to vend to others to be used, two of the patented machines within the town of Watervliet, in the county of Albany.

The fourteenth section of the Patent Law authorizes any person, who is a grantee of the exclusive right in a patent within and throughout a specified portion of the United States, to maintain an action in his own name for an infringement of the right.

The plaintiff comes within the very terms of the section. Although limited to the use of two machines within the town, the right to use them is exclusive. No other party, not even the patentee, can use a right under the patent within the territory, without infringing the grant.

The seventh question certified is as follows: Whether the letters patent of renewal issued to W. W. Woodworth, as administrator, on the 8th of July, 1845, upon the amended specification and explanatory drawings then filed, be good and valid in law, or whether the same be void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

The court is satisfied, upon an examination of the specification and drawings referred to in the question certified, that it is sufficiently full and explicit, and is not subject to any of the objections taken to it.

The remaining questions will be sufficiently answered by the certificate sent to the court below.

Order.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and on the points and questions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this court for its opinion, agreeably to the act of Congress in such case made and provided, and was argued by counsel ; on consideration whereof, it is the opinion of this court—

1. That the eighteenth section of the Patent Act of 1836 did authorize the extension of a patent on the application of the executor or administrator of a deceased patentee.

2. That, by force and operation of the eighteenth section of the act of July 4, 1836, entitled “ An act to promote the progress of the useful arts,” &c., the extension granted to William W. Woodworth, as administrator, on the 16th day of November, 1842, did not inure to the benefit of assignees under the original patent granted to William Woodworth, on the 27th day of December, 1828, but that the said extension inured to the benefit of the administrator only, in his said capacity.

3. That the extension specified in the foregoing second point did inure to the benefit of the administrator, to whom the same was granted, and to him, in that capacity, exclusively ; and that, as to the territory specified in the contract of assignment made by William Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th day of November, 1829, (and set forth in the second plea of the defendants to the first count of the declaration,) and by legal operation of the covenants contained in said contract, the said extension did not inure to the benefit of the said Toogood, Halstead, and Tyack, or their assigns.

4. That the plaintiff, claiming title under the extension from the administrator, can maintain an action for an infringement of the patent-right within the territory specified in the contract of assignment to Toogood, Halstead, and Tyack, against any person not claiming under said assignment ; and that the said assignment is not, of itself, a perfect bar to the plaintiff's suit.

Order.

5. That the extension specified in the second point could be applied for and obtained by William W. Woodworth, as administrator of William Woodworth, deceased, although the said William Woodworth, the original patentee, had, in his lifetime, disposed of all his interest in the then existing patent, having at the time of his death no right or title to or interest in the said original patent; and that such sale did not carry anything beyond the term of said original patent; and that no contingent rights remained in the patentee or his representatives.

6. That the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within said town.

7. That the letters patent of renewal issued to William W. Woodworth, as administrator as aforesaid, on the 8th day of July, 1845, upon the amended specification and explanatory drawings then filed, are good and valid in law; and are not void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

8. That the question involved in the eighth point propounded does not present any question of law which this court can answer.

9. That the decision of the Board of Commissioners, who are to determine upon the application for the extension of a patent under the eighteenth section of the act of 1836, is not conclusive upon the question of their jurisdiction to act in a given case.

10. That the Commissioner of Patents can lawfully receive a surrender of letters patent for a defective specification, and issue new letters patent upon an amended specification, after the expiration of the term for which the original patent was granted, and pending the existence of an extended term of seven years; and that such surrender and renewal may be made at any time during such extended term.

It is thereupon now here ordered and adjudged by this court, that it be so certified to the said Circuit Court.

Dissenting opinion.

M'LEAN, J. As I dissent from the opinion of the court, in their answer to the second question certified, I will state, in few words, the reasons of my dissent.

The question is, whether the extension of the patent, under the act of 1836, to William W. Woodworth, the administrator, inured to the benefit of the assignees of the first patent.

I had occasion to consider this question in the case of *Brooks & Morris v. Bicknell & Jenkins*, [4 McL. 64,] on my circuit, and, on a deliberate examination of the eighteenth section of the above act, I came to the conclusion that, unless the assignment gave to the assignee the right in the extended or renewed patent, his interest expired with the limitation of the original patent.

The lamented Justice STORY, without any interchange of opinion between us, about the same time, gave the same construction to the section. The late Mr. Justice THOMPSON, and several of the district judges of the United States, have construed the act in the same way.

The eleventh section of the act makes the patent assignable in law, either as to the whole interest or any undivided part thereof, by any instrument of writing, which is required to be recorded in the Patent Office within three months from the date.

By the eighteenth section, the patentee may make application for the extension of his patent to the Commissioner, who is required to publish a notice of such application "in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent." "And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them, both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement in writing, under oath, of the ascer-

Dissenting opinion.

tained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear, to the full and entire satisfaction of the said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent," &c. ; "and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein."

This section embraces patents previously issued, and the construction now to be given to it operates on all cases of extensions under it, whether the assignments were made before or after the passage of the act.

The object of this section is so clearly expressed as not to admit of doubt. It was for the exclusive benefit of the patentee ; for the extension can only be granted when it shall be made to appear that the patentee, "without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for his time, ingenuity, and expense," &c. This, then, being the clear intent of Congress, expressed in this section, it must have a controlling influence in the construction of other parts of the section. A statute is construed by the same rule as a written contract. The intent of law-makers, and of the persons contracting, where that intent clearly appears, must be carried into effect. Where the statute or the contract is so repugnant in its language as not to show the intent, then no effect can be given to it. If the words

Dissenting opinion.

used be susceptible of such a construction as not only to show the intent, but to enable the court to give effect to it, it is the duty of the court so to construe it.

Bacon, on the construction of statutes, says : “ The most natural and genuine way of construing a statute, is to construe one part by another part of the same statute ; for this best expresseth the meaning of the makers.” And, “ If any part of a statute be obscure, it is proper to consider the other parts ; for the words and meaning of one part of a statute frequently lead to the sense of another.” “ A statute ought, upon the whole, to be so construed, that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant.”

That the patentee may have his patent extended, though the assignee held the entire interest in it, is undoubted. He has only to show that he has not been reimbursed, &c., within the meaning of the section, to establish his claim for an extension. And in such a case, if the benefit of the extension go to the assignee, he having the entire interest in the patent, how is the patentee benefited ? And yet the law was enacted exclusively for his benefit. Does not such a construction defeat the object of the law ? And if it does, can it be maintained ? Where the assignment of the patent has been for less than the whole, the same objection lies, though the object of the law is subverted only to the extent of the assignment.

The interest of the assignee, it is supposed, is protected by the provision that “ the benefit of such renewals shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.” There can be no doubt that the words, “ to the extent of their respective interests therein,” refer to their right to use the thing patented ; and this, it is contended, is the benefit which results to the assignee from the renewal. That this would seem to be the import of these words, disconnected from other parts of the section, is admitted ; but such a construction is wholly inadmissible, when the object of the section is considered.

Dissenting opinion.

The patent is extended for the benefit of the patentee. This is so obvious that no one will deny it. And the above construction gives the benefit to the assignee. Here is a direct repugnancy, and there is no escape from it; for the same repugnancy exists, though in a less degree, where a part of the patent only has been assigned. Under such circumstances, we must inquire whether this repugnancy may not be avoided by giving another and a different application to the provision, of which the words may be susceptible.

The benefit of the renewal is given to the assignees; but to what extent? To the extent of their interest in the renewal. But it is said that this cannot be the true construction, as it renders the provision inoperative. If, by the assignment, there was an express contract that the assignee should enjoy the same interest in the renewal or extension of a patent, this would secure such interest without the provision.

To this it may be answered, that such an assignment of a thing not *in esse* would, at most, only be a contract to convey the legal right. But, under the eighteenth section, the assignment, after the extension, becomes a legal transfer. In addition to this, the right under the extension being legal, all purchasers would be affected with notice, where the assignment had been recorded in the Patent Office. This view gives effect to the section, and harmonizes its provisions. The other construction makes the parts of the section repugnant, and nullifies the whole of it. Now, which is the more reasonable view? But, in addition to this, what conceivable motive could Congress have had to give a boon to the assignee? How is he injured by the extension?

Without the extension, the assignee would only have a right, in common with all others, to use the invention. This could be of no more value to him than the worth of his machinery; for competition equally open to all cannot be estimated of any value. Under the assignment, the assignee claims a monopoly. Now, did Congress intend to

Dissenting opinion.

give him this boon? Why should he be an object of public munificence? He laid out his money, in the purchase of the patent-right, because he believed it would be profitable. And, in most cases, the assignee speculates upon the poverty of the inventor. Inventors are proverbially poor and dependent. The history of this patent illustrates strongly this fact. Half of the right was originally assigned to pay the expense and trouble of taking out the patent. Another part of the patent was assigned to compromise a pretended claim to a similar invention.

The hardship complained of by the assignee is more imaginary than real. If the patentee takes all the benefit of the extension, the assignee loses, it is said, the value of his machinery. This does not necessarily follow; for if the machinery has been judiciously selected, and put in operation at a proper place, it will sell for its value generally, if not always. If the invention be of great value, as is undoubtedly the case in this instance, the machinery will be wanted by any one who may wish to continue the business, under the extended patent. So that the loss in the sale of the machinery would not be greater than would have been suffered by a sale if the patent had not been extended.

This construction, then, inflicts little or no injury on the assignee, while the other construction, as has been shown, defeats the object of the statute. But this inconvenience or loss to the assignee is duly considered and weighed, under the statute, as the board, in granting the extension, must have a due regard to the public interest. Notice is to be given, as far as practicable, to all persons interested against the extension of the patent, who may appear before the board and oppose it; and it was stated in the argument that the assignees of this patent did oppose the extension of it. Little did they suppose, at the time, that they were resisting a boon secured to them by the above section. Whatever loss, real or imaginary, the assignee may suffer from the extension of the patent, is a loss or inconvenience which results from the general advancement of the public good, and for which society does not, and indeed cannot,

Dissenting opinion.

make compensation. The price of property is affected by general legislation. An embargo is laid, and ships, during its continuance, are valueless. The increase or diminution of the tariff affects beneficially or injuriously the value of machinery used in manufactures. The reduction of the price of the public lands affects the price of lands generally in the new States. An act authorizing a company or individual to construct a railroad, renders useless turnpike roads in its neighborhood, and the public houses established thereon. But for these injuries, no compensation is made. Indeed, it is difficult to find any great public enterprise which does not, in a greater or less degree, affect injuriously private rights. But these must yield to the general welfare of society.

All enlightened governments reward the inventor. He is justly considered a public benefactor. Many of the most splendid productions of genius, in literature and in the arts, have been conceived and elaborated in a garret or hovel. Such results not only enrich a nation, but render it illustrious. And should not their authors be cherished and rewarded?

If the assignee, under the eighteenth section, take anything, in my judgment, he takes the whole extent of his interest,—the whole or nothing. And it appears to me the construction given by the court is, if possible, less warranted by the section, than to hold that the assignee takes under the extension the entire interest assigned.

The words, “and the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein,” cannot, it seems to me, by any known rule of construction, be held to give to the assignee or grantee the right to use the machine he may have had in operation at the time the extension took effect. The words, “to use the thing patented,” are descriptive of the right assigned or granted, and refer to such right,—not to the mere use of the machine. “The extent of their respective interests therein” undoubtedly covers the whole interest, and cannot refer

Dissenting opinion.

merely to the number of machines the individual may have in operation.

Mr. Justice WAYNE expressed his dissent from that part of the opinion of the court which, in answer to the second question, gave a right to an assignee to continue the use of the patented machine, and said he would probably file his reasons with the clerk.

WOODBURY, J. There is one of the leading questions certified to us in this cause, in the decision of which I have the misfortune to differ from a majority of the court.

As that decision bears on several of the other questions, and also disposes entirely of some of the four causes connected with this matter, which have been so long and so ably under argument before us, I consider it due to the importance of this subject, to the parties and the public, as well as just to myself, to state the reasons for my dissent.

The difference in our views arises in the construction of the eighteenth section of the Patent Law of July 4, 1836, and relates to the benefits which may be enjoyed under it by assignees and grantees.

Before the passage of that law, a patent could not, under any circumstances, be extended in its operation, for the benefit of anybody, beyond its original term, except by a special act of Congress. But this section allowed a patentee to apply to a board of officers and obtain from them a renewal of his patent for seven years longer, provided he offered to them satisfactory proofs that his expenses and labor in relation to the patent had not been indemnified. It provided, further, that the renewal be indorsed on the back of the original patent; "and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years." It then added: "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein." This last clause creates the chief embarrassment. In this

Dissenting opinion.

case, the patentee having died, and we having just decided that a renewal was legally granted to his administrator, the controverted question about which we differ is, whether that renewal inures exclusively to the use of the patentee, through his administrator, or goes, either in full or in part, to his assignees and grantees under the old patent. In the present case, it is conceded that, by the contract of assignment or grant, nothing is expressly conveyed but the old patent, and in words only, for the original term of "fourteen years."

The question is not, then, whether, when assigning an interest in the old term, before or after the passage of the act of 1836, it might not be competent and easy to use language broad and explicit enough to transfer an interest in any subsequent extension by means of the contract of assignment, and this be confirmed by the words of the eighteenth section; but whether those words alone transfer it, or were intended to transfer it, when the contract of assignment, as in this case, was made before the act of 1836 passed, and referred *eo nomine* only to the old patent, and expressly limited the time for which the patent was assigned to the old term.

In such case, it seems to me that both the language and spirit of this section restrain its operation to the patentee or his legal representatives, and convey no rights in the extension to assignees or grantees, whether prior or subsequent, except where the patentee had clearly contracted that they should have an interest beyond the original term.

But the majority of the court hold here that this clause, independent of any expression in the assignment, transfers an interest in the extension to all assignees and grantees, so that they may continue to use any machine already in operation during the new term, without any new contract, or any new compensation for such farther use.

The argument on the part of the assignees, in all the cases before us, on this subject, has been, that, by force of this section, all assignees before authorized to make, vend, or use these machines for fourteen years, could continue to

Dissenting opinion.

make and vend, as well as use them, for seven more, without any new contract or new consideration ; and that "grantees of the right to use" should have a like prolongation of all their interests. And such seems to have been the opinion of the Circuit Court in Maryland, in *Wilson v. Turner*, [Taney, 278,] October Term, 1844, Chief Justice TANEY presiding, though other points arose there, and were disposed of in that opinion.

But now, for the first time, it is believed, since the passage of the Patent Law, this court, by force of the last clause in the eighteenth section, not only give to assignees and grantees a greater or longer interest in the thing patented than was given in the contract of assignment to them, but undertake to introduce a novel discrimination, not seeming to me to be made in the clause itself, and give to assignees of the patent-right itself an extension of only a part of their former interest, but to "grantees of the right to use" the patent, an extension of all their former interests.

We propose to examine the objections to this decision of the court, first, on the principle of giving to old assignees and grantees an extension of their interests to the new patent at all, unless the contract of assignment to them was manifestly meant to embrace any new term ; and, after that, to examine the propriety of the discrimination in allowing a right in the renewed patent to grantees of the use, to the extent of all their old interests, and withholding a like privilege from assignees of the patent itself.

First, it has been repeatedly decided, that "a thing which is in the *letter* of a statute is not within the statute, unless it be within the intention of the makers." Dwarris on Statutes, 692 ; Bac. Abr. Statute, T ; 2 Instit. 107, 386.

Here, the great design of the whole section was to extend assistance to an unfortunate and needy class of men of genius, who had failed to realize any profits from their valuable inventions during the first term of their patents. The intention of the makers of this law is usually conceded to have been relief to such patentees, and not to assignees or grantees.

It was the former, and not the latter, who were sufferers, and whom Congress had before, by special acts of extension, occasionally tried to indemnify for their losses ; and to whom now, in a more summary way, on application and proof by them alone, an extension was authorized to be given by a board of officers, in order that they, and not others, might reap the profits of such extension.

But, by allowing the benefit of it to go to the former assignees of only the old patent, the intention of the makers appears to be defeated, and those profited who have not proved any loss or suffering, but, on the contrary, may have already derived great advantages from the assignment.

It might thus happen, likewise, where, in a case like this, the patentee has assigned all his old patent before the extension, and the use of it under the extension would constitute all or its chief value, that neither he nor his representatives—he whose genius had produced the whole invention, at the sacrifice of time and toil, and whose sufferings, losses, and disappointments the law is expressly made to indemnify—would receive the smallest pittance from it ; but those reap all its advantages who may already have grown rich by the assignment to them of the old patent, and who nobody can pretend were the particular or principal objects of relief. Under such a construction, how absurd would it be for such a patentee ever to apply for an extension, when he must do it at new cost and expense, and then have the whole fruits of it stripped from him by persons who had neither paid for the extension nor had it conveyed to them. It is an equal violation of the leading intention of this section, and of most of these principles and of much of this reasoning, to allow, as the opinion of the court does, such persons to take, unpaid for and unbought, a *part* of the

Dissenting opinion.

stipulation of the parties. Congress will, in this way, be made unworthily to tamper with the private obligations of individuals, and will impair them by taking from the rights of one, and enlarging or adding to the rights of the other ; and this without any new consideration or new engagement passing between them, but, on the contrary, against the wishes, assent, and interests of one. That view, also, involves us in the unreasonable inference, that Congress intended to violate a solemn compact, to disturb the vested rights and written agreements of parties, when the language used is susceptible of a different construction, and one that is consistent with what is just, and with the spirit of the whole section.

By that view, an assignee or grantee will obtain " a right to use the thing patented " for a term of seven years longer than he contracted or paid for ; while the patentee, without any such agreement in his contract assigning or granting the right to use, and without any new consideration, will be deprived of all his new and vested rights in the extension, so far as regards that use, and will have his former contract impaired virtually in its whole vitality, by making him part with the use for a term of twenty-one years, when the contract says but fourteen, and making him do it, also, without any application by others for the extension, any proof by others of not being indemnified, any payment by others of the cost and expenses for procuring the additional seven years, and when the avowed and cardinal object of the renewal was to indemnify him alone for losses which he, and not others, had sustained. Well may he say, as to these new and extended interests attempted to be conferred on assignees and grantees beyond the contract of assignment, *in hæc federa non veni*.

Thirdly, the construction I contend for seems to me the only one consistent with the language used in the latter portion of the eighteenth section. By this, no part of those troublesome four lines is senseless, or expunged, or ungrammatical, or contradictory to the object of the previous portion of the section ; while the construction opposed to

this must, in my view, require interpolations or extirpations of words, and a violation of the object of the rest of the section, in order to give to the clause the meaning the advocates of that construction impute to it. Look at the phraseology of the clause: "*The benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein,*"—but surely to no more than that *extent*. It would violate both the words and design to have them enjoy more than the extent of their interests therein, quite as much as not to let them enjoy all of the extent of them. In the construction of statutes, it is a well-settled axiom, that, "to bring a case within the statute, it should be not only within the mischief contemplated by the legislature, but also within the plain, intelligible import of the words of the act of Parliament." *Brandling v. Barrington*, 6 Barn. & Cressw. 475. In this case, the assignees and grantees were not within either the mischief intended to be remedied, that is, a want of indemnity for losses by the patentee, or within the "plain, intelligible import of the words," as their contract of assignment or grant did not extend to the renewed term at all, for any purpose whatever, but was expressly limited to the fourteen years of the original patent.

There must be some measure of their respective interests, when the act passed. What was it? Clearly, the contracts under which they had been acquired. Nothing had been done, either in other acts or previous portions of this, to increase those interests beyond the contracts, but merely to enable assignees and grantees of exclusive rights to protect them by suits in their own names. The present clause, also, does not profess to increase those interests, but simply to let assignees and grantees enjoy them under the renewal, if by their extent by the contract which limits and defines them they run into the extended term. Various hypotheses and metaphysical refinements have been resorted to, for the purpose of putting a meaning on the words of this clause differing from this, which is so plain and so consistent with

Jan., 1846.]

WILSON v. ROUSSEAU

Dissenting opinion

the spirit of the section ; and virtue that assignees and grantees shall have the renewal in the thing patented to their respective interests therein."

But before testing more critically the interests by the only standard applicable, it is necessary to consider separately the words employed in this clause, and the words "*therein*."

Much research has been exhibited in this case between the words "*extension*." But I am not satisfied that these words are employed as in the contracts relating to this subject. "renewals" are not "extensions," and the term of the patent,—that is, the term surrendered and a new one taken for the rest of the term,—while all the term. But, still, "renewals" are a prolongation of the term, or for a new term, and in this very section "*to renew*" is if synonymous, and this in sound and word *renewal* on several other subjects. To renew a lease, is to extend it another term ; to extend it another term ; to renew a patent is to extend them. Again, the second close of the clause, has been considered "in the *renewal*," and by others, "in the thing patented," and by others still, "in the thing patented," automatically, it refers to the "thing patented," "the interests therein" are "the interests in the *patented*."

Phillips treats it as a matter of "patent," and uses that as synonym for "patented," though, in regard to my construction, the result is much the same, whether considered to mean in "the thing patented" or "the renewal," yet I incline to

that most strictly grammatical and the most natural, as well as coming nearest to the views of this court in *McClurg v. Kingsland*, 1 How. 210. Further objections to its meaning "in the right to use" will be stated hereafter, under another head. Passing, then, to a more careful scrutiny of the whole clause, it would seem that there could be but one rational test of "the extent" of the interests of assignees and grantees in the thing patented, and that such test must be the previous contract of assignment or grant under which alone they hold any interests.

If that contract grants to them one-fourth or one-half of the old patent, or the use of it in one State or county, and for a term of five years, or ten, or fourteen, from the issue of the patent, then such, and such alone, is the extent of their interests, and they will not run into the new term. But if the contract goes further, and grants one-half or all of the old patent to assignees, and for a term not only of fourteen years, but twenty-one years, or any number to which the patentee may afterward become entitled by any extension or new grant, then such is the extent of their interests, and they will in such case run into the new term. This view gives meaning and spirit to every word, and excludes or alters none. This, too, conforms to the design of the section in taking away no part of the benefit intended to be conferred by it on the patentee, unless he has chosen to dispose of it clearly and deliberately, and receive therefor, either in advance or after actually granted, such additional consideration as he deemed adequate and contracted to be sufficient.

If after the word "*extent*," in this clause, there had been added, what is the legal inference, *both in time and quantity*, this meaning might have been still more clear to some. But without those words, the extent of interest seems to me to depend as much on the length of time the patent is granted to the assignee, as on the dimensions of territory over which he may use it, or the proportion of the whole patent he is authorized to use. It is like a leasehold interest in land, or a grant of it. The extent of interest by such

Dissenting opinion.

a grant of land is more or less, as the term is shorter or longer, quite as much as if the land conveyed is more or less in quantity.

The word "extent," in common parlance, varies somewhat in meaning, according to the subject to which it is applied, and as that changes, it may as well refer to time as to space or proportion ; and more especially so, when applied to interests, as in patents, for a particular term of years.

There is another analogy in support of this view, that has not been urged in the ingenious arguments offered, but has struck me with some force. A patent was the description once applied to commissions for office ; and the records of this court at first speak of the commissions of the judges as patents.

Now, what is the extent of interest the incumbent has in any office under his commission or patent ? Clearly, in part, the length of time it is to run, whether four years, during good behavior, or for life, and in part only its yearly profits, often quite as much depending on that length of time, as the amount of the salary or fees annually attached to the office.

What is the chief objection in reply to all this ? Nothing, except that the assignee could get protected to the extent of his interest, in this view, by the contract alone, without the aid of the provision at the close of the eighteenth section, and hence that the provision is in this view unnecessary or nugatory, and must have been inserted for some other purpose. But were it in reality unnecessary, that would not require us to consider it as intending something different from its words, or different from the previous contracts of the parties. Legislatures often add clauses to acts, which do not prove to be in reality necessary, but are inserted from abundant caution and to remove future doubts or litigation. So, in this very act, in the eleventh section, it is declared that a patent may be assigned. Yet this is probably unnecessary, as an interest like that of a patentee can, of course, be assigned, on common-law principles, without the aid of a statute.

When we look, however, to another circumstance,—that, though a contract of assignment would, without any clause in the statute, pass the interest to the assignee, yet it would not enable him to sue in his own name,—we can discover another reason for this provision, still more effective. A clause had been inserted in a previous part of the act to enable the assignee to sue in his own name on the old patent, if violated ; and, probably in doubt whether such provision would be extended to assignees under the renewal, when having any interest therein, it was provided further, that “the benefit of the renewal” should reach them to the extent of their interests therein—a part of which benefit would be to sue in their own name for any infringement on their rights to it, as fully as they could do for a violation of their rights in the original patent, and as if that had been for twenty-one years. The provision thus would be far from nugatory, by clearly conferring on them every power and privilege to sue, under the extension, which they possessed under the original patent.

By means of this provision, also, in another view, the condition of the parties might be changed, from a reliance on a contract alone that they should have a certain interest in the new patent, to a vested interest in it ; or, in another view still, from an executory to an executed right.

There is, in the construction given by some of the majority of the court to the clause immediately preceding this, another ample reason for inserting such a provision.

The previous clause, stating that “thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years,” would, it is argued, if the section had there ended, have conferred on any assignee or grantee of the old patent, or any part of it, the extended term, so as to enable them to use the patent as if it originally had been granted for twenty-one years instead of fourteen.

Suppose, then, for a moment, that this construction was considered by Congress proper, or only possible, it is manifest that the additional clause which follows had a second

Dissenting opinion.

and most pregnant object,—no less than to prevent that consequence, so hostile to the design of inserting the whole section,—to grant an extended term for the benefit and indemnity of the patentee, and not of the assignee. In this view, the last clause might well be added, as a limitation on what would otherwise be the inference from that just preceding it; and might well declare, instead of this inference, that assignees of the old patent should not hold it, in all cases, as if originally granted for twenty-one years, though patentees might; but that assignees should hold only in conformity to “the extent of their respective interests” in the thing patented. In other words, if by contract they had acquired clearly an interest for twenty-one years, they should hold for that time; but if by contract they had acquired an interest for only five or fourteen years, they should hold it only to that extent. This is rational, consistent with the great object of the section, and gives new and increased force and necessity to the clause. The assignees would then, after the renewal, hold the patent for all the time they had stipulated, and for all they had paid, but for no more.

It will be perceived, that very few assignees or grantees, prior to the passage of the act of 1836, would, in this view, be likely to come under this provision, and be benefited by it; because, not knowing that any future law would pass allowing an extension, very few would be likely to anticipate one, and provide in their contract and pay for a contingent interest in its benefits.

This would make the provision, in practice, apply chiefly to future assignees, who, knowing that such a provision existed, might be willing to give something for a right to any extension which might ever take place under it; and, therefore, might expressly stipulate in the assignment for that right. Indeed, the arguments on the part of the patentee in this case have mostly proceeded on the ground that this provision was intended to apply solely and exclusively to future assignees. Considering that any other construction is in some degree retrospective, and that this would

give force to the provision as well as preserve the spirit of the section, I should be inclined to adopt it, if mine did not produce a like effect, and was not alike free from objection, as limited by me ; because I do not make the provision retrospective, except in cases where the parties had expressly contracted that the prior assignee should receive the benefit of any extension, and in that case it has the preference in its operation over the other view, as it carries into effect that express compact, and does not cramp the force of it to the future alone, where the language and the consideration are equally applicable to past engagements of this character.

This conclusion is also strengthened by being in harmony with all the leading rules of construction applicable to statutes, while that adopted by the court seems, to my mind, to violate some of the most important of them.

Besides those already referred to, it is well settled, that, "if a particular thing be given or limited in the preceding parts of a statute, this shall not be taken away or altered by any subsequent general words of the same statute." *Dwarris*, 658 ; *Standen v. The University of Oxford*, 1 *Jones*, 26 ; 8 *Coke*, 118, *b*. Here a particular benefit is, by the former part of the eighteenth section, conferred on a patentee for reasons applicable to him alone : and yet, in this

Dissenting opinion.

be copied or adopted ; and as, under that, assignees have been allowed to participate in the extended time, it has been argued that such was the intention here. But it is doubtful whether that act was before the committee when they reported the bill in 1836, as the intervening time had been short, and the eighteenth section, on examining the journals and files, appears not to have been in the bill at all as originally introduced, or as originally reported ; but was afterward inserted as an amendment in the Senate. The consideration of this section, therefore, does not seem to have been so full as of the rest of the bill ; and it is very far, in language, from being a copy of the English act. Assignees are not named at all in that act ; and though, in extensions under it, assignees have, in two or three cases, been allowed to participate, it has only been where an enlarged equity justified it—as where the patentee consented, or was to receive a due share in the benefits, or had clearly conferred a right in the extension by the assignment ; and where, also, the assignees are expressly named in the new grant or patent as entitled to a share of it. See Webster's Patent Cases, 477.

There, also, an assignee, under like circumstances, would doubtless benefit by the renewal, under its ordinary operations ; and the practice in England, thus limited, will fortify rather than weaken the construction. I adopt of the true design of the last clause in our own law.

There is much, also, in another collateral consideration here, which does not apply in Great Britain, and which restricts conferring the benefit of an extension, or an extension itself, on an assignee by or under any statute, if it goes beyond what a patentee had himself contracted to do.

Here the Constitution limits the powers of Congress to give patents to inventors alone.

“The Congress shall have power to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.” Article I, section 8.

No authority is conferred to bestow exclusive rights on others than “authors and inventors” themselves.

Dissenting opinion.

Hence a patent could not probably be granted to an assignee, nor an extension bestowed on one, independent of the assent or agreement of the patentee, or of its inuring to his benefit, without raising grave doubts as to its being a violation of the Constitution. But so far as inventors have expressly agreed that assignees shall be interested in their patents, or in the extensions of them, the latter may well be protected ; and so, as far as administrators represent the inventor or patentee, when deceased, the grant to them is substantially a grant to the inventor, as the benefit then inures to his estate and heirs. But to grant an exclusive right to an assignee would confer no benefit on the patentee or his estate ; and it would violate the spirit as well as letter of the Constitution unless the inventor had himself agreed to it, and had substituted the assignee for himself by plain contract, whether for the original term or any extension of it.

Cases have been cited in this country, likewise, where Congress, in ten or twelve instances, have renewed patents to the inventors ; but they have never done it to assignees. And though in two out of the whole which were renewed after the term had expired and the assignees and the public were in the free use of the patent, some limitations have been imposed on requiring further payments from the assignees for the longer use of the old patent, yet in these only, and under such peculiar circumstances, has it been done, and in these no term was granted by Congress directly to the assignee rather than the patentee ; and this limitation or condition in favor of the assignee, in the grant to the patentee, is of very questionable validity, unless it was assented to by the patentee. In this case, it is most significant of the views of Congress to relieve the patentee, rather than assignees, that by a special law, passed February 26, 1845, they have conferred on the representative of the original patentee still another term of seven years, without mentioning the assignees in any way, and without any pretence that the benefits of this extension were designed for them.

Dissenting opinion.

The argument, that the assignee is sometimes a partner and makes liberal advances, furnishes a good reason, in a pecuniary view, why an assignment should be made to him of such an interest in the old patent as will indemnify him, but furnishes none for giving him, even if he regards money above public spirit or benevolence, more than an indemnity, or for giving him a benefit in any renewal, which it has never been agreed he should have, and for which he never has paid.

So, the reasoning that the assignee stands in the shoes or in the place of the patentee, and represents him, and therefore should have an interest in the extension, applies very well, so far as he is assignee, or so far as the contract extends ; but he no more stands in the shoes of the patentee, beyond the extent of his contract, than an entire stranger does. Such are the cases of *Herbert v. Adams*, 4 Mason, 15, and that cited in 1 Hawk. P. C. 477, note.

In one, the assignee of the old patent represented the patentee as to that, and that only ; and in the other, where by law a further copyright was authorized in all cases, and the patentee assigned his whole interest, the second term passed also, because the law had previously given it absolutely, without contingency or evidence of losses, but in connection with or appurtenant to the first copyright.

Again, it has been urged that the assignee should have the benefit of the extension ; otherwise he may have made large expenditures, in preparing for a free use of the patent after the original term expires, and will lose them in a great degree, or be obliged to pay largely for the continued use of the patent. But this same reasoning applies equally well to the whole world as to the assignee, because any individual, not an assignee, may have incurred like expenditures in anticipation of the expiration and free use of the old patent. In fact, the argument is rather a legislative than judicial one, and operates against the policy of the whole section, rather than the construction put on the last clause.

But the hardship to any person, in such case, is more

Dissenting opinion.

apparent than real. The price to be paid for the new patent is not so much as the gain by it, and hence those who have proposed to use it, and do use it, after the extension, and pay anew for a new or further term, gain rather than lose, or they would have employed the old machinery in operation before this invention.

Nor is it any relief to the community at large, as seems by some to have been argued, to hold that the renewal, or a large part of it, vests in the assignee and grantee rather than in the patentee ; for the great mass of the people must still purchase the patent, or the right to use it, of some one, and must pay as much for it to the assignee as to the patentee.

Finally, the construction of the court, by conferring any privilege whatever on assignees and grantees beyond the extent of their interests in the thing patented, when those interests, as in this case, were expressly limited in the contract to the term of the old patent, goes, in my view, beyond the language of the act, beyond the contract of assignment, beyond the consideration paid for only the old term, and beyond any intention of the legislature for relief or indemnity to others than unfortunate patentees.

I feel not a little fortified in these views on the case by several decisions and opinions that have heretofore been made, in substantial conformity to them. Indeed, independent of opinions in some of the actions now before us, (from which an appeal has been taken, or the cause has come up on a certificate of division,) every reported case on this subject has been settled substantially in accordance with these views. See *Woodworth v. Sherman*, and *Woodworth v. Cheever et al.*, [3 Story, 171,] Circuit Court for Massachusetts, May Term, 1844, decided by Justice STORY ; *Van Hook v. Wood*, Circuit Court for New York, October Term, 1844, by Justice BETTS ; *Wilson v. Curties & Grabon*, Circuit Court for Louisiana, by Justice McCaleb ; *Brooks & Morris v. Bicknell et al.*, Circuit Court for Ohio, July Term, 1844, by Justice McLEAN, (*Western Law Journal*, October, 1845 ;) Butler's opinion, as Attorney-General, in

Dissenting opinion.

Blanchard's case, (Opinions of Attorney-Generals, pages 1134 and 1209.)

All that remains for me is to advert a moment to that branch of the construction adopted by the majority of the court, which, after giving to both assignees and grantees a benefit in the new patent or term beyond "the extent of their interests" under the contract of assignment, undertakes to go still farther, and make a discrimination between assignees and grantees, as to the enjoyment, under the renewal, of their different original interests. It gives to the latter, the grantees, by the mere force of this last clause in the eighteenth section, the enjoyment of all their old interests during the whole of the new term; but it gives to the former, the assignees, the enjoyment of only about a third portion of their old interests, during that term. In other words, it gives to "grantees of the right to use the thing patented" a continuance of all their interests; but to assignees, whose interests extended to the right to make and to vend, as well as use, the thing patented, a continuance of only a part of theirs. In such a discrimination, uncountenanced and unwarranted, as it seems to me, by either the words or the spirit of the act of Congress, I am sorry to find another strong ground of dissent to the opinion of the court. The act does not say, as is their construction, that "the benefit" of only "the right to use the thing patented" shall extend to any one, whether an assignee or grantee; but that the benefit of the renewal shall extend to both, "to the extent of their respective interests," though differing clearly in extent as they do, and as will soon be more fully shown.

"Judges are bound to take the act of Parliament as the legislature have made it." [Jones v. Smart] 1 D. & E. 52, and Dwarris on Statutes, 711.

But the words in this act, "the right to use the thing patented," must be transposed, and other words altered in their ordinary meaning, to make these a description of the interests conferred.

They are now a description of one kind of purchasers,

Dissenting opinion.

festly, then, there is not conferred on these two clauses, by this clause, either in its spirit or *in totidem verbis*, merely "the right to use the thing patented," but, on the contrary, "the benefit of the renewal," "to the extent of their respective interests in the thing patented." The interests of the grantees may be limited to the use, and those of the assignees may not be, but include the right to make and vend as well as use; yet large or long as may be the interests of either, the benefit of the renewal is to cover them, if *the extent* of them, under the original assignment or grant, reached to the new term. One is not to have the whole of his interests protected and the other a part only, when their equities are the same. But the assignee is to have to the extent of his, which is to make, vend, and use; and the grantee only "of the right to use" is to have to the extent of his.

This, to my apprehension, is unquestionably the substance of what Congress has said on this topic; and yet it is only by supposing new language not in the act, or by transposing some of the old, so as not to be in harmony with the original structure of the sentence, or by giving a meaning to words different from what has been established, and, in my view, only by doing this, that any foundation can be laid in support of this part of the construction approved by the court. But "it is safer," said Mr. J. Ashhurst, "to adopt what the legislature have actually said, than to suppose what they meant to say." [Jones v. Smart] 1 D. & E. 52; [The King v. The Poor Law Commissioners] 6 Adolph. & Ellis, 7.

It may be well, also, not to forget, that it is always more judicial, and less like legislation, to adhere to what Congress have actually said, and that it is more imperative to do this when, by adhering to it, you carry out, as in this case, the manifest intention of the previous part of the section. Nor can the inconsistency produced by the construction of the court be without influence in creating doubts as to its correctness; as by it "the benefit of the renewal" will be extended to assignees and grantees not in ratio with

“their respective interests,” (the words of the law,) nor in conformity with their respective contracts, nor according to the respective considerations they have paid, nor in proportion to the respective losses they have sustained, but, under the same general permission as to the extent of the “respective interests” of both, one class will be allowed to the full extent of his previous interest, and the other to only a part of that extent.

By what authority, let me respectfully ask, is this general permission thus divided, and in one class or case limited, and in the other not? By what legal authority are assignees cut off from a valuable portion of their interests in a patent, while grantees to use the thing patented are allowed to exercise the whole of theirs, and both under one and the same general permission, covering all “their *respective* interests”? To make this discrimination, and allow to one class the full extent of their interests, and to the other not the full extent of theirs, when the law says it shall be “to the extent of their *respective* interests,” and when their respective contracts and equities show that this should include both the duration and quantity of their interests, looks like a distinction in a great degree arbitrary, and not a little in conflict with the plain words and design of the act of Congress.

But, beside this further departure from what seems to me the obvious meaning of the eighteenth section, caused by this branch of the construction of the court, it will fail, I fear, as any compromise of the difficulties arising under the section, if any compromise be expected from it. It is not likely to avert ruin from most of those indigent inventors who have, in their distresses, resorted for aid to the delusive provisions of that section. Their very necessities and embarrassments, which are the justification for granting the renewal to them, have usually forced them to sell and

Dissenting opinion.

the assignees and grantees of the old patent, the law is perfectly suicidal as to the only design to be effected by its bounty. But if, seeing this, the construction is modified, as here, by the court, so as to deprive the patentee in such cases of only the benefits of the use of his old patent or old machines during the new term, this qualification in the operation of the law will, it is apprehended, usually prove a mere mockery, working, in most cases, as fully as the court's construction without the qualification would, the entire defeat of the laudable object of the renewal toward patentees. In one or two of the cases now before us, the patentee, under this construction, will still be subjected to defeat and burdensome costs. In relation to its effect on the present patent as a whole, all the consequences cannot now be ascertained. But it is admitted that the inventor had assigned the whole of the old patent, so that no right whatever to use will remain in his representatives to dispose of; or if a right remains where machines are not now in actual use, probably enough are now in use to supply, for some time, the public wants in most parts of the United States.

The right to continue to use them will probably last during the whole seven years the renewal runs, as the machine will usually, with proper repairs, do service beyond that time. It will not, then, be very difficult to calculate what value, during the seven years, will be derived from the right to make and vend machines, when the use of others already in existence is scattered over every section of the country, and they may be employed all the time of the extended patent, without the assignees or grantees ever having paid, or being obliged to pay, a dollar for that extended use.

Looking, then, to the beneficent design of the eighteenth section, to enforce the Constitution, by advancing science and the arts, and protecting useful inventions, through the security for a longer term to men of genius of a property in their own labors, in cases where they had not been already remunerated for their time and expenses, I cannot but fear

Dissenting opinion.

that the construction given by the majority of the court will prove most unfortunate. It will tend to plunge into still deeper embarrassment and destitution, by losses in litigation and by deprivation of a further extended sale of their inventions, those whose worth and poverty induced Congress to attempt to aid them.

Nor would a different construction tie up, as some suppose, the future use of numerous patents. Of the fourteen thousand five hundred and twenty-six heretofore issued, since the Constitution was adopted, I am enabled, by the kindness of the Commissioner of Patents, to state that only ten have been renewed under the eighteenth section during nearly ten years it has been in operation.

And if the individuals who use the improved machines, the fruit of the toil and expense and science of others, were obliged in but one case in a year, over the whole country, to pay something for that further use, is it a great grievance? They are not obliged to employ the patent at all, and will not, unless it is better by the amount they pay than what was in use before. And is it a great hardship, or inequitable, where they are benefited by another's talents, money, and labor, to compensate him in some degree therefor?

While other countries, and Congress, and our State courts are adopting a more liberal course yearly toward such public benefactors as inventors, I should regret to see this high tribunal pursue a kind of construction open to the imputation of an opposite character, or be supposed by any one to evince a feeling toward patentees which belongs to other ages rather than this, (and which I am satisfied is not cherished,) as if patentees were odious monopolists of the property and labors of others, when in truth they are only asking to be protected in the enjoyment and sale of their own,—as truly their own as the wheat grown by the farmer, or the wagon built by the mechanic.

Nor should we allow any prejudices against the utility of patents generally, and much less against the utility of the invention now under consideration, to make our construc-

Dissenting opinion

tions more rigid in this case. The courts now, under the lights of law once otherwise, is, in doubtful cases, decisions most favorable to patentees. (6 Peters, 218; 1 Sumner, 485; Wy Rep. 287; *Blanchard v. Sprague*, 2) is it strange that this should be the century, however different it was when we daily witness how the world since by the patented inventions are in all its wonderful varieties and uses spinning, and weaving cotton by machine the human race, and in myriads of other things, shedding so benign a light which we live, and most of them exist under the protection secured to them by an enlightened government.

Some estimate can be formed of the present patent, and its title to favor, by computing that a man can perform the labor of a horse in one day that would require fifty days of a horse. It is supposed to reduce near seven-tenths of the time of such work in every building where it is used,—as it ere long will be by the use of the steam power of our own population, and in time overtake the horse. Every honest social system must sustain the rights of property, and every wise one seeks to undo the wrongs of the past.

To be liberal, then, in the protection of property, to be just toward the rights of property, to be just toward the rights of property in this and other ways to give encouragement to genius and talent, is to increase the power of the nation, to hasten the progress of practical improvement in science. And to discountenance encroachments on the rights of property, and defeat piracies of their rights, is related in the end to better the condition of the society, and introduce wider and faster progress in the superior state of civilization and the

Notes and Citations.

Pavement Co. v. Jenkins, 14 Wall. 452.

Hendrie v. Sayles, 98 U. S. 546.

8. Act 1836, § 14. See note 4, *ante*.

Territorial grantee, right to sue :

Woodworth v. Wilson, 4 How. 712 [p. 542 *post*].

• Of assignee :

See Tyler v. Tuel [p. 1, *ante*], note 1.

Patent in Suit :

No. . Woodworth, W. December 27, 1828. Planing
Mill. Reissue No. 71. July 8, 1845.

OTHER SUITS ON SAME PATENT :

See Wilson v. Turner, 4 How. 712 [p. 539 *post*].

Citations :**IN SUPREME COURT OF UNITED STATES :**

Simpson v. Wilson, 1846. 4 How. 709 ; Bk. 11, L. ed. 1169
[p. 533 *post*].

Woodworth v. Wilson, 1846. 4 How. 712 ; Bk. 11, L. ed. 1171
[p. 542 *post*].

Wilson v. Turner, 1846. 4 How. 712 ; Bk. 11, L. ed. 117 1 [p. 539
post].

Hogg v. Emerson, 1848. 6 How. 437 ; Bk. 12, L. ed. 505.

Wilson v. Simpson, 1849. 9 How. 109 ; Bk. 13, L. ed. 66.

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Railroad Co. v. Winans, 1854. 17 How. 31 ; Bk. 15, L. ed. 27.
Chaffee v. Belting Co., 1859. 22 How. 217 ; Bk. 16, L. ed. 240.
Bloomer v. Millinger, 1863. 1 Wall. 340 ; Bk. 17, L. ed. 581.
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Eunson v. Dodge, 1873. 18 Wall. 414 ; Bk. 21, L. ed. 766.
Paper Bag Cases, 1882. 105 U. S. 766 ; Bk. 26, L. ed. 959.

IN CIRCUIT COURTS :

Blanchard's Gun Stock Turning Factory v. Warner, April, 1846.
1 Blatch. 258 ; Fish. Pat. Rep. 184.
Woodworth v. Hall, May, 1846. 1 Wood. & Minot, 248 ; 2 Robb.
495.
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517.
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115.
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49.
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Woodworth v. Curtis, May, 1847. 2 Wood. & Minot, 524 ; 2 Robb.
603.
Phelps v. Comstock, May, 1848. 4 McLean, 353 ; Fish. Pat. Rep.
215.
Case v. Redfield, May, 1849. 4 McLean, 526 ; 2 Robb. 741.
Gibson v. Gifford, June, 1850. 1 Blatch. 529 ; Fish. Pat. Rep. 366.
Bloomer v. Stolley, July, 1850. 5 McLean, 158 ; Fish. Pat. Rep.
376.
Gibson v. Cook, November, 1850. 2 Blatch. 144 ; Fish. Pat. Rep.
415.
Woodworth v. Cook, November, 1850. 2 Blatch. 152 ; Fish. Pat.
Rep. 423.
Clum v. Brewer, October, 1855. 2 Curt. 506.
Day v. Union India Rubber Co., August, 1856. 3 Blatch. 488.

Jan., 1846.]

WILSON v. ROU

Notes and Citat

Baldwin v. Sibley, October, 1858. 1

Goodyear v. Cary, February, 1859. 4

Goodyear v. Beverly Rubber Co., Octo

Aiken v. Manchester Print Works, Ma

Hodge v. Hudson River and Harlem

Blatch. 85 ; 3 Fish. 410.

Wood v. Mich. Southern R. R., No

Fish. 464.

Crompton v. Belknap Mills, May, 186

Chambers v. Smith, June, 1870. 7 Pl

Jenkins v. Nicholson Pavement Co., J

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45.

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385 ; 2 O. G. 471.

Gear v. Grosvenor, March, 1873. 1 l

3 O. G. 380.

Hill v. Whitcomb, February, 1874.

Ard. 34 ; 5 O. G. 430.

Prime v. Brandon M'f'g Co., July, 187

& Ard. 379.

Brickill v. The Mayor of N. Y., July,

O. G. 463 ; 7 Fed. Rep. 479 ; 5 Ba

Fire Extinguisher M'f'g Co. v. Graham,

543 ; 24 O. G. 793.

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McBurney v. Goodyear, November, 185

Buss v. Putney, January, 1859. 38 N.

Statement of the case.

ANDREW P. SIMPSON, JOSEPH FORSYTH, AND
BAGDAD MILLS, APPELLANTS, v. JAMES G.
WILSON.

4 How. 709-711. Jan., 1846.

[Bk. 11, L. ed. 1169 ; 2 Robb. 469 ; 1 Whit. 424.]

Exclusive territorial assignee. Sale of product of patented machine.

1. Assignee of an exclusive territorial right to make, use, and vend to others a patented machine, may vend the product elsewhere (p. 535).

[Citations in the opinion of the Court :]

(1) Wilson v. Rousseau, 4 How. 646, p. 535.

THIS case came up on a certificate of division in opinion between the judges of the Circuit Court of the United States for the District of Louisiana, sitting as a court of equity.

Wilson was the complainant below, who filed a bill, and obtained an injunction against Simpson, Forsyth, and Mills. After sundry proceedings in the case, Forsyth put in a plea, and a rule was obtained that the plaintiff should show cause why the injunction should not be dissolved. Upon argument, the court dismissed the rule, and the case was set down for hearing, by consent of parties, the complainants not admitting the facts alleged in the plea, but for the purpose of raising the questions of law which they involved, and obtaining a speedy decision of the same.

Upon the argument, the division of opinion arose which will be presently stated.

The facts in the case were these :

The patent for planing, &c., having been obtained by Woodworth in 1828, as has been particularly mentioned in the report of the preceding case of Wilson v. Rousseau *et*

Statement of the case.

al., Forsyth, one of the defendants below, became an assignee under that patent for all its rights within the county of Escambia, in West Florida. This took place in 1836.

Woodworth, the patentee, having died, his administrator, in 1842, obtained a renewal of the patent under the act of 1836, and, in 1843, assigned to Wilson, the complainant below, all the rights under the extended patent for the States of Louisiana, Alabama, and the Territory of Florida.

On the 13th of April, 1844, the said Wilson instituted proceedings in equity, in the Circuit Court of Louisiana, against the defendants, on the ground that they infringed on his just rights, by setting up and putting in operation the said patented machines in the Territory of Florida, and by vending in New Orleans large quantities of dressed lumber, plank, &c., the product of the machines there established.

In May, 1845, the cause came up for hearing, as above stated, when the following points were ordered to be certified to this court, namely :

“J. G. WILSON	}	No. 1,225.
v.		
SIMPSON ET AL.		

“This case coming on to be heard, on demurrer filed to the plea of Joseph Forsyth, one of the defendants, set down for hearing by consent, and the matters of law arising on said plea, the following points became material to the decision, and, being considered, the court were divided in opinion on the following points :

“1. Whether, by law, the extension and the renewal of the said patent, granted to William Woodworth, and obtained by William W. Woodworth, his executor, inured to the benefit of said defendant, to the extent that said defendant was interested in said patent before such renewal and extension.

“2. Whether, by law, the assignment of an exclusive right to the defendant, by the original patentee, or those claiming under him, to use said machine, and to vend the

Jan., 1846.]

SIMPSON v. W

Order.

same to others for use, within the Territory of West Florida, did to vend elsewhere than in said city in the city of New Orleans, St boards, and other materials produced and used within the said Territory of West Florida.

“Wherefore, upon the request is ordered and directed that the fact be certified for the opinion of the Supreme States.”

The case was argued by *Gilpin* defendants below, who were the appellants by *Henderson* and *R. Johnson*, for the respondents.

Mr. Justice NELSON delivered the opinion of the court.

The questions in this case come from a division of opinion in the court below. In this court in the previous case of *McCulloch*, upon the second question certified here, the court was equally divided.

The second question certified in this case is, whether or not the assignment of an exclusive right to use, and to vend to others, planing-machines in the Territory only, authorizes the assignee to vend out of the said territory, the planing-machines and materials the product of said machines.

The court have no doubt but that the restriction in the assignment is to the use of the machine solely to the using of the machine, and not to the place of the sale of the product. The question is referred to the court below.

ORDER. This cause came on to be argued before the court of the record from the Circuit Court for the District of Louisiana, and

Notes and Citations.

tions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this court for its opinion agreeably to the act of Congress in such case made and provided, and was argued by counsel ; on consideration whereof, it is the opinion of this court—1. That, by law, the extension and renewal of the said patent granted to William Woodworth, and obtained by William W. Woodworth, his executor, did not inure to the benefit of said defendant to the extent that said defendant was interested in said patent before such renewal and extension ; but the law saved to persons in the use of machines at the time the extension takes effect the right to continue the use. 2. That an assignment of an exclusive right to use a machine, and to vend the same to others for use, within a specified territory, does authorize an assignee to vend elsewhere, out of the said territory, plank, boards, and other materials the product of such machine.

It is, therefore, now here ordered and decreed by this court, that it be so certified to the said Circuit Court.

Patent in suit :

No. . Woodworth, W. December 27, 1828. Planing
Mill. Reissue No. 71. July 8, 1845.

OTHER SUITS ON SAME PATENT :

See *Wilson v. Turner*, 4 How. 712 [p. 539 *post*].

Citations :**IN SUPREME COURT OF UNITED STATES :**

Wilson v. Simpson, 1849. 9 How. 109 ; Bk. 13, L. ed. 66.

Notes and Citations.

IN CIRCUIT COURTS :

Blanchard's Gun Stock Turning Factory *v.* Warner, April, 1846.

1 Blatch. 258 ; Fish. Pat. Rep. 184.

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Wilson *v.* Sherman, June, 1850. 1 Blatch. 536 ; Fish. Pat. Rep. 361.

Pitcher's Case, October, 1863. 1 Ct. of Claims, 7.

Wood *v.* Mich. Southern R. R., November, 1868. 2 Biss. 62 ; 3 Fish. 464.

IN STATE COURTS :

Howe *v.* Wooldredge, January, 1866. 12 Allen, 18.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 101, 221.

Curt. on Pats., 4th ed., §§ 203, note, 295, note, 297, 498.

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Statement of the case.

JAMES G. WILSON, COMPLAINANT AND APPELLANT, v. JOSEPH TURNER, JUNIOR, AND JOHN C. TURNER, DEFENDANTS.

4 How. 712- . Jan., 1846.

[Bk. 11, L. ed. 1171 ; 2 Robb. 467 ; 1 Whit. 427.]

Affirming *ibid.*, Taney, 278.

1. The judgment of the court in *Wilson v. Rousseau*, 4 How. 646 [p. 436 *ante*], disposes of this case (p. 540).

[Citations in the opinion of the Court :]

(1) *Wilson v. Rousseau*, 4 How. 646, p. 540.

THIS case came up by appeal from the Circuit Court of the United States for the District of Maryland, sitting as a court of equity.

The bill was filed by Wilson, as the assignee of William W. Woodworth, the administrator of Woodworth, the patentee, as stated in the report of the preceding case. It set out the patent and assignment, and then prayed for an injunction and account.

The answer referred to the mutual assignment made between Woodworth and Strong on the one part, and Toogood, Halstead, Tyack, and Emmons of the other part, which was recited in the preceding case, and traced title regularly down from these latter parties to the defendants.

A statement of these facts was agreed upon by counsel, and all the documents set forth at length ; and upon this statement, together with the bill and answer, the cause was argued.

At April Term, 1845, the court dismissed the bill, and from this decree the case was brought up by appeal to this court.

It was argued by *Phelps* and *Webster*, for Wilson, the

appellant, and *Schley*, for the appellees, who were the defendants below.

Mr. Justice NELSON delivered the opinion of the court.

The judgment of the court in the previous case of *Wilson v. Rousseau et al.* disposes of the question in this case, and affirms the decree of the Circuit Court.

Patent in suit:

No. . Woodworth, W. December 27, 1828. Planing
Mill. Reissue No. 71. July 8, 1845.

OTHER SUITS ON SAME PATENT:

- Brooks *v.* Bicknell, 1843. 3 McL. 250 ; 2 Robb. 118.
Brooks *v.* Jenkins, 1844. 3 McL. 432 ; Fish. Pat. Rep. 41.
Washburn *v.* Gould, 1844. 3 Story, 122 ; 2 Robb. 206.
Woodworth *v.* Sherman, 1844. 3 Story, 171 ; 2 Robb. 257.
Lippincott *v.* Kelly, 1844. 1 West. L. J. 513.
Wilson *v.* Rousseau, 1845. 1 Blatch. 3.
Barnard *v.* Gibson, 1849. 7 How. 650-658 ; Fish. Pat. Rep. 243.
Woodworth *v.* Stone, 1845. 3 Story, 749 ; 2 Robb. 296.
Brooks *v.* Stolley, 1845. 3 McL. 523 ; 2 Robb. 281.
Brooks *v.* Bicknell, 1845. 4 McL. 70 ; Fish. Pat. Rep. 72.
Brooks *v.* Bicknell, 1845. 4 McL. 60 ; Fish. Pat. Rep. 65.
Simpson *v.* Wilson, 1846. 4 How. 709 ; 2 Robb. 469 ; 1 Whit.
424 [p. 533 *ante*].
Smith *v.* Mercer, 1846. 4 West. L. J. 49 ; 5 Penn. L. J. 529.
Van Hook *v.* Pendleton, 1846. 1 Blatch. 187 ; Fish. Pat. Rep.
120.
Wilson *v.* Rousseau, 1846. 4 How. 646 ; 2 Robb. 373 ; 1 Whit.
357 [p. 436 *ante*].
Woodworth *v.* Hall, 1846. 1 W. & M. 248 ; 2 Robb. 495.
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Woodworth *v.* Weed, 1846. 1 Blatch. 165 ; Fish. Pat. Rep. 108.
Woodworth *v.* Wilson, 1846. 4 How. 712 ; 2 Robb. 473 ; 1 Whit.
428 [p. 542 *post*].
Gibson *v.* Harris, 1846. 1 Blatch. 167 ; Fish. Pat. Rep. 115.
Gibson *v.* Betts, 1846. 1 Blatch. 163 ; Fish. Pat. Rep. 91.
Wilson *v.* Stolly, 1847. 4 McL. 273 ; Fish. Pat. Rep. 146.

Jan., 1846.]

WILSON *v.* TU

Notes and Cita

Woodworth *v.* Curtis, 1847. 2 W. &
Wilson *v.* Stolly, 1847. 4 McL. 275 ;
Woodworth *v.* Edwards, 1847. 3 W. &
Van Hook *v.* Pendleton, 1848. 2 Blatch.
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Rep. 457.

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Whit. 515.

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Olcott *v.* Hawkins, 1849. 2 Am. L. &
Motte *v.* Bennett, 1849. 2 Fish. 642.
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Rep. 243.

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Woodworth *v.* Cook, 1850. 2 Blatch.
Gibson *v.* Van Dresar, 1850. 1 Blatch.
Gibson *v.* Gifford, 1850. 1 Blatch. 52
Gibson *v.* Cook, 1850. 2 Blatch. 144
Bloomer *v.* Stolley, 1850. 5 McL. 15
Brooks *v.* Norcross, 1851. 2 Fish. 66
Bicknell *v.* Todd, 1851. 5 McL. 236
Ritter *v.* Serrell, 1852. 2 Blatch. 379.
Sloat *v.* Patton, 1852. 1 Fish. 154.
Bloomer *v.* McQuewan, 1852. 14 How.
Livingston *v.* Woodworth, 1853. 15 H
Brooks *v.* Fiske, 1853. 15 How. 212 ;
Foss *v.* Herbert, 1856. 1 Biss. 121 ;
Pitts *v.* Edmonds, 1857. 1 Biss. 168 ;
Jenkins *v.* Greenwald, 1857. 1 Bond,
Dean *v.* Mason, 1857. 20 How. 198 ;
Brown *v.* Shannon, 1857. 20 How. 5
Bloomer *v.* Gilpin, 1859. 4 Fish. 50.
Bloomer *v.* Millenger, 1863. 1 Wall.

Statement of the case.

WILLIAM W. WOODWORTH, ADMINISTRATOR, &c.,
AND E. V. BUNN, ASSIGNEE, COMPLAINANTS
AND APPELLANTS, v. JAMES, BENJAMIN, AND
ALPHEUS WILSON.

4 How. 712-716. Jan., 1846.

[Bk. 11, L. ed. 1171 ; 2 Robb. 473 ; 1 Whit. 428.]

*Original inventor. Grant of extension to administrator.
Joinder of parties plaintiff.*

1. Legality of an extension granted the administrator of patentee determined in conformity with *Wilson v. Rousseau*, 4 How. 646 (p. 547).
2. Held that Woodworth was the original inventor of the patent for Planing Mills granted him December 27, 1828, and that the specifications accompanying the patent were sufficiently full and explicit (p. 547).
3. Patentee held properly joined as plaintiff in suit for infringement brought by assignee, of an exclusive right within a limited territory (p. 547).

[Citations in the opinion of the Court:]

(1) *Wilson v. Rousseau*, 4 How. 646, p. 547.

THE bill was filed in this case in the Circuit Court for the District of Kentucky, by the complainants, setting forth that William Woodworth was the inventor and patentee of a certain planing-machine, describing it ; also, the extension of the said patent to W. W. Woodworth, as administrator, and that E. V. Bunn, one of the complainants, took an assignment from the said W. W. Woodworth for the exclusive right of making, using, and vending machines for planing, &c., under the extension of the patent, within the limits of the city of Louisville, and in the district of country ten miles around said city.

The bill further charges that the defendants have, in vio-

Statement of the case.

lation of the rights of the complainants, erected and put in operation, in the city of Louisville, a planing-machine, &c., which machine is, in all its material parts, substantially like and upon the plan of the machine of the complainants, and persists in using the same.

The defendant, James Wilson, answered the bill, substantially denying most of the material allegations contained in it. The other defendants answered, by denying that they had any interest in the machine.

The court granted an injunction, enjoining the defendant, James Wilson, from using the machine.

Afterward, an application was made to the court, on behalf of the complainants, for a rule upon the defendant, James Wilson, to show cause why an attachment should not be issued against him for a violation of the injunction, which was accordingly granted.

The defendant showed cause by affidavit, in which he affirms that immediately on the service of the injunction he had ceased to use the machine mentioned in the bill, and conformed himself to the order of the court, and that he had purchased and set up Bicknell's planing-machine, which he was using, and which was substantially different from the machine of the complainants.

Much testimony was taken in the court below, on the question whether the machine which the defendant had substituted and was using was, in all its material and substantial parts, like Woodworth's, which it is not material to refer to more particularly. A great deal of testimony was also taken, for the purpose of showing that Woodworth was not the original inventor of the complainants' machine, which it is also not necessary to recite.

The cause afterward came to a hearing on the merits, upon the pleadings and proofs, and also upon the rule previously granted against the defendant, to show cause why an attachment should not issue for a violation of the injunction, and, after consideration, the court dissolved the injunction and dismissed the bill, and discharged the rule to show cause, with costs.

Statement of the case.

As the opinion of the court refers, in general terms, to the interest of Woodworth under the assignment, as a justification for his being joined as a party in the suit, it is proper to set forth the assignment, which was as follows :

“ Transfer from Woodworth, Administrator, &c., to E. V. Bunn.

“ Whereas, William Woodworth, now deceased, did, in his lifetime, obtain letters patent, issued under the great seal of the United States, bearing date the 27th day of December, 1828, giving and granting to him, the said Woodworth, his heirs, administrators, and assigns, for and during the term of fourteen years from the date of the said letters patent, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used a certain improved method for planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any materials, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings in or facing metallic, mineral, or other substances ;

“ And whereas, William W. Woodworth, administrator of said William Woodworth, hath applied for and obtained an extension of said letters patent for the term of seven years from and after the expiration of said patent, to wit, the 27th day of December, 1842, pursuant to an act of Congress in such case made and provided, and hath a certificate of said extension annexed to said patent, signed by the Commissioner of Patents, under the great seal of the Patent Office of the United States, and dated November 16th, A.D. 1842 ; and whereas, E. V. Bunn, of the city of Louisville, in the State of Kentucky, hath fully viewed, examined, and considered for himself the said improvement, and, of his own motion, hath requested and desired the said William W. Woodworth, administrator of said William Woodworth, deceased, to give a license and permission, in writing, for constructing and using machines on the said improved plan in the city of Louisville aforesaid, including

Statement of the case.

the district of country within ten miles of said city, and in no other city, town, or place in the United States, or the territories thereof, on the conditions hereinafter mentioned, and have offered to pay him the sum of fifteen hundred dollars for such license and consent in writing, with which request and desire the said William W. Woodworth, administrator of William Woodworth, deceased, has agreed to comply :

“ Now, know all men by these presents, that the said W. W. Woodworth, administrator of William Woodworth, deceased, in consideration of the said sum of fifteen hundred dollars, secured to be paid to him, the said William W. Woodworth, administrator of William Woodworth, deceased, doth hereby give his full consent and permission, in writing, and license to the said E. V. Bunn, and to his executors, administrators, and assigns, to construct and use, during the said extension of the aforesaid patent, ten planing-machines on the improved plan aforesaid, within the city of Louisville, and including the district of country within ten miles of said city, and in no other city, town, or place within the United States or the territories thereof ; and also, within said limits, to dispose of the plank or other things dressed and prepared in the said machines. And he doth also hereby authorize and empower the said E. V. Bunn, and his executors, administrators, and assigns, in the name of said Woodworth, administrator aforesaid, or in his own name, to commence and prosecute to final judgment any suit or suits against any person or persons who shall construct or use the said improvements within the said limits, contrary to the true meaning and intent of the aforesaid letters patent, and the extension thereof, and the law in such case made and provided ; and to receive for his own benefit, and at his own proper costs and charges, any penalty or penalties which he may recover. And, in consideration of the premises, it is hereby covenanted and agreed, by and between the said William W. Woodworth, administrator of William Woodworth, deceased, his executors, administrators, and assigns, of the one part, and

Statement of the case.

the said E. V. Bunn, his executors, administrators, and assigns, of the other part, as follows, namely :

“ 1st. That the said William W. Woodworth, administrator of William Woodworth, deceased, his executors or administrators, during the terms aforesaid, shall not, nor with themselves, construct or use, nor give their license, consent, and permission to any other person than the said E. V. Bunn to construct or use, the improved planing-machine aforesaid, within the said city of Louisville, or within the district of country within ten miles of said city.

“ 2d. That the said E. V. Bunn, his executors, administrators, and assigns, shall not nor will, during the times aforesaid, construct or use more than ten machines as aforesaid within the limits above mentioned, nor construct or use any such machines, nor sell and dispose of any plank or other thing dressed and prepared in such machine anywhere else within the United States and the territories thereof ; it being declared to be the true intent and meaning of these presents that not more than ten planing-machines in the whole shall be constructed and used, by virtue of the license, consent, and permission herein given.

“ 3d. It is understood and agreed that the said William W. Woodworth has entered and filed, at the Patent Office at Washington, a disclaimer of that part of said patent for the planing-machine which claims the reduction of materials, boards, and plank to an equal width and thickness by circular saws ; and a lien is retained and renewed on this assignment for the security of the payment of the fifteen hundred dollars, the consideration and purchase-money to be paid to said Woodworth.

“ Signed, sealed, and delivered this 21st day of June, 1843.

[SEAL.]

“ W. W. WOODWORTH,

“ *Administrator of W. Woodworth, deceased.*

“ The words ‘ to him in hand paid by the said ’ were erased, and the word ‘ ten,’ and the words ‘ in the name of said Woodworth, administrator aforesaid, or in his own

Opinion of the court.

name,' were interlined before the execution of the foregoing instrument, in presence of D. E. Sickles."

The cause was argued by *Latrobe* and *Staples*, for the complainants, Woodworth and Bunn, and by *Bibb*, for the defendants.

Mr. Justice NELSON delivered the opinion of the court.

The objection taken, that the administrator could not apply for an extension of the patent granted to Woodworth, his intestate, under the eighteenth section of the Patent Law, has been disposed of in the previous case of *Wilson v. Rousseau et al.*, and need not be further noticed.

Another objection taken to the right of the complainants to maintain the suit, is that Woodworth was not the first and original inventor of the planing-machine, against the using of which the defendant was enjoined.

Without going into the proofs in the case, which are very voluminous, it will be sufficient to state that, after fully considering all the evidence produced bearing upon the question, the court is satisfied that the weight of it is decidedly against the objection, and in favor of the allegation in the bill, that Woodworth was the original inventor of the machine.

It is objected, also, that the specifications accompanying the patent were not sufficiently full and explicit, so as to enable a mechanic of ordinary skill to build a machine. The court is not satisfied, according to the proof in the case, that the objection is well founded, and it cannot be relied on as affording sufficient ground for the dismissal of the bill.

A further objection was taken, that W. W. Woodworth, one of the complainants, was improperly joined with E. V. Bunn, the assignee of the exclusive right in Louisville and ten miles around it. The court is of opinion that the interest of Woodworth in the assignment, as appears from the record, is sufficient to justify his being made a party jointly with the assignee.

Notes and Citations.

Some other objections were taken to the maintenance of the suit on the argument, which it is not material to notice particularly. They have all been considered, and, in the judgment of the court, afford no sufficient ground for the dismissal of the bill and the dissolving of the injunction.

We think the court erred, and that the decree dismissing the bill, as to the derendant James Wilson, and dissolving the injunction, should be reversed, and that a perpetual injunction should issue.

Notes :

1. Extension.

See notes to *Wilson v. Rousseau* [p. 436 *ante*].

3. Joinder of parties.

See note 8 to same and *Tyler v. Tuel* [p. 1 *ante*], note 1. *Livingston v. Woodworth*, 15 How. 546.

Patent in suit :

No. . Woodworth, W. December 27, 1828. Planing
Mill. Reissue No. 71. July 8, 1845.

OTHER SUITS ON SAME PATENT :

See *Wilson v. Turner*, 4 How. 712 [p. 539 *ante*].

Citations :**IN SUPREME COURT OF UNITED STATES :**

Brooks v. Fiske, Diss. opin., 1853. 15 How. 212 ; Bk. 14, L. ed. 665.

Notes and Citations.

Moore *v.* Marsh, 1868. 7 Wall. 515 ; Bk. 19, L. ed. 37.

IN CIRCUIT COURTS :

Woodworth *v.* Hall, May, 1846. 1 Wood. & Minot, 248 ; 2 Robb. 495.

Van Hook *v.* Pendleton, October, 1846. 1 Blatch. 187 ; Fish. Pat. Rep. 120.

Woodworth *v.* Rogers, May, 1847. 3 Wood. & Minot, 135 ; 2 Robb. 625.

Olcott *v.* Hawkins, 1849. 2 Am. L. J. (9 Penn. L. J.) 317.

Gibson *v.* Van Dresar, June, 1850. 1 Blatch. 532 ; Fish. Pat. Rep. 369.

Jenkins *v.* Greenwald, April, 1857. 1 Bond, 126 ; 2 Fish. 37.

Baldwin *v.* Sibley, October, 1858. 1 Cliff. 150.

Nelson *v.* McMann, April, 1879. 16 Blatch. 139 ; 4 Ban. & Ard. 203 ; 16 O. G. 761.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, pp. 93, 284.

Curt. on Pats., 4th ed., §§ 212, 347, note, 405.

Statement of the case.

JAMES WOOD, PLAINTIFF IN ERROR, v. WILLIAM A. UNDERHILL AND ASCHEL H. GEROW, DEFENDANTS.

5 How. 1-6. Jan., 1847.

[Bk. 12, L. ed. 28 ; 2 Robb. 588 ; 1 Whlt. 432.]

Description. Composition of matter. Particular patent sustained.

1. The degree of certainty required by the law (Act 1836, § 6) is that the specification be in such full, clear, and exact terms as to enable any one skilled in the art to compound and use the invention without making any experiments of his own (p. 556).
2. In patents for machines the sufficiency of the description must in general be a question of fact for the jury (p. 556).
3. Where the specification of a new composition of matter fails to state the relative proportions of the substances mixed together, or the proportions are ambiguously and vaguely stated, the patent would be void for insufficient description (p. 556).
4. Where patentee in his patent, No. 97, Wood, J., December 2, 1836, Brick Making, gave a certain proportion of the ingredients as a general rule, and also pointed out the variations, the specification was held sufficiently clear to support the patent (p. 556).
5. Where, from the nature and character of the ingredients used in a composition of matter, they are not susceptible of the description required by law, the inventor is not entitled to a patent (p. 557).

THIS case was brought up by writ of error from the Circuit Court of the United States for the Southern District of New York.

It appeared that, in the year 1836, Wood took out amended letters patent for "a new and useful improvement in the mode of making brick, tile, and other clay ware," and filed the following specification of his invention :

Statement of the case.

“Be it known, that I, the said James Wood, have invented a new and useful improvement in the art of manufacturing bricks and tiles. The process is as follows : Take of common anthracite coal, unburned, such quantity as will best suit the kind of clay to be made into brick or tile, and mix the same, when well pulverized, with the clay before [it] is moulded. That clay which requires the most burning will require the greatest proportion of coal-dust. The exact proportion, therefore, cannot be specified ; but, in general, three-fourths of a bushel of coal-dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding a half-bushel. The benefits resulting from this composition are the saving of fuel, and the more general diffusion of heat through the kiln, by which the whole contents are more equally burned. If the heat is raised too high, the brick will swell, and be injured in their form. If the heat is too moderate, the coal-dust will be consumed before the desired effect is produced. Extremes are therefore to be avoided. I claim as my invention the using of fine anthracite coal, or coal-dust, with clay, for the purpose of making brick and tile as aforesaid, and for that only claim letters patent from the United States.

“JAMES WOOD.

“Dated 9th November, 1836.”

In July, 1842, he brought a suit against the defendants in error, for a violation of this patent.

And at the trial the defendant objected to the sufficiency of the specification, “because no certain proportion for the mixture is pointed out, but only that such quantity of coal must be taken as will best suit the kind of clay to be made into brick or tile ; but that clay which requires most burning will require the greatest quantity of coal-dust. The exact proportion cannot, therefore, be specified ; but, in general, three-fourths of a bushel of coal-dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding half a bushel ; so that

Argument of counsel.

there is no fixed rule by which the manufacturer can make the mixture, but that must be ascertained by experiments upon the clay ; and the claiming clause in the specification is only for the abstract general principle of mixing anthracite coal-dust with clay, for the purpose of making brick, without any practical rule as to the proportions, which is too vague and uncertain to sustain a patent,"—which objection was sustained by the court. The plaintiff excepted. And the verdict and judgment being against him, the case was brought up here upon this exception.

The cause was argued by *Silliman*, for the plaintiff in error, and *Rowley*, for the defendants.

Silliman, for the plaintiff in error, made the following points :

The plaintiff insists—

1. That he has, in his specification, given a general rule by which every kind of clay may be much better burned than by any previous process ; and that the general proportions specified are, with some exceptions, the very best that can be used.

That a patent may properly be granted for a *beneficial general rule*, although there might be some exceptions to it not provided for.

2. That if it is necessary to entitle the plaintiff to a patent for a most beneficial invention for burning clay of the qualities usually found, that he should also discover the means of burning, to best advantage, clays of qualities not usually found, that his patent should not therefore be deemed void on its face ; but he should be permitted to prove, by persons conversant with the business, that they could instantly determine, on inspection of clays of uncommon qualities, whether they required more or less than the usual burning, and how much more or less, so as to regulate the variation of proportions in such manner as to burn to the best advantage.

Argument of counsel.

3. The plaintiff should have been permitted to show, under his specification, by *experts*, that any kind of clay of which bricks can be made, however varied the qualities, can be better burned under his general rule than by any previous process; and if such is the fact, the plaintiff should be entitled to a patent for the discovery, if he had given the general rule only, and had taken no notice of those exceptions, in which some uncommon kinds of clay can be best burned with a greater or less proportion of coal than that specified in the general rule.

4. The judge, in his decision, adopts all the errors of the defendants' objection, which states that there is no fixed rule by which the manufacturer can make the mixture, but that must be ascertained by experiments upon the clay. Suppose this to be so, and that the inventor has only furnished a guide by which such experiments can be successfully made, and that the subject, on account of the variable qualities of the materials, does not admit of greater certainty, and that by the simplest and cheapest experiments the manufacturer, in consequence of the plaintiff's invention, will be able to burn his bricks much better in less than half the time, and at less than half the cost of burning, by any other process, is not the inventor entitled to a patent for an invention practically so useful?

The fact that not a single brick has, for some years past, been burned, except according to the plaintiff's specification, is pretty good evidence that the manufacturers have been able to discover something from plaintiff's specification.

5. The objection, as adopted by the court, declares that the claiming clause in the specification is only for the abstract general principle of mixing anthracite coal-dust with clay, for the purpose of making bricks and tiles, without

Opinion of the court.

ascertained by an experiment on each bed of clay, it might, nevertheless, be a very useful invention, for which the inventor should be in some measure compensated by a patent. But this part of the objection is not true in fact; for the claiming clause is of the invention of using fine anthracite coal, or coal-dust, with clay, for the purpose of making brick and tile "*as aforesaid*." These words, "*as aforesaid*," refer to the general rule of three-fourths of a bushel of coal for a thousand bricks, with the exceptions or variations previously expressed.

6. The judgment should be reversed, with costs, including the costs in the Circuit Court.

Rowley, for the defendants in error.

The patentee's specification is uncertain and insufficient. It furnishes no rule for making bricks, without the manufacturer's first making a series of experiments. The most it does is to prescribe in about what manner the trials are to be conducted, which is not enough to sustain his patent. *The King v. Arkwright*, Dav. Pat. Cases, 106 (per Buller, J.); *Turner v. Winter*, 1 Term R. 606 [1 Am. & Eng. 43] (per Ashurst, J.); *Boulton v. Bull*, 2 H. Bl. 484 [1 Am. & Eng. 59] (Buller, J.); *Harmer v. Playne*, 11 East, 101 [1 Am. & Eng. 171] (Lord Ellenborough); *The King v. Wheeler*, 2 Barn. & Ald. 345 [1 Am. & Eng. 317] (Abbott, Ch. J.); *Godson on Patents*, 85; *Lowell v. Lewis*, 1 Mason's R. 182 (Story, J.); *Langdon v. De Groot*, 1 Paine's R. 203; *Phillips on Patents*, 83, 267, 268, 283, 284, 289.

Mr. Chief Justice TANEY delivered the opinion of the court.

The question presented in this case is a narrow one, and may be disposed of in a few words.

The plaintiff claims that he has invented a new and useful improvement in the art of manufacturing bricks and tiles; and states his invention to consist in using fine anthracite coal, or coal-dust, with clay, for the purpose of making brick or tile; and for that only he claims a patent.

Opinion of the court.

And the only question presented by the record is, whether his description of the relative proportions of coal-dust and clay, as given in his specification, is upon the face of it too vague and uncertain to support a patent.

The degree of certainty which the law requires is set forth in the act of Congress. The specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention ; that is to say, to compound and use it without making any experiments of his own. In patents for machines, the sufficiency of the description must, in general, be a question of fact, to be determined by the jury. And this must also be the case in compositions of matter, where any of the ingredients mentioned in the specification do not always possess exactly the same properties in the same degree.

But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely ; for in such cases it would be evident, on the face of the specification, that no one could use the invention without first ascertaining by experiment the exact proportion of the different ingredients required to produce the result intended to be obtained. And if the specification before us was liable to either of these objections, the patent would be void, and the instruction given by the Circuit Court undoubtedly right.

But we do not think this degree of vagueness and uncertainty exists. The patentee gives a certain proportion as a general rule ; that is, three-fourths of a bushel of coal-dust to one thousand bricks. It is true, he also states that clay which requires the most burning will require the greatest proportion of coal-dust ; and that some clay may require one-eighth more than the proportions given and some not

Order.

last mentioned proportions may, however, be justly considered as exceptions to the rule he has stated ; and as applicable to those cases only where the clay has some peculiarity, and differs in quality from that ordinarily employed in making bricks. Indeed, in most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. In this case, however, the general rule is given with entire exactness in its terms ; and the notice of the variations mentioned in the specification would seem to be designed to guard the brick-maker against mistakes, into which he might fall if his clay was more or less hard to burn than the kind ordinarily employed in the manufacture.

It may be, indeed, that the qualities of clay generally differ so widely that the specification of the proportions stated in this case is of no value ; and that the improvement cannot be used with advantage in any case, or with any clay, without first ascertaining by experiment the proportion to be employed. If that be the case, then the invention is not patentable, because, by the terms of the act of Congress, the inventor is not entitled to a patent unless his description is so full, clear, and exact as to enable any one skilled in the art to compound and use it. And if, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. But this does not appear to be the case on the face of this specification. And whether the fact is so or not, is a question to be decided by a jury, upon the evidence of persons skilled in the art to which the patent appertains. The Circuit Court, therefore, erred in instructing the jury that the specification was too vague and uncertain to support the patent, and its judgment must be reversed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United

States for the Southern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

Notes:

1. Sufficiency of specification.

See *Evans v. Eaton*, 7 Wheat. 356 [p. 105 *ante*].

Battin v. Taggart, 17 How. 74.

Valve Co. v. Valve Co., 113 U. S. 157.

2. A question of fact for jury.

Evans v. Eaton, 7 Wheat. 356 [p. 105 *ante*].

Battin v. Taggart, 17 How. 74.

3. Composition of matter.

Hotchkiss v. Greenwood, 11 How. 248.

Tyler v. Boston, 7 Wall. 327.

Cochrane v. Anilin Fabrik, 111 U. S. 293.

Product:

Wood Paper Patents, 23 Wall. 566.

Powder Co. v. Powder Works, 98 U. S. 126.

Notes and Citations.

Patent in suit :

No. 97. Wood, J. December 2, 1836. Brick Making.

Citations :

IN SUPREME COURT OF UNITED STATES :

Hogg *v.* Emerson, 1847. 6 How. 437 ; Bk. 12, L. ed. 505.

Valve Co. *v.* Valve Co., 1885. 113 U. S. 157 ; Bk. 28, L. ed. 939.

IN CIRCUIT COURTS :

Jenkins *v.* Walker, March, 1872. 1 Holmes, 120 ; 5 Fish. 347.

IN TEXT-BOOKS :

2 Abb. Pat. Law, 1886, p. 74.

Curt. on Pats., 4th ed., §§ 259, 462.

Merwin on Pat. Invt., 1883, p. 235.

Walker on Pats., 1883, p. 124.

[The body of the page contains 25 horizontal lines for writing.]



INDEX DIGEST

OF

DECISIONS OF THE SUPREME COURT OF THE UNITED STATES IN PATENT CASES REPORTED IN THIS VOLUME.

Abandonment.

PAGE

1. Abandonment of an invention is absolute, and cannot afterward be resumed, and is generally a question of fact. Pennock v. Dialogue..... 217
 2. Under Act 1793 the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent. Pennock v. Dialogue. 217
 3. Under Act 1793 any acquiescence by the inventor in the public use of his invention prior to obtaining a patent is an abandonment, but acquiescence can in no case be presumed where he has no knowledge of such use. Shaw v. Cooper..... 286
 4. Whatever may be the inventor's intention, if he suffers his invention to go into public use through any means whatsoever without an immediate assertion of his right, he is not entitled to a patent. Shaw v. Cooper..... 286
 5. Where an inventor permits the use of his invention by his employers, prior to patenting, it could well be held an abandonment by public use, in view of decision in Pennock v. Dialogue, 2 Pet. 7 [p. 217 *ante*] and of Act 1793, §§ 1 and 3; Act 1800, § 1; Act 1832, § 3; and Act 1836, § 15. McClurg v. Kingsland..... 382
 6. Act 1790, § 1, examined on the question of abandonment. Pennock v. Dialogue..... 217
 7. Act 1793, ch. 11, §§ 1, 3 and 6, "abandonment" reviewed and construed. Pennock v. Dialogue..... 217
- See Particular Patents, 4; Prior Knowledge and Use, 2. Statute of Monopolies, 1.

Acquiescence.

See Abandonment, 3; Evidence, 8; License, 1.

INDEX I I

Burden of Proof.

1. The burden of proof is on the party asserting the validity of the statutory notice of 1886, § 15, before it can be used as evidence of alleged prior use. P. 8

Charge to Jury.

See Record, 1 ; Reissue, 5 ;

Claim.

See Estoppel, 1.

Combination.

1. A combination of several ;
use of less than all of ;
for an omitted element
form or manner of arr
ty v. Ruggles.....

See Particular Patents, 7.

Composition of Matter.

1. Where, from the nature of the subject-matter, it is not possible to use the subject-matter in a composition, the subject-matter is not entitled to a patent.

See Particular Patents, 8 ; Sp

Compound.

See Composition of Matter.

Congress.

See Construction of Statutes.

Constitution.

See Statute, 1 ; Term, 1.

Construction of Patents.

- 1. Where the words in a patent are entitled to be construed in favor of the parties are entitled to construe it. *Evans v. Es.***

Construction of Special Act.

1. Special Act 1808 for the re
not to authorize those v
in the interval between
patent and the special s
liability, subsequent to
v. Jordan..... ..
2. Special Act 1808 for the re
Evans v. Eaton..... ..

See Jurisdiction, 1.

Construction of Statutes.

PAGE

1. An argument founded upon the hardship of a case is entitled to great weight in the construction of a statute, where the words are obscure, but not where expressed in plain and unambiguous language. *Evans v. Jordan.* 7
 2. Rule of construction of statutes in cases of obscure and doubtful phraseology. *Wilson v. Rousseau.* 496
 3. The patent law should be construed in the spirit in which it is made. *Grant v. Raymond.* 245
 4. Congress can never be presumed to have decided in a general act that an individual is an author or inventor, the words of which do not render such a construction unavoidable. *Evans v. Eaton.* 16
 5. Act 1793, § 1, words "not known or used before the application" mean not known or used by the public before the application. *Pennock v. Dialogue.* 217
 6. Act 1793, ch. 11, reviewed (§§ 1, 2, 3 and 6). *Evans v. Eaton.* 105
 7. Act 1800, § 1, examined. *Pennock v. Dialogue.* 217
- Act 1790, § 1. See Abandonment, 6.
- Act 1793. See Abandonment, 2, 3; Alien Patentee, 1; Assignee and Grantee, 1; Reissue, 1, 4.
- Act 1793, § 1. See Abandonment, 5, 7; Construction of Statutes, 5, 6; Prior Knowledge and Use, 2.
- Act 1793, § 2. See Construction of Statutes, 6.
- " " § 3. See Abandonment, 5, 7; Construction of Statutes, 6; Reissue, 8. Specification, 4, 5.
- Act 1793, § 6. See Abandonment, 7; Evidence, 10; Construction of Statutes, 6; Notice, 1; Prior Knowledge and Use, 3; Specification, 5.
- Act 1793, § 10. See Repeal of Patent, 1.
- Act 1800. See Alien Patentee, 1.
- " " § 1. See Abandonment, 5; Construction of Statutes, 7.
- " " § 3. See Jurisdiction, 1.
- Act 1832, § 3. See Abandonment, 5; Prior Use, 1; Reissue, 8.
- Act 1836, § 6. See Specification, 3.
- " " § 11. See Assignee and Grantee, 3.
- " " § 13. See Reissue, 7.
- " " § 14. See Actions, 2; Assignee and Grantee, 3, 4.
- " " § 15. See Abandonment, 5; Actions, 2; Burden of Proof, 1; "Thing Patented," 1.
- Act 1836, § 18. See Board of Commissioners, 1; Extension, 1, 2, 6; "Thing Patented," 2.
- Act 1839, § 7. See Prior Use, 2; "Thing Patented," 1.

Contract.

1. A contract with a party to purchase all the articles made by him upon an infringing machine does not render the purchaser an infringer, unless the contract was colorable only (Act 1800, § 3). *Keplinger v. De Young.* 209

2. A covenant dated 1829 construed in view of the then established law, and the term "renewal" held not to cover an extension authorized only by Act 1832, subsequent thereto. *Wilson v. Rousseau*..... 436
See Evidence, 2.

Date of Invention.

See Evidence, 6.

Declarations of Inventor.

See Evidence, 6.

Defence.

See Questions of Fact, 1 ; Specification, 5.

Depositions.

See Evidence, 4 and 5.

Description.

See Specification.

Diligence.

See Evidence, 8.

Division of Opinion.

See Practice, 1.

Employer and Employé.

See Abandonment, 5 ; License, 1.

Estoppel.

1. A patentee cannot reject as unessential and as not of the essence of his invention part of matter expressly so claimed. *Carver v. Hyde*..... 367

Evidence.

1. Evidence to which no exception is taken should not be made a part of the record, and will not be considered by the court. *Pennock v. Dialogue*..... 217
2. Parol evidence bearing upon written contracts or papers ought not to be admitted without the production of such written contracts or papers. *P. & T. R. R. Co. v. Stimpson*..... 324
3. Where evidence is offered for a certain purpose, it cannot be deserted for that purpose, to show its relevancy to another purpose, not at that time suggested to the court. *P. & T. R. R. Co. v. Stimpson*..... 324
4. Depositions taken according to State court practice not admissible. *Evans v. Eaton*..... 105
5. Deposition introduced with the acquiescence and consent of plaintiff, cannot afterward be objected to. *Evans v. Hettich*..... 182

- | | PAGE |
|--|------|
| 6. The conversations and declarations of the inventor, stating that he had made an invention, describing its details and operation, are part of the <i>res gesta</i> and legitimate evidence to prove the date of invention as early as at that period. <i>P. & T. R. R. Co. v. Stimpson</i> | 324 |
| 7. Based on patentee's oath, the patent is <i>prima facie</i> evidence that he is the inventor. <i>P. & T. R. R. Co. v. Stimpson</i> . | 324 |
| 8. Want of diligence in asserting his right on becoming aware of the public use of his invention is evidence of inventor's acquiescence therein. <i>Shaw v. Cooper</i> | 286 |
| 9. Evidence of want of identity, a material difference between the original and reissued patents, offered by defendants after stating in open court that they had closed their evidence and plaintiffs had discharged their witnesses; if a matter in the sound discretion of the court, <i>held</i> properly rejected. <i>P. & T. R. R. Co. v. Stimpson</i> | 324 |
| 10. Under Act 1793, § 6, notice is submitted for a special plea, and is given only in order to offer special matter in evidence under the general issue. <i>Evans v. Eaton</i> | 16 |
| 11. Evidence of special matter not specified in notice, held admissible, as it would be under a special plea. Evidence of prior use so admitted. <i>Ibid.</i> | 16 |
| 12. Evidence that those engaged in such prior use had paid patentee for licenses is admissible. <i>Ibid.</i> | 16 |
| See Grant, 2. | |

Examination of Witnesses.

See Witnesses, 5 and 6.

Exceptions.

1. Exceptions should be to the points ruled by the court, and not to the charge as published at length. *Stimpson v. West Chester R. R. Co.*..... 398
- See Evidence, 1 ; 5.

Executor.

See Extension, 2.

Extension.

1. The extension of the patent under Act 1836, § 18, is a new grant of the exclusive right for a term of seven years, and all rights of assignees or grantees terminate at the end of the original term and become reinvested in the patentee, and Woodworth's patent inured to the benefit of the administrator only in his said capacity. *Wilson v. Rousseau*..... 436
2. Act 1836, § 18, authorized the extension of a patent on the application of the executor or administrator of a deceased patentee. *Wilson v. Rousseau*..... 436

INDEX D

3. The judgment of the court
646 [p. 436 *ante*], di
Turner.....
 4. Legality of an extension g
antee determined in c
seau, 4 How. 646. W
 5. An extended patent can b
extended termed. Wi
 6. Assignee's "right to use
§ 18, during extende
thing in use at the ti
Rousseau.....
- See Contract, 2.

Form.

See Particular Patents, 9.

Fraud.

See Reissue, 7.

Grant.

1. The correct performance
which the validity of
always examinable in t
violation shall be broug
ent reissued under Act
2. The grant of a patent by
and proofs laid before
cide and act, is *prima j*
and sufficiency of the p
is not re-examinable.]

Grantee.

See Assignee and Grantee.

Identity.

1. Identity of infringing macl
jury. Evans v. Eaton.
See Evidence, 9 ; Reissue, 5.

Improvement.

1. A patent for an improven
provement. Evans v.]
2. A patent for an improver
clear, and exact terms t
provement only. Evan
See Particular Patents, 1 ; 8.

Infringement.

See Combination, 1 ; Contract.

Intention.

See Construction of Patents, 1.

Invention.

PAGE

See "Thing Patented," 1 and 2.

Inventor.

See Construction of Statutes, 4.

Joinder of Invention.

1. Doubted whether improvements on different machines could regularly be comprehended in the same patent, under the general patent law. *Evans v. Eaton*..... 16
- See Particular Patents, 1.

Joinder of Parties.

1. Patentee held properly joined as plaintiff in suit for infringement brought by assignee of an exclusive right within a limited territory. *Woodworth v. Wilson*.... 542

Jurisdiction.

1. Evans's special act being engrafted on the general patent act, and the patent issued in pursuance of both, the court has jurisdiction under Act 1800, § 3, though between citizens of the same State. *Evans v. Eaton*.... 16
- See Board of Commissioners, 1 ; Record, 2.

Jury.

See Identity, 1 ; Reissue, 5.

Knowledge and Use.

See Prior Knowledge and Use.

License.

1. Where, prior to patenting, the inventor fully acquiesces in the use of his invention by his employers, it raises the presumption of a license from the inventor to continue its use subsequent to the grant of a patent. *McClurg v. Kingsland*..... 882

New Trial.

See Practice, 1.

Notice.

1. Where witness was asked as to the identity of defendant's machine with plaintiff's model in court, *held* that it was not included in the class of cases of which notice was necessary under Act 1793, § 6, and was perfectly proper under the general issue. *Evans v. Hettich*.... 182
- See Burden of Proof, 1 ; Evidence, 10 and 11.

Oath.

See Evidence, 7.

Particular Patents.

1. Patent granted Oliver Evans, December 18, 1790, for Hopper-boy construed to be a grant of the general result of the whole machinery and of the improvements in each machine. *Evans v. Eaton*..... 16

	PAGE
2. Evans's claim construed to be for the entire machine. <i>Evans v. Eaton</i>	105
3. Evans's patent construed to be for an improvement, and defective for not specifying it. <i>Ibid.</i>	105
4. Patent granted Shaw, J., June 19, 1822, reissued May 7, 1829, for Percussion Gun, held to have been in public use with inventor's consent prior to the grant of this patent, and was abandoned. <i>Shaw v. Cooper</i>	286
5. Held that Woodworth was the original inventor of the patent for Planing Mills granted him December 27, 1828, and that the specifications accompanying the patent were sufficiently full and explicit. <i>Woodworth v. Wilson</i>	542
6. Reissued patent No. 71 granted Woodworth, W., July 8, 1845, for Planing Mill, held sufficiently full and explicit in its specification and drawings. <i>Wilson v. Rousseau</i>	436
7. Patent granted Prouty & Mears, March 4, 1836, for a Plough, construed to be for a combination of three old elements, and held not infringed by the omission of one of the elements. <i>Prouty v. Ruggles</i>	351
8. Where patentee in his patent, No. 97, Wood, J., December 2, 1836, Brick-Making, gave a certain proportion of the ingredients as a general rule, and also pointed out the variations, the specification was held sufficiently clear to support the patent. <i>Wood v. Underhill</i>	551
9. Patent No. 777 granted Carver, E., June 12, 1838, reissued as No. 17, November 16, 1839, for Ribs of Cotton Gin, construed to have claimed form and manner of attaching as an essential part of the invention, and not infringed by a substantially different form. <i>Carver v. Hyde</i>	367

Parties.

See Joinder of Parties, 1.

Patent.

See Construction of Patents ; Evidence, 7 ; Petition, 1.

Patentability.

See Composition of Matter, 1 ; Result, 1.

Petition.

1. The petition is a part of the patent. *Evans v. Eaton*..... 16

Practice.

1. Practice on appeal on a division of opinion on a motion for a new trial. *Grant v. Raymond*..... 245
2. The mode of conducting trials, the order of introducing evidence, and the times when it is introduced, belong to the practice of the Circuit Courts, with which this Court ought not to interfere, unless it shall choose to

- PAGE
- prescribe general rules on the subject. P. & T. R. R.
Co. v. Stimpson 324
See Evidence, 4 ; Record, 1-3 ; Repeal of Patent, 1.
- Prerequisites to Grant.***
See Grant, 1 ; Questions of Fact, 1 ; Reissues, 8.
- Presumption.***
See Abandonment, 3 ; License, 1 ; Prior Knowledge and Use,
1 ; 2.
- Prior Knowledge and Use.***
1. The law presumes patentee's knowledge of prior public knowledge and use of his alleged invention. Evans v. Eaton 16
 2. The prior knowledge and use under Act 1793, § 1, refers to the public only, and when fraudulently obtained raises no presumption of abandonment. Shaw v. Cooper . . . 286
 3. Under Act 1793, § 6, if the thing patented had been in use or described in some prior public work, judgment shall be rendered for defendant, and the patent declared void. Evans v. Eaton 16
- See Construction of Statutes, 5.
- Prior Use.***
1. Under Act 1882, § 8, no prior use of the defective original patent can authorize the use after the reissue. Stimpson v. West Chester R. R. Co 398
 2. The use referred to in Act 1889, § 7, refers to the original application, and not to a reissue of it. Stimpson v. West Chester R. R. Co 398
- See Abandonment, 3.
- Product of Patented Machine.***
See Assignee and Grantee, 2 ; Contract, 1.
- Public Use.***
See Abandonment, 3-5.
- Purchaser.***
See Contract, 1.
- Questions of Fact.***
1. Questions of fact that would defeat the patent or the application are left open to be controverted by any one who contests the patent. Shaw v. Cooper 286
- See Abandonment, 1 ; Identity, 1 ; Specification, 1 ; 2.
- Record.***
1. Charge to Jury should not be spread *in extenso* on the record. Evans v. Eaton 105

2. Where a special jurisdiction is given to a court, all the preliminary proceedings required to found that jurisdiction should appear of record, as they constitute an essential part of the case. *Ex parte* Wood & Brundage..... 198
 3. Where a rule is the sole foundation of a suit, the record must not only show that it was granted, but it must appear by the proceedings that it was rightfully granted. *Ibid.*..... 198
- See Evidence, 1.

Recovery.

1. A patentee who includes in his patent, as part of his invention, things before known or used, cannot recover, as his patent is broader than his invention. *Evans v. Eaton*..... 105

Reissue.

1. The grant of a reissue to correct an error committed in the department of State, as also for an error arising through inadvertence or mistake on the part of the inventor, though not expressly authorized by the Act of 1793, is within its spirit. *Grant v. Raymond*..... 245
2. The holder of a defective patent may surrender it and obtain a new one, which is a continuation of and relates back to the original (*Grant v. Raymond*, 6 Pet. 220, affirmed). *Shaw v. Cooper* 286
3. The rights of the patentee of a reissue must be ascertained by the law under which the original application was made. *Shaw v. Cooper*..... 286
4. Doubted whether the fact that rights acquired by third parties pending the original invalid patent would not be a valid defence to the reissue (Act 1793). *Grant v. Raymond*..... 245
5. Whether the reissue was substantially for a different invention from that in the original patent, is a question for the jury on the evidence. *Stimpson v. West Chester R. R. Co.*..... 898
6. The reissue and the proceedings on which it issues have relation back to the original transaction; and the term runs from the date of the original patent. *Grant v. Raymond*..... 245
7. Under Act 1836, § 13, the grant of a reissue is conclusive as to how the mistake or inadvertence arose, leaving open the question of fraud only. *Stimpson v. West Chester R. R. Co.*..... 898
8. A reissue granted in compliance with Act 1832, § 3, upon compliance with the conditions prescribed by Act 1793, § 3, requires no recitals that the prerequisites of the

	grant have been duly complied with. P. & T. R. R. Co. v. Stimpson.....	PAGE 824
	See Evidence, 9 ; Extension, 5 ; Grant, 1 ; Particular Patents, 6 ; Prior Use, 1 ; 2.	
Renewal.	See Contract, 2.	
Repeal of Patent.	1. Under Act 1793, § 10, proceedings to repeal a patent require a record of the preliminary proceedings under the rule to show cause and a process in the nature of a <i>scire facias</i> to issue to repeal the patent, if upon a future trial the same should be found invalid. <i>Ex parte</i> Wood & Brundage.....	196
	See Actions, 1 ; Prior Knowledge and Use, 3 ; Specification, 5.	
Result.	1. A result is not patentable. Carver v. Hyde.....	367
Reversal.	1. It is no ground of reversal that the court below omitted to give directions to the jury upon any point of law which might arise in the cause, where it was not requested by either party at the trial. Pennock v. Dialogue.....	217
Right of Action.	See Assignee and Grantee, 1 ; 4.	
Right to Use.	See Extension, 6 ; License, 1 ; Prior Use, 1.	
Sale of Product of Patented Machine.	See Assignee and Grantee, 2.	
Scire facias.	See Repeal of Patent, 1.	
Special Act.	See Construction of Special Act.	
Specification.	1. The sufficiency of the description of the invention is a matter of fact for the jury and not of law for the court. Evans v. Eaton.....	105
	2. In patents for machines the sufficiency of the description must in general be a question of fact for the jury. Wood v. Underhill.....	551
	3. The degree of certainty required by the law (Act 1836, § 6) is that the specification be in such full, clear, and exact terms as to enable any one skilled in the art to compound and use the invention without making any experiments of his own. Wood v. Underhill.....	551

INDEX D

4. Act 1793, § 8. "Description.....
 5. An insufficient description in a particular suit under Act 1793, a judgment under Act 1793 void, it must further show intent to deceive the public.
 6. Where the specification of an invention fails to state the relative parts mixed together, or the description is and vaguely stated, the description is not a sufficient description.
- See Improvement, 2 ; Particulars, 2.

State Court.

See Evidence, 4.

Statute.

1. It is no objection to the validity of a statute which may be retrospective in its operation, if Congress to legislate upon the subject of the Constitution, so that the rights of property in existing land.....

See Construction of Special Acts, 2.

Statute of Monopolies.

1. 21 Jac., ch. 8, Statute on the subject of the question of abandonment.

Statutory Notice.

See Notice.

Term.

1. The constitutional provision which requires that the term of the patent be in the discretion of Congress.

See Reissues, 6.

Territorial Assignee.

See Assignee and Grantee, 2.

"Thing Patented."

1. Act 1839, § 7, "newly-invented composition of matter," patented" (§ 15, Act 1839).
2. The "thing patented," *A. Wilson v. Rousseau*...

Use.

See Prior Use ; Right to Use.

Validity.

PAGE

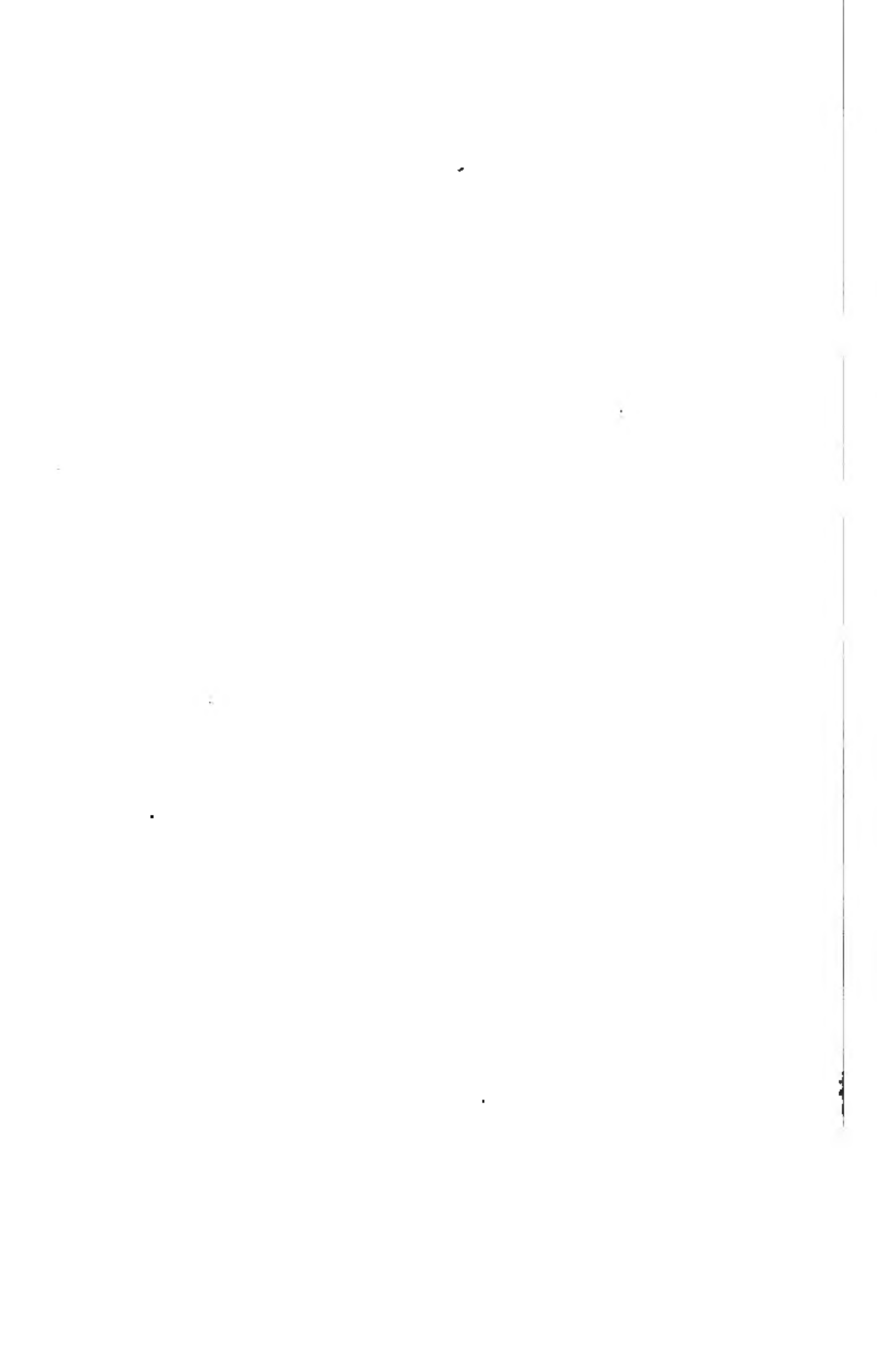
1. The validity of a patent is determined in view of the statutes in force at the time of its grant. *McClurg v. Kingsland*..... 382

Void Patent.

1. A party can take nothing by a void patent. *Evans v. Eaton*..... 105
- See Specification, 6.

Witnesses.

1. A person having an interest only in the question, and not in the event of the suit, is a competent witness. And where witness for defendant had used the patented improvement claimed, he was held competent, although matters in the defence, if found specially for defendant, would authorize the court to declare the patent void. *Evans v. Eaton*..... 105
 2. The law judges a party incompetent only when he has a certain and not a contingent interest. *Evans v. Eaton*. 105
 3. Where witness was sued for infringement of plaintiff's patent-right in another cause, *held* that it did not render him incompetent. *Evans v. Hettich*..... 182
 4. If witness is sane at the time of giving his testimony, the fact that he is subject to fits of derangement is no objection either to his competency or credibility. *Evans v. Hettich*..... 182
 5. Questions put to witness as to acts among strangers, *held* properly overruled. *Evans v. Hettich*..... 182
 6. A party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination. *P. & T. R. R. Co. v. Stimpson*..... 324
- See Notice, 1.



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